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## Patenting Inventions

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# Patenting Inventions

## What is a Patent?

A patent issued by the United States Patent and Trademark Office grants the patent owner “the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States.”

There are two principal types of patents:

**Utility patents** may be granted to anyone who invents or discovers a new and useful process, machine, article of manufacture or composition of matter; or a new and useful improvement of these.

**Design patents** may be granted to anyone who invents a new, original and ornamental design for an article of manufacture.

## What Can Be Patented?

**Useful** Only “useful” inventions can be patented with a utility patent. The term “useful” means that the invention has a useful purpose and is operative for its intended purpose.

**Subject Matter** Patentable subject matter has limits. Laws of nature, physical phenomena, abstract ideas, mathematical algorithms and mere printed matter are not patentable subject matter. In addition, a patent cannot be obtained for a mere idea or suggestion.

**Novelty** In order for an invention to be patentable it must be novel over the “prior art.” Thus, under most circumstances, only the first inventor can obtain a patent for an invention. Moreover, an inventor cannot obtain a patent for an invention if (a) the invention was known or used by others in the United States, (b) the invention was patented or described in a printed publication anywhere, or (c) the invention was in public use or on sale in the United States more than

one year prior to the application for the patent. It is immaterial whether the printed publication or public use was by the inventor, or by someone else. If an invention is described in a printed publication, used publicly, or placed on sale, the inventor must apply for a patent within one year; otherwise any right to a patent will be lost.

**Non-Obvious** Even if the subject matter to be patented is novel, and involves one or more differences over the most nearly similar thing already known, a patent may still be refused if the differences would be obvious. The invention must be sufficiently different from what has been previously used or described, that a person with ordinary skill in the pertinent technology would find it non-obvious. For example, substitution of one color for another and mere changes in size are ordinarily not patentable.

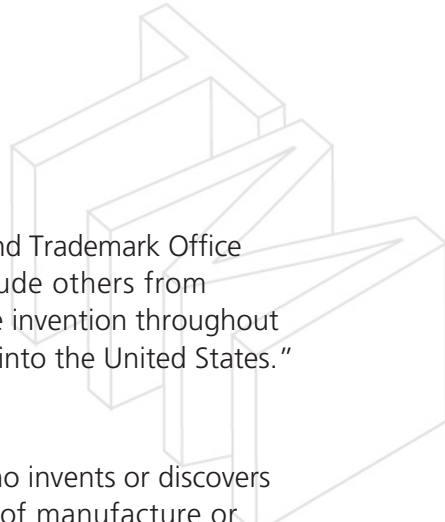
## Who Can Apply for a Patent and Who Owns the Patent?

Only the inventor may apply for a patent. If two or more persons develop an invention jointly, they must apply for a patent as joint inventors.

A patent initially belongs to the inventors. However, patents are like other property and can be sold and licensed. In an employer/employee situation, the employer typically owns the patent.

## Does a Patent Make Business Sense?

When deciding whether to patent an invention, an inventor must not fall victim to the common misconception that a patent is



needed to market an invention. A patent only gives its owner the right to keep *others* from marketing the invention. It gives the patent owner no right to bring the invention to the marketplace (although it makes it much easier to license an invention to someone else).

The principal issue to address before embarking on the patent process is whether an invention has the potential to be commercially profitable. Just because something is new or better does not mean it will be profitable. If an invention will not generate a profit, then no patent is needed; chances are no one will copy it if it is not profitable.

## Types of Patent Applications

### Design Patents versus Utility Patents

As noted above, there are two main categories of patents: **design patents** and **utility patents**.

*Design patents* only protect the non-functional appearance of a product, while *utility patents* cover how an invention works. For some products, both patent types may be available. Design patents are advantageous because they are relatively inexpensive to obtain and are more likely to be issued by the Patent Office than utility patents. Their main disadvantage is that the scope of protection is generally narrow—they only protect the appearance of the product shown in the drawings, and not the product's function.

### Provisional Patent Applications versus Regular Patent Applications

If a utility patent is appropriate for an invention, then it is necessary to decide whether to file a regular application or a provisional application.

Inventors have the option of filing a provisional patent application for an invention that can be protected with a utility patent. A provisional application allows filing without any formal patent claims or declaration. It may establish an early effective filing date for a later filed regular patent application, and allows for the term "Patent Pending" to be used.

Provisional patent applications appeal to inventors who want more time to test market an invention before investing in the cost of a utility patent. However, a provisional patent application does not start the patenting process in the United States Patent Office, and only lasts for one year. The inventor must file a corresponding regular application within one year of the filing date of the provisional application to obtain the benefit of the provisional application.

### Advantages of a Provisional Application

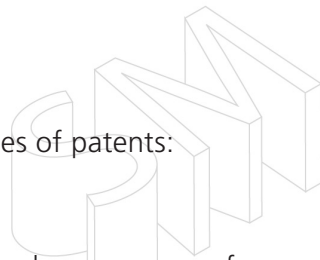
**Lower Initial Cost.** Due to lower filing fees and lack of claims, the initial cost of preparing and filing a provisional patent application is lower than that of preparing and filing a regular patent application.

**Delay of Examination Costs.** Since the Patent Office does not examine a provisional application, examination costs are delayed during the pendency of the provisional application.

**Shift of Patent Term.** The end of the patent term can be shifted one year into the future—an important advantage for inventions, such as drugs, whose commercial value may be at the end of the patent term.

### Disadvantages of a Provisional Application

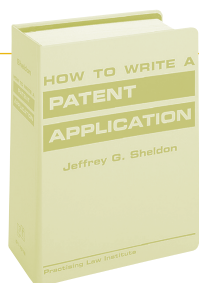
**Delay in Issuance of a Patent.** A provisional application cannot result in a patent; eventually a regular application must be filed.



Accordingly, the initial filing of a provisional application, instead of the immediate filing of a regular application, delays the issuance of any resulting patent.

**Higher Total Cost.** The overall cost of initially filing a provisional application, followed by filing a regular application, will be higher than the immediate filing of a regular application.

**Accelerated Foreign Filing Costs.** As discussed later, generally foreign applications are filed within one year of the filing date of the first U.S. patent application relating to an invention. Thus filing a provisional patent application starts the clock on this one-year period.



## How to Write a Patent Application

By Jeffrey G. Sheldon  
Published by Practising Law Institute

Since its publication in 1993, *How to Write a Patent Application*, authored by founding shareholder Jeffrey G. Sheldon, has been a benchmark text for inventors, entrepreneurs, managers, law schools and patent lawyers, both veteran and novice. It offers a step-by-step process for handling a wide range of patents, and explains, analyzes, and illustrates all the essential principles and techniques of drafting solid patent applications. This book can be ordered from the publisher at [www.pli.edu](http://www.pli.edu).

## The Patent Process

### The Patent Checklist

Is a patent appropriate for an invention? We can provide a checklist to determine whether filing a patent application makes sense. We can also help work through the checklist.

### Patentability Study

Usually a patentability study is conducted before filing a patent application. This is optional; the Patent Office does not require such a study. A key purpose of a patentability study is to determine the chances of obtaining a patent in the Patent Office. The study usually includes the following steps:

- 1) We request a patentability search from a professional searcher. The request defines the invention, and identifies the general categories of references to investigate.
- 2) The searcher conducts a search for references relating to the invention, typically by searching for U.S. patents and published patent applications.
- 3) We evaluate and report the search results.

Reasons for conducting a patentability study include the following:

**Economics.** A patentability study assists in deciding whether to invest the money and time in filing a utility patent application.

**A Better Application Can Be Prepared.** A patentability study helps identify the features of an invention that are most likely to be patentable. With this knowledge, we can write an application that stresses those features.

**Commercial Reasons.** Often the commercial potential of an invention depends upon whether a patent can be obtained. A patentability study provides an early indication of the chances of obtaining a United States patent.

**Foreign Filing Decision.** Patentability studies are useful in determining whether to file international applications, which are expensive. Most inventors start the foreign filing process within one year of the United States filing date, which is usually before the U.S. Patent Office will examine a patent application. Accordingly, in view of the cost of foreign filing, it makes sense to conduct a patentability study before making the decision to file international applications.

### Preparing and Filing a Patent Application

If the patentability study results are favorable, then it is time to file a patent application—a petition to the U.S. government asking for a patent. The application includes formal paperwork, a description of the invention, any drawings necessary to understand the invention, and the claims that define the invention.

### Duty of Disclosure

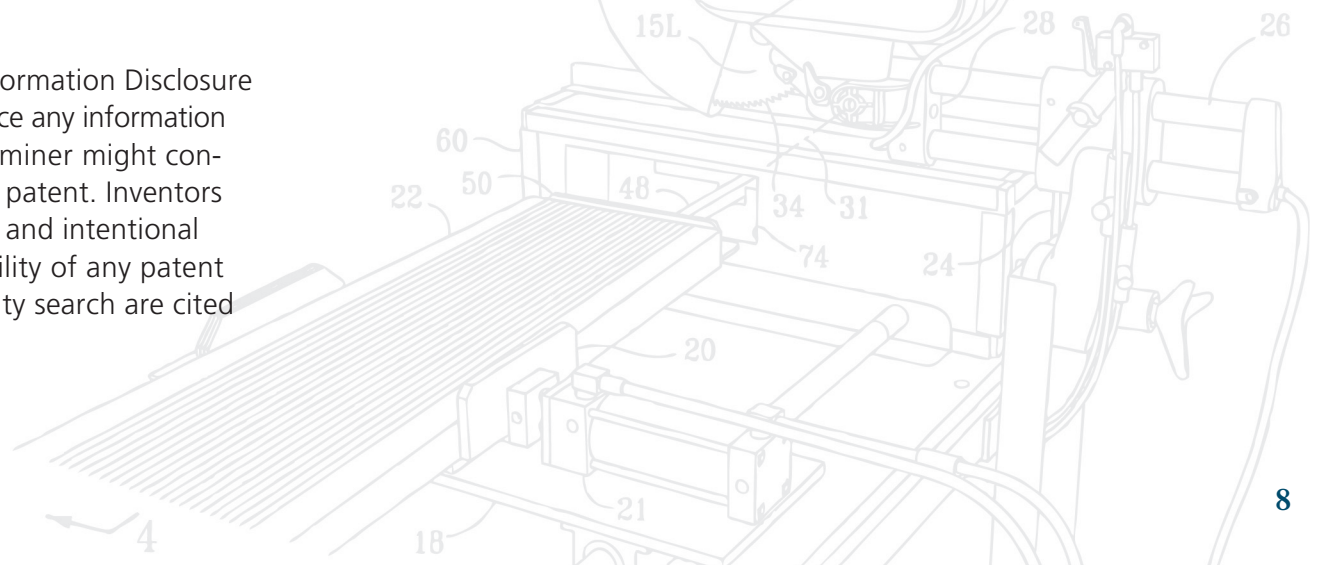
Typically, the application papers include an Information Disclosure Statement, where we disclose to the Patent Office any information we, or the inventor, are aware of that an examiner might consider important in deciding whether to issue a patent. Inventors are under a duty to disclose such information, and intentional failure to do so may jeopardize the enforceability of any patent that issues. Usually, the results of a patentability search are cited to the Patent Office.

### Patent Prosecution

The U.S. Patent Office assigns the application to an examiner to determine if a patent should issue. More often than not, the examiner initially rejects the application. The inventor has the right to argue with the examiner and amend the application to overcome the examiner's initial position. If the examiner cannot be persuaded to issue a patent, there are appeal rights. The process of obtaining a patent after the initial filing is called "patent prosecution."

### Foreign Patents

A U.S. patent does not provide rights in foreign countries. If someone is using an invention only outside the United States, a U.S. patent normally cannot be used to stop them. Therefore, it is necessary to file applications in those countries where a patent will be of value. We recommend starting the foreign filing process within one year of the United States filing date in order to obtain the benefit of that filing date. Under international treaties with most countries, if an application is filed overseas within one year of the U.S. filing date, there is a "fiction" that the inventor filed in the foreign country on the same day as the application was filed in the United States. This sometimes can be very important in avoiding prior art that becomes available in the one-year period.



## FAQs

### ***Do I need a patent to sell my product?***

No. A patent only gives the inventor the right to keep others from using the invention; not the right to sell the invention.

### ***Can I keep my trade secrets and get a patent?***

Generally no. The inventor must disclose the “best mode” of practicing the invention in the patent application. Disclosure of the best mode is in exchange for the right to exclude others from using an invention.

### ***Will the government enforce my patent?***

No. If someone infringes an issued patent, the remedy is to sue that person in Federal Court, or ask the International Trade Commission to bar importation of an infringing product.

### ***What is the process to obtain a patent?***

The overall process includes the following steps:

- 1) Conduct a patentability search (optional).
- 2) Prepare and file the application.
- 3) Receive a filing receipt from the Patent Office.
- 4) The application is typically published 18 months after the filing. It is possible to opt out of publication if no foreign patent applications will be filed.
- 5) Receive an office action from the Patent Office.
- 6) If the office action raises issues with regard to the patent application, which happens over 90% of the time, respond to the Patent Office. This can occur multiple times.
- 7) A patent, hopefully, issues.

### ***How long does it take to get a patent?***

The length of time to obtain a patent cannot be predicted. It depends on many factors, such as the overall backlog in the Patent Office, the backlog in a particular technological area, whether it is an application for a design patent or utility patent, and the level of difficulty involved in persuading the Patent Office to actually grant a patent. Under certain circumstances, such as if an inventor is over 65, it is possible to file a petition to expedite the process. In addition, a patent may never issue. Sometimes the Patent Office is not willing to issue a meaningful patent, or the invention turns out not to be worth the cost of a patent.

### ***How long does a patent last?***

Generally, a utility patent expires 20 years from the filing date. However, during this period, the patent owner must pay maintenance fees to keep a utility patent from expiring. Design patents last for 14 years, and there are no maintenance fees.

### **About Sheldon Mak & Anderson**

At Sheldon Mak & Anderson, we recognize that innovation is our clients' competitive edge, and this innovation needs protection. As intellectual property attorneys, we specialize in offering powerful protection for unique ideas.

### **Creating Wealth for Our Clients**

As intellectual property law attorneys, we can accomplish what most attorneys cannot; we can help create wealth for our clients. Patents, trademarks, copyrights and trade secrets are assets that can be worth many times their cost. By using our skills and experience to protect innovation, we help optimize returns for our clients.