In-House Illustration Has Its Benefits

Oct 29 2021

Posted By: Thomas A. Miller

Practice Area: Patents & Intellectual Property

Patent prosecution is a term of art referring to the process a patent attorney undertakes to transform the idea of an inventor into an enforceable property right. Many steps are traversed along the way starting with the initial meeting with the engineer or scientist, or even independent inventor, to understand what has been created. Searching is often then conducted to see if the idea has been patented or disclosed before. More often than not, that searching shows that the absolutely exact idea has not been patented, but in doing so at least the closest prior art is discerned so that the patent attorney can then write claims which distinguish over that which is known.

Once that patentable subject matter is identified, and the inventor or business owner has decided the perceived degree of coverage is worth pursuing, the patent attorney proceeds to put pen to paper to write up a patent application capturing that nugget or nuggets of ingenuity. The resulting patent application is then filed with the US Patent & Trademark Office (USPTO) followed by an extensive negotiation period with an Examiner at the USPTO to hopefully arrive at an issued US patent.

The foregoing is all done on a daily basis by patent attorneys and patent firms the world over. One of the many things that sets the von Briesen approach apart, however, is that concurrent with our patent attorneys putting that pen to paper to capture the idea in text, our in-house illustrator also gets to work preparing drawings which show the invention in graphic form. Typically, this step is farmed out to vendors outside of the firm. While workable, we find that having the drawings prepared in-house not only leads to a better patent, but a quicker throughput as well.

Elisabeta Jakllari is the von Briesen illustrator and has been preparing patent drawings for several years. With a degree in computer aided design (CAD), “Elsa” is able to quickly and thoroughly prepare the various cross-sectional, isometric, plan and side views needed to satisfy the drawing requirements of the US Patent & Trademark Office, as well as the flow-charts, graphs and block diagrams which, in combination with the text prepared by the patent attorney, help to fully flesh out the concept and result in a convincing and enforceable patent. Text is great, but given the dense technical subject matter conveyed in most patent applications, a set of understandable patent drawings often carry the day in not only convincing the Examiner of its merit as a patent, but perhaps even more importantly convincing a judge and jury down the road of its validity and worth as well.

Of import in its own right is that by having such capability in-house, Elsa gets to know the technology of our clients as well as the attorneys and can draw upon historical knowledge naturally gleaned from repeated exposure to their given technology to arrive at a set of figures not only capturing the invention but succinctly depicting the differences between the invention of our client and that covered by the prior art. Our inventors are often overworked engineers at large corporations with heavy demands on their time. Some days, the last thing they want to do is review a thirty page patent application we have prepared for their latest invention. It is only human nature that in such situations they will turn to the drawings first to see if we have captured it. With Elsa in the fold, we and they know it will be as she has prepared so many for them before.

Finally, with the passage of the America Invents Act (AIA) seven years ago, the United States joined much of the rest of the world in becoming a "first-to-file" country. This was a drastic departure from prior Patent Acts which had all made the US a "first-to-invent" jurisdiction. In other words, before the AIA, the filing date of the patent application with the USPTO was not of utmost importance as even if one inventor beat another inventor by filing first, the inventors had a chance to later prove to the USPTO that they were in fact entitled to the idea. Evidence such as lab notebooks, internal emails, mail stamps, and the like could all be used to show when an idea was first conceived, and if diligently reduced to practice, that date of first conception would entitle the later filing inventor to the patentable idea, even if the other inventor filed first.

With the advent of the AIA, however, all that changed. Suddenly, it did not matter when the idea was conceived and how diligent the inventor was in fine-tuning and otherwise reducing that concept to a working prototype or patent application, what matters was who filed first with the Patent Office. That was it. As you can imagine, one immediate and direct offshoot of that for patent prosecutors and patent holders was to demand the patent applications themselves be drafted and filed as soon as possible. What used to maybe take 120 days or more to prepare now needed to be wrapped up in 45 or 60 days, or less. That's another area where having an in-house illustrator becomes advantageous. Nothing is worse as a patent attorney than hustling to prepare the patent text, only to wait on an outside patent illustrator to send back drawings. By doing so in concert with the patent attorney, and doing so repeatedly in-house, what previously might have been a bottleneck in the practice throughput instantly became a facilitator instead.

The patent attorneys, and illustrator, of von Briesen are well versed in all the myriad nuances of patent prosecution. Should you ever have a need for assistance with your intellectual property we would be pleased to assist you.

---

von Briesen & Roper Legal Update is a periodic publication of von Briesen & Roper, s.c. It is intended for general information purposes for the community and highlights recent changes and developments in the legal area. This publication does not constitute legal advice, and the reader should consult legal counsel to determine how this information applies to any specific situation.