

# ipBrief



## Dos and Don'ts of IP Protection

To protect your creative endeavours and maximise their commercial value, a few simple rules must be observed\*.

### Do

#### ✓ Maintain secrecy before filing

The “golden rule” is that you must file a patent or design application to secure the rights, before any public disclosure or commercial use. Any prior discussions must take place under conditions of confidentiality, which should be confirmed in writing, ideally in a non-disclosure agreement.

#### ✓ Conduct preliminary searching

This can provide initial confidence that an idea is new and a clearer understanding of how it differs from the closest “prior art”. This will help your patent attorney and save you money. US patents can be searched at [patft.uspto.gov](http://patft.uspto.gov) and specifications downloaded from [www.pat2pdf.org](http://www.pat2pdf.org) – both at no cost.

#### ✓ Seek professional advice

Be sure to consult a patent attorney. Filing your own patent or design application is like performing your own surgery - possible, but not recommended! There are numerous traps and pitfalls along the way to successful IP protection - and many fatal defects cannot be rectified retrospectively, when they eventually come to light.

#### ✓ Have a business plan

Once a patent or design application has been filed, the next steps come around surprisingly quickly. They can also be costly, especially if you wish to extend the IP into other countries. A sound business plan is important, to ensure that the IP is well protected, adequately funded and structured to support your commercial objectives.

### Further Assistance

For further information and an initial consultation at no cost, please call Shelston IP on 02-9777-1111. We will advise you on the most suitable form(s) of protection to pursue and how to go about it. We will also provide a complimentary reference guide outlining the procedures, requirements and approximate costs of patents, trade marks and designs.

*\*Please Note: This list is not exhaustive and should not be relied upon as a substitute for professional advice.*

### Don't

#### ✗ Disclose before filing

This is a restatement of the “golden rule” above. Potentially valuable IP rights are often lost through public disclosure or use before a patent or design application has been safely filed. There are some limited exceptions and “grace period” provisions, but they are not available worldwide and should only be relied on as a last resort.

#### ✗ File too early

It can also be a mistake to file an application prematurely, for example based on a speculative concept with no tangible means of practical implementation. The value of an early priority date must be balanced against the need for an effective priority date, which may dictate further product development before filing.

#### ✗ Rely on verbal confidentiality undertakings

Verbal confidentiality undertakings can be notoriously difficult to prove. At a minimum, such agreements should be documented. By far the safest approach, however, is to rely on a professionally prepared patent or design application. This will be unaffected by subsequent disclosures and independent of contractual relationships.

#### ✗ Publish improvements

Product improvements may not be covered by earlier applications. It is therefore critically important for any improvements or developments to be discussed with your patent attorney before they are published, to ascertain whether an amendment to the original application or a supplementary application may be required.