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David J French LLB BEng

When first asked by Mitchell to speak at this event I replied: “No I’ve said all I have to say in my two papers at ICCF-17 and ICCF-18.”

Then I thought for a moment and said: “But wait there’s one more possible topic: The role of the Patent Attorney in patenting Cold Fusion Inventions.” So here I am now.

I’m going to address this topic from the viewpoint of what you can or should expect from your Patent Attorney.

Preliminary Patent fundamentals

But first to summarize the other two papers:

- you can’t get a patent unless you have an invention that works
- you have to describe how others can build something that will work
- you have to define what it is about your invention that is new, and
- the core essential of your new idea must not be “obvious”

My previous papers covered these themes, which are standard nuts-and-bolts issues addressed by Patent Attorneys everywhere. That’s explaining the system. My papers went on to address two additional issues:

- the challenge of patenting Cold Fusion inventions, and
- patenting fallacies.

Cold Fusion inventions

Here is the big issue for Cold Fusion inventions. An invention has to work and the patent disclosure has to describe how to do it. Normally Examiners generally assume that the described invention will work and that the description is sufficient. But in the case of Cold Fusion applications an Examiner is entitled to ask an applicant: “Prove that this works”. This special treatment for Cold Fusion inventions is also applied to inventions based upon perpetual motion, universal cures for cancer or baldness, anti-gravitational devices and any invention where there is a suspicion that the invention may not work. The Examiner has discretion to raise such a challenge.

The solution: file evidence with the Examiner which shows that your invention works. This may require you to hire an engineering firm or Research Institute. Not cheap.

Problem: you also have to satisfy the Examiner that your description in your patent application will enable others to get a useful result. This one can be a sticker!

Satisfying the Examiner

Now there are some Inventors who have had a lot of bitter experience with the US Patent Office. Mitchell Swartz is not alone. In order for an Examiner to properly make a request of an applicant to: “prove it”, the Examiner has to demonstrate through a written argument that the workability of the invention is dubious. I’m afraid that a kind of template might be circulating in the Patent Office amongst Examiners reciting all of the reasons why it’s legitimate to doubt that an invention based on Cold Fusion will work. In fact, this template seems to condemn Cold Fusion as a fraud. But the issue is not whether there have been fraudulent claims made respecting Cold Fusion in the past. The issue is whether the application under examination describes an invention which works and does so in a way that will enable others to reproduce the benefits of the invention. Don’t get distracted. Don’t get disheartened. But appreciate before you file what will be required.

Patent Attorneys

That has all been background. This talk is supposed to be about what you can expect from your Patent Attorney. Well, I can certainly address that subject. I’ve had 30 years experience in preparing and filing patent applications. Mostly, this was a practice that I carried-on before the US Patent Office from Canada on behalf of Canadian clients. Filings in Canada and abroad were a bonus. But I must confess that I have never filed for a Cold Fusion invention.

What can you expect from a Patent Attorney in such cases?

Here’s what some Inventors expect.

The Inventor’s Dream

They have a dream: the dream of many Inventors is that obtaining a patent will help make them rich. Without fully understanding how this process can occur they start the process by seeking-out a Patent Attorney with the same enthusiasm that Dorothy, the Tin Woodman and others had when they went to the City of Oz to see the Great Wizard. According to this version of the Inventor’s dream, they will enter a Patent Attorney’s office, and after being interviewed and told how much it will cost, they will be able to go away comfortable that the procedures will all be looked after, that a patent will issue, and that money will then start to flow. Warning: this is not true!

Role of Patent Attorneys

Most Inventors aspiring to patent rely upon their Patent Attorney. It is essential to employ a Patent Attorney at key points in the exercise. But it is a rare Patent Attorney that will guide an Inventor in the combined invention, patenting and commercialization processes.

Patent Attorneys are functionally journalists. They write-up the story of inventions. But they also have to help you define what it is about an invention that is new. A patent can only issue for an invention having a *feature* that is new (and unobvious). Your Patent Attorney has to understand the invention well enough to see the feature that is new. You may have spent years working in the field of your invention, indeed thinking about your invention. By way of contrast, in most cases your story will be about something that the Patent Attorney has never seen before. He's going to have to become a quick study in order to do justice to describing your ideas.

The first suggestion an Attorney will make is to have a "prefiling patent novelty search" conducted. This is a search amongst all available literature to see what aspect of the invention might be new. He might do a partial search himself on the Internet. After all, if he finds the invention easily then the exercise is over. But properly, good searches should be done by search professionals. They are going to charge $800 or more for a simple invention; your Attorney will charge a similar amount to analyze and report the search results.

(An Inventor can save some money by ordering a search himself directly. But there are some challenges in doing so. A key issue is that you have to tell the Searcher what key feature is to be searched.)

When the search comes back the Attorney will not only look through the documents found by the Searcher to see if your invention has been addressed, but he will also use the literature that has been located to educate himself in the principles and jargon of the field of the invention. Frankly, your Attorney has to get up to speed if he's going to do justice in understanding and writing-up the story of your invention. Even though you may pay $600 or $800 to have the Attorney report on the search, in addition to the Searcher's charges, you're also paying for him to get a little more educated before the exercise goes further.

Often a search will turn up aspects of the idea of the invention. This generally always happens. The job of the Attorney is to look for that special feature which is new. Here's where the agendas of the Inventor and the Attorney may go off-the-rails.

All an Attorney can represent to a client is that he will endeavor to obtain a patent on the key feature of the invention which is new, and do so in a manner which will support the validity of the patent. Hence, I have said more than once to a client: "I can always get you a patent." How can this be true?

What are you patenting?

You can always get a patent by focusing on a feature which is a trivial detail. For example if you were to try to patent a fork, if you added the stipulation that one of the tines is twisted into a spiral and then bent at 45° to pick up olives, adding such further features as may be required, eventually the patent application will be focused on something so miniscule that the Examiner will throw up his arms and say: "I'll never find this in the prior art. I may as

well quit searching and issue the patent." So it will be possible to obtain a patent. But will it be worth it?

Many patent applicants end up obtaining patents on features which are trivial because this is imposed on the application by the state of the prior art. Good ideas are often thought of by several individuals. An Inventor may feel that they have an originated in idea, but if it's a good idea, the broad concept may already have been addressed in the prior art. All that may remain with a prospect of being patentable may be minor details. Should an applicant proceed under those circumstances? What if a prior art search shows that only a modest feature of the invention qualifies for patent protection? Should an applicant proceed?

The issue is not just whether the prospective patent rights that can be obtained will only focus on a minor detail of an invention. The bigger question is whether such patent rights, what you are likely to obtain, will have any commercial relevance or power at all.

Many, indeed, the greater part of Patent Attorneys, are obtaining patents that will not have any significant commercial value. The reason is that Attorneys do not investigate or advise their clients on the commercial potential of the invention. They do not say: "This patent will be a waste of money." An Inventor may ask his Attorney: "What do you think about the prospects for my invention?"; or: "Do you think it will be worthwhile for me to invest in obtaining a patent?" The answer that he will get either directly from an honest Attorney, or by pressing the point with an Attorney who is evasive is: "I don't know. That's your responsibility. I'm just going to try and obtain a patent on the feature of your idea that is new."

This is a very important reality. Do not expect your Patent Attorney to assess your idea for its likely commercial success. Remember, this Attorney is looking forward to billing you probably $10,000, sometimes $15,000 or $20,000 and sometimes even more. It is a rare to find a Patent Attorney who will say: "This invention is not good enough. Go back to the drawing board until you get it right." Instead they will say: "Tell me your idea. We will find out what is new about your idea and then we will try to obtain a patent on that novel feature."

If you want to determine whether your prospective patent rights will have any meaningful scope and commercial value, you must make this assessment yourself.

Warnings from Attorneys

Now there's another issue that is very relevant for Cold Fusion inventions. A Patent Attorney should know that the Patent Office is likely to harass an applicant who claims that the invention works on the basis of a Cold Fusion effect. Not all Attorneys give this warning. Normally, an Attorney will take it on good faith that when the Inventor describes something, then it is going to work.

Sometimes Inventors present stories to their Attorney which are blatantly deficient. Most Attorneys, not all, will make an effort to press the Inventor to both focus on an idea which

will work, and to provide a description which is sufficient so that others can exploit the idea. But few will press this point if it means risking their retainer. They will not want to offend their client. If the client insists on making a filing, the Attorney will write-out the story as provided to him by the Inventor.

Also, appreciate that in the background is the ever-present issue that it is only a *feature* of the invention, a feature which qualifies as being novel (and unobvious), that can be patented. Many Inventors do not appreciate this distinction. Many Inventors do not understand that the scope of their exclusive rights will be limited by the prior art. It will be a rare Patent Attorney who will try to bring home this point emphatically to a client. It is not often that a Patent Attorney will say: “It looks like we are only going to get a patent on a trivial feature.” If the client says: “But can we still obtain a patent?”, then many Attorneys will simply sit down, assess the feature that is a candidate for patenting and then report: “Yes, we can probably get a patent.” But on what? Inventors should understand what their patent is likely to protect.

Who is at fault if an applicant decides to proceed under these circumstances?

The Challenge for Cold Fusion inventions

But now we must talk about whether the invention works and whether the Inventor can provide a sufficient description to support a valid patent grant.

When you first approach your Patent Attorney you should raise this question: “Are we going to have problems because this invention relies upon a Cold Fusion effect?” Patent Attorneys in-the-know will say “Yes”. If you’re properly advised, you’ll be told that you are going to have to prove that it works and you’re going to have to satisfy the Examiner that the write-up filed at the time of application is sufficient to enable others to benefit from the invention. You cannot change the “story” in a patent disclosure once a final application has been filed.

Think about this carefully. If you give to the Attorney a write-up and assure the Attorney that this document meets these two requirements, then is the Attorney wrong to proceed to prepare and file the patent application, and send you a bill? In most cases, he/she will take you at your word.

There are some Attorneys who may persist in challenging you. Indeed, you may find an Attorney who raises repeated questions and makes numerous demands while he is writing-up the story of the invention. This may seem like a terrible nuisance. After all, isn’t the Attorney supposed to understand the invention? Don’t get upset. You are fortunate to have found an Attorney who is trying to do a good job!

Conclusion

These are the highlights of my message on the topic of what you can expect from a Patent Attorney when you file for a Cold Fusion invention. As I’ve indicated in my other papers, it is

very appropriate, very desirable, that an Inventor make the effort to understand the patenting process. The whole exercise will go forward much more efficiently, and with less risk of making a futile application, if an Inventor understands as much as possible about the patenting process. This doesn't mean understanding everything, all of the details such as deadlines and international filing options etc. But I've tried to hit highlights here that should put an Inventor/applicant on the alert.

You are going to need an Attorney at the key stages, but the burden is on the Inventor to decide whether it is worth proceeding.

An Inventor should be aware whether they're wasting money on a patent filing. They should honestly assess whether the invention works and be prepared to prove to the Examiner that it does when he asks for proof. It is for the Inventor to ensure that the description of the invention is sufficient to qualify as an "enabling disclosure".

These are issues which are specific to a Cold Fusion invention. There remain the other important issues about whether the patent will have any commercial value. That will depend upon the nature of the invention, the state of the market for this type of technology, and the scope of patent rights which can potentially be obtained. These are very, very important considerations for an Inventor who is concerned to know whether he may be wasting money. I tried to address some of these issues in my two prior papers for ICCF-17 and ICCF-18 and shortly in this presentation.

One last message: don't despair! If you don't have something that works right now, keep trying. Be alert when you do have something that works to understand the process. And if you think you have a winner don't miss-out by failing to get good patent protection, if you can.

David J French
www.SecondCounsel.com