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Guide for an Efficient Initial Meeting with a Patent Attorney to Discuss Preparing a Patent Application

Whether to apply for patent protection is not always an easy decision, and deciding how to best apply can also require complex considerations. For a patent attorney to provide the best advice, you need to be able to provide a variety of information. When you can provide as much as possible of the desired information during your first meeting with the patent attorney, you enable him/her to provide the appropriate advice more quickly.

Accordingly, I have developed this guide as a checklist to help you prepare for an efficient initial meeting with a patent attorney on the subject of applying for patent protection. I recommend that you gather as much as reasonably possible of the information discussed below. Of course, some issues may not apply to your situation, and some situations may warrant reliance on additional information. I have also limited the number of issues referenced to prevent the task of preparing for the meeting from becoming too arduous.

Whether you have prepared the information below in detailed written form or you have prepared yourself to concisely explain it orally, having the information available will increase the efficiency of the initial meeting and more quickly enable your patent attorney to determine the course of action appropriate for you.

Accordingly:

Please provide or be prepared to discuss as much as practical of the following:

List of all Inventors, even “suspected” inventors

It can sometimes be difficult to determine whether someone involved peripherally in a project can be deemed an “inventor.” An inventor is one who makes a material contribution to the concept as opposed to merely providing routine technical support. List all those you suspect may be inventors and be prepared to discuss their contributions.

Are any of the inventors employees of a different company or members of another enterprise or business?

Such can be the case when two enterprises work together on a common project.

Does any other enterprise, government entity, etc. potentially share rights to the invention? Discuss.

- **Are all inventors cooperating with you regarding potentially obtaining a patent? Discuss.**

An inventor who has left employment with a company may still be under an obligation to cooperate in the preparation of a patent application. Some former employers may be difficult to locate but willing to cooperate. Others may be hostile and refuse to cooperate. Special circumstances may need to be discussed during the meeting with the patent attorney.

- **Tentative title of invention**

- **Brief Description of Invention**

Try to limit the description to fewer than 150 words.

- **Problem(s) addressed by invention**

Brief descriptions are sufficient.

- **What is “better” about your invention?**

(It is OK to repeat information that may be been provided already above.)

- **Previous Approaches to Solving Problem**

Brief descriptions are sufficient.

- **Best prior art known to you**

The term “prior art” refers to publicly-known technology, and “best” refers to what is the closest to your invention. Are there publications, patents, public displays, *etc.* of which you are aware?

- **Enabling and Best Mode disclosure**

To the extent reasonable at this stage, describe how to make and use the invention. Which way works best? Prepare and include appropriate text, drawings, flowcharts, etc. Describe any alternative embodiments.

- **Did you make a prototype?**

A prototype is not necessary to apply for a patent, but it sometimes can help. If you built a prototype of the invention, provide a brief description or be prepared to describe the prototype during the meeting with the patent attorney.

- **Approximate Date of Conception**

When did the inventor(s) conceive of the invention?

- Was the invention ever disclosed in public? If so, when?**

- Was the invention ever “used” in public, even if concealed somehow? If so, when?**

If yes, indicate when and describe how.

- Are there plans to disclose the invention in public? When?**

- Was an embodiment of the invention ever offered for sale – regardless of whether the embodiment had yet been sufficiently developed? When?**

Believe it or not, merely offering an invention for sale even before sufficient development has occurred to reduce it to practice can set a deadline for which a patent application must be filed.

- Is a date, even approximate, set already for an embodiment of the invention to be offered for sale? When?**

- If a competitor saw your invention, how easy would it be for the competitor to reverse engineer it?**

My Initial Meetings to Discuss Preparing Patent Applications

If you are considering whether to or how to best apply for patent protection, I suggest that you prepare the information noted above. Then, I invite you to contact me to schedule a session where we will discuss your particular circumstances. Example topics for discussion include:

- The potential scope of your patent protection
- The likelihood you may need to forfeit some or all of your potential patent rights to others and how to reduce this likelihood
- Whether you should apply for patent protection or maintain a trade secret

Your advance preparations as described above to increase meeting efficiency, and accordingly I gladly offer the initial meeting for no charge. However, the availability of such sessions is limited based on factors such as eligibility and potential conflicts of interest with my existing clients.

I look forward to your call.

- Joe Felber
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