

BASIC INFORMATION ABOUT PATENTS

“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”

--35 U.S.C. § 101

WHAT IS A PATENT?

A patent is essentially a bargain between the government and an inventor. In exchange for disclosing his or her invention in complete terms so that others can benefit from and improve on the technology, an inventor receives the right to exclude others from making, using, or selling his or her invention for a limited period of time.

In order to understand what a patent is, it's important to understand what sorts of things can be patented. As 35 U.S.C. § 101 (quoted above) states, a patent can be issued for “any new and useful process, machine, manufacture, or composition of matter.” The courts have interpreted this phrase to include machines and articles of various sorts, chemical compounds, computer software, and genetically modified organisms brought into being by humans, to name a few.

However, things like artistic works, business logos, and the written content of books do not generally fall under the patent laws. Instead, they're typically covered by copyright and trademark law.

WHO MAY APPLY FOR A PATENT?

The United States grants a patent only to the first and true inventor or inventors of the subject matter (an invention may be made jointly, provided that each prospective inventor contributed to its conception). The applicant(s) must be people, because corporations and other legal entities are not permitted to apply for patents in the U.S. However, if work that led to the invention is performed by an employee in the course of his or her normal duties, it is possible that he or she may be required to assign his or her rights in the patent to the employer (this is between the employer and employee and is not really a matter of patent law). There are also some extreme circumstances in which a corporation or other interested party may petition the U.S.P.T.O. to allow the patent application to proceed without the agreement of one or more of the inventors.

WHAT TYPES OF PATENTS ARE THERE?

There are three basic types of patents. A **utility** patent is the most common type, and is what most people think of when they use the word “patent.” A utility patent protects an invention's structure and the way an invention works. A **design** patent protects the ornamental design or appearance of an invention (for example, automotive

manufacturers often get design patents to protect how a car looks, and furniture manufacturers may get a design patent to protect how a particular sofa looks). A **plant** patent – the rarest of the three types of patents – protects particular varieties of asexually reproduced plants (for example, hybrid roses).

The remainder of this information pertains to **utility** patents. If you are interested in other types of patents, additional information is available.

HOW LONG DOES A PATENT LAST?

A patent's term is currently 20 years from the earliest claimed filing date. Thus, the term of a patent may vary from case to case. In one common example, if a patent application is filed as a first application and it takes three years before the application becomes a patent, the term of the issued patent will be 17 years. (Laws and procedures are in place to increase the term length of the patent if the U.S. Patent and Trademark Office (U.S.P.T.O.) takes too long in examining it.) Maintenance fees must be paid 3.5 years, 7.5 years, and 11.5 years from the issue date to keep the patent in force.

WHAT ARE THE REQUIREMENTS FOR A PATENT?

There are several requirements for a patent. First and foremost, the inventor must file an application that describes the invention in such complete terms that one of "ordinary skill in the art" could make and use the invention from the description provided by the inventor. Second, the invention must be novel and nonobvious. "Novelty" means that the invention must not have been invented before. "Nonobviousness" means that the invention must not be obvious to "one of ordinary skill in the art" from the literature and patents that already exist. Obviousness can be difficult to evaluate, and is often a case-by-case judgment call, although the courts have provided some standardized guidance over the years.

Another important requirement for obtaining a patent is that the inventor be completely candid and honest with the U.S.P.T.O. during the process of obtaining the patent. The inventor and others associated with the preparation of a patent application have a duty to disclose any prior art (literature, patents, etc.) that might have a bearing on whether or not a patent should be granted.

WHO DECIDES WHETHER I GET A PATENT?

A patent attorney or agent (see below) may initially help you to decide whether your invention is patentable, i.e., whether it appears to be novel and nonobvious. However, the government's decision of whether or not to grant a patent is vested in a patent examiner. There are over 3,000 patent examiners currently employed by the U.S.P.T.O. Each patent examiner is a technical specialist in a particular field, and many of them have experience in industry as well as government. "Primary" patent examiners have the full authority to grant or deny a patent; these are individuals who have been with the U.S.P.T.O. for many years, and whose work has been evaluated for legal and technical correctness. Assistant patent examiners, while not assigned to all cases, are

examiners with slightly less experience who are typically given day-to-day control over a case, subject to review by a primary examiner. Patent examiners are assisted by various types of clerical and support personnel.

WHAT IS THE PATENT ACQUISITION PROCESS LIKE?

Patent acquisition, commonly called patent prosecution, can be a lengthy and resource-intensive process that requires a significant commitment of time and money. In the beginning, it can take 3-6 months to assemble all the necessary information on an invention, study the field to determine whether the invention is patentable, and prepare the application for filing in the U.S.P.T.O. Once a patent application is filed, it may be 14-18 months before the U.S.P.T.O. takes any significant action on it (the U.S.P.T.O. has had a serious backlog of work for a very long time).

When action is taken on the patent application, a patent examiner specializing in the relevant field will search for other similar inventions and, based on his or her findings, will make an initial determination as to whether the application should be allowed to issue as a patent or should be rejected. The findings are communicated in a paper called an Office Action. If an initial Office Action indicates that the application has been rejected, the inventor and/or his or her representative may change parts of the application (“amendments”) and may negotiate with the patent examiner until the final scope of the patent is determined and the patent is allowed to issue or until the application is finally rejected by the patent examiner. The entire process can take three or so years in some cases, although some patents do issue more quickly.

The most disheartening thing for many inventors is to see that their patent application has initially been “rejected.” Most patent applications are initially rejected, and the reasons may or may not have anything to do with the merits of the invention. Oftentimes, if the rejection is argued, or if some changes are made to the scope of patent protection that the inventor is seeking, a patent can ultimately be issued.

WHAT IS A PATENT ATTORNEY? WHAT IS A PATENT AGENT?

Because the patenting process is difficult and requires great knowledge of many arcane rules and procedures, the U.S.P.T.O. has long required that each individual seeking to represent inventors before it be specially licensed. In order to get a license to represent others, an individual must prove that he or she: (a) has scientific or technical training (at least equivalent to a bachelor’s degree); (b) has the requisite legal knowledge (by taking and passing a rigorous test administered by the U.S.P.T.O.); and (c) is of good character, since honesty is such an important part of the process.

A **patent attorney** is a lawyer (i.e., admitted to the general practice of law in a state) who has passed the test and demonstrated the necessary credentials and is thus licensed to represent others before the U.S.P.T.O. Patent attorneys can also assist inventors with many other areas of law, including copyright, trademark, licensing, corporate structures, patent-related lawsuits, etc.

A **patent agent** is a non-lawyer who is licensed to represent others before the U.S.P.T.O. Patent agents must demonstrate the same credentials as patent attorneys and must pass the same test. Before the U.S.P.T.O., a well-trained patent agent can provide the same type and level of assistance as an attorney. However, patent agents may not assist with matters of law outside of the U.S.P.T.O.

Either a patent attorney or a patent agent may be right for you, depending on your individual circumstances. However, if obtaining a patent is the only goal, a patent agent may be able to perform that task more cost effectively than a patent attorney.

WHAT ARE THE COSTS?

There are standard government fees for filing a patent application. These change from time to time and, for a lone inventor or small company, can range to about \$1,100 by the time the patent is issued. There are specific fees, for example, upon filing and issuance of the patent, and other fees that must be paid if specific actions are taken during the process.

However, oftentimes the lion's share of cost comes in the form of the attorney or agent's time in preparing the patent application and shepherding it through the process. A patent application can take between 20-60 hours to prepare, and more time can be spent responding to Office Actions from the U.S.P.T.O. It is not uncommon for lone inventors or small companies to spend \$5,000 or more in the course of getting a U.S. Patent, and large corporations may spend upwards of \$10,000. Note that a U.S. Patent only protects an invention in the U.S.; foreign patents are required for protection abroad, and these, if desired, can add significantly to the costs.

WHAT ARE THE DEADLINES FOR FILING A PATENT APPLICATION?

In the U.S., a patent application must be filed within one year of the date that the invention is first publicly disclosed, publicly used, or sold. After that one-year period expires, all right to a patent is lost. However, if foreign patent protection is desired, many foreign countries do not have a one-year "grace period," and most foreign countries will not grant a patent if there has been any public use, disclosure, or sale prior to filing. Therefore, in most circumstances, it may be a good idea to keep an invention confidential until a patent application is filed. However, a patent attorney or agent can discuss a particular situation with you.

In some cases, a patent attorney or agent will decide that it would be beneficial to file a provisional patent application first. A provisional patent application generally has the same components as a regular utility patent application and serves to establish a priority filing date, but is not examined for patentability. A provisional application remains pending in the U.S.P.T.O. for one year. During that one-year period, the inventor may improve on his or her invention. A regular utility application claiming priority to the provisional application must be filed by the end of the one-year period.

WHAT ELSE SHOULD I KNOW?

It's important to keep in mind that there is no guarantee that a patent will be issued if a patent application is filed. Moreover, no patent attorney or agent can guarantee a client that he or she will obtain a patent.

A patent attorney or agent may recommend that an invention be searched, i.e., compared with the existing patents and literature in the field to determine whether the invention is patentable. This is similar to the searching done by a patent examiner when deciding whether or not to grant the patent. However, the inventor should realize that searching is an art, rather than a science, and that a patent examiner may find more relevant materials than were previously known, even if a thorough search is performed prior to filing the patent application.

WHAT ABOUT INTERNATIONAL PATENT PROTECTION?

The information above pertains to U.S. patents and patent applications. A U.S. patent protects an invention only within the U.S. and its territories. Each country has its own patent law, and inventors wishing to protect their inventions in other countries must apply for patents in those other countries.

An inventor wishing to obtain a patent in another country must file a patent application in that country within one year of the date of filing in the U.S. Similarly, an inventor who has filed a patent application first in another country must file a corresponding U.S. application within one year of the date of filing in the foreign country. If an invention has been patented or described in a printed publication anywhere in the world, that patent or publication can bar an applicant from getting a U.S. patent.

Procedures in foreign countries are often somewhat similar to those in the U.S., and most countries also insist on novelty and nonobviousness for any invention sought to be patented. There are some international treaties, such as the Patent Cooperation Treaty (PCT) that standardize some of the processing and make it easier for an applicant to obtain patent protection in multiple countries.

FOR MORE INFORMATION

U.S. Patent and Trademark Office website: <http://www.uspto.gov/>

To search patents: <http://www.uspto.gov/patft/>

Andrew McAleavey
Registered Patent Agent
(No. 50,535)
510-428-9778
andrew@patentbest.com
www.patentbest.com