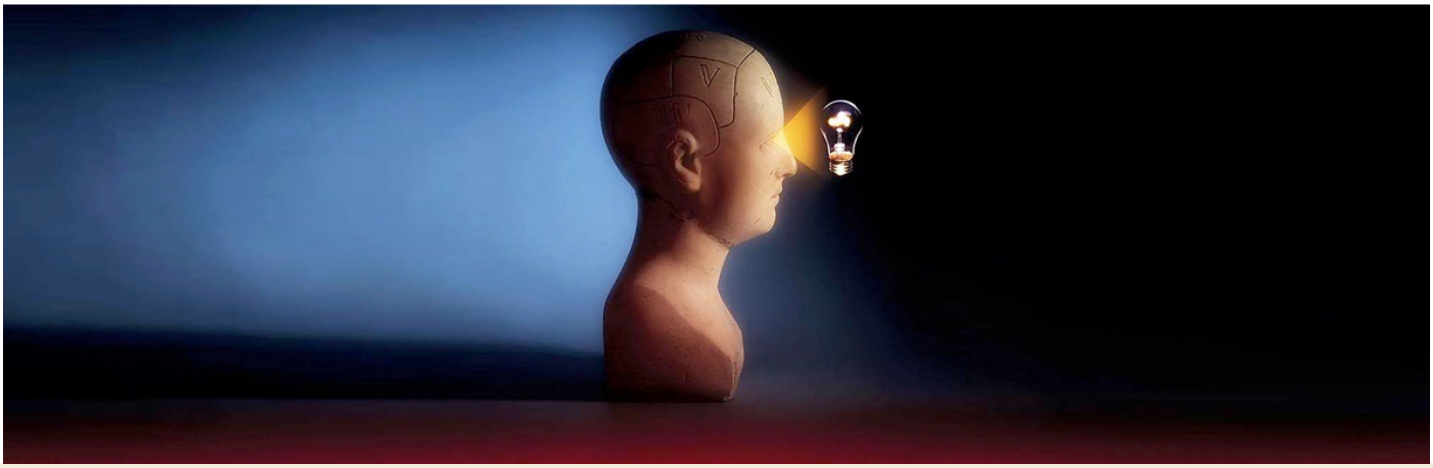
The Patent Professor®

PATENT PROTECTION

A PRACTICAL GUIDE FOR INVENTORS & ENTREPRENEURS

By John Rizvi, Esq.



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Providing a common sense strategy to inventors seeking legal protection for their ideas. Topics covered include distinguishing patent rights from trademark and copyright protection, initial documentaion of an idea's conception, disclosure documents, types of patent applications, prior art searches, provisional patent applications, filing, patent pending status, and the prosecution process. The material is presented in an easy to understand format and viewed from the practical standpoint of the inventor.

Patent Protection

A Practical Guide For Inventors

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I. The Protection of Ideas

Overview of Intellectual Property

How do you protect an idea?

How does one protect a new idea? Protecting other property is relatively easy. If it's money, you put it in a bank. If it's a car, you keep the keys and a title certificate. A bicycle—buy a chain and secure it to a bike rack. Horses, pigs, cattle, livestock—you keep them from wandering with a fence.

But, what do you do if you are an inventor? Or an author or musician? Or in business and want to protect your company or product names? What if your business is on the Internet, and you want to protect your domain name or web content from being stolen? And, what about your company identity? In short, where does one go protect their creativity?

> **I build locks and chains and fences and security alarm systems for the imagination.**
>
> **I specialize in the law of protecting ideas.**

My name is John Rizvi, and I am a U.S. Registered Patent Attorney. I build locks and chains and fences and security alarm systems for the imagination. I specialize in the law of protecting ideas.

Wanting to protect the creations of our mind is nothing new. Let me give you a short example. In 1631 B.C., Shah Jahan, a great Emperor in India wanted to build the Taj Mahal to show his love for his wife. He wanted what every inventor today wants—to prevent someone else from copying his idea. Back then, there were no laws for protecting ideas, so rumor has it Shah Jahan had his soldiers chop off the hands of all the artists and craftsmen who

helped build the Taj Mahal. This way he ensured that there would not be another monument like his during his lifetime. Patent Protection—1600's style!

Taj Mahal

Luckily, today we do not have to resort to assault and battery, manslaughter, or murder to protect our ideas. The law permits us to "fence in," lock, chain, and harness the creations of our imagination. We do it with Patents, Trademarks, Copyrights, Trade Secrets, Unfair Competition Law, domain names, Franchise Agreements, and Nondisclosure Agreements. These different doctrines or legal categories are generally referred to as the protection of intellectual property.

Today, I am going to focus on one particular type of intellectual property . . . **PATENTS**.

Patents, Trademarks, and Copyrights

> **By providing an inventor with the security that he will enjoy the fruits of hard work and ingenuity, patents encourage innovation.**

What is a Patent?

A patent is a right, granted by the United States to an inventor, to exclude others from making, using, selling, and even importing an invention into the United States without his or her permission. In its simplest form, it is a monopoly granted by the United States to an inventor to enable the inventor to exploit his or her creativity. By providing an inventor with the security that he will enjoy the fruits of hard work and ingenuity, patents encourage innovation.

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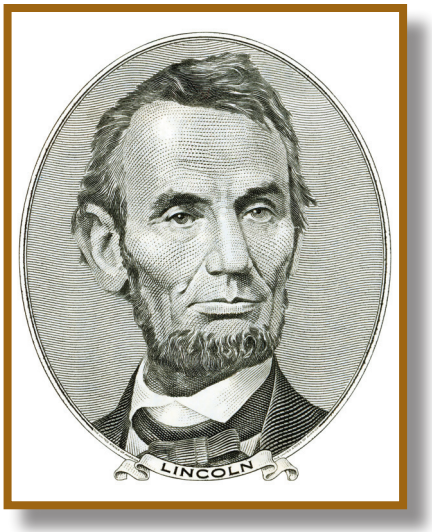
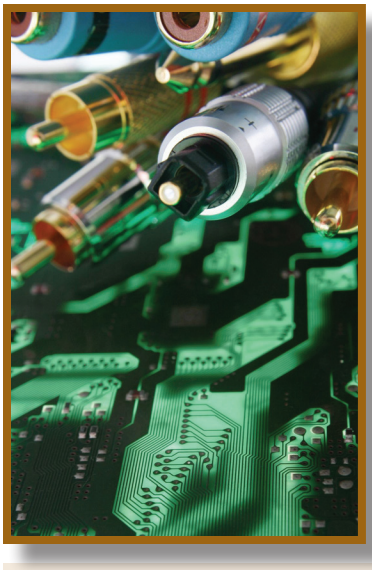
> *The patent system added the fule of interest to the fire of ingenuity.*



Abraham Lincoln

In the famous words of Abraham Lincoln, "the patent system added the fuel of interest to the fire of ingenuity." The founding fathers of our country, for the first time in the history of the world, decided to provide every citizen the incentive to create and invent. They placed great confidence in the inspired ordinary citizen.



They were right. Today, the United States comprises only about 4% of the world's population, yet almost every major new scientific or technological innovation can be traced to American ingenuity. By fueling and encouraging self-interested research and protecting the hard work and creative rights of innovative geniuses, our patent system has encouraged creativity and entrepreneurship and has helped establish the United States as the world leader in new technology and new innovations.

> **Today, the United States comprises only about 4% of the world's population, yet almost every major new scientific or technological innovation can be traced to American ingenuity.**

A patent right is a legal right to limit competition. It is often the most valuable assets owned by a business. Some of the largest corporations in America today were started by individual inventors who decided to seek patent protection and exploit the monopoly granted by the United States government.

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The airplane was the creation of the Wright Brothers, two bicycle mechanics in Dayton, Ohio. The electric light, the creation of a farm boy who never completed high school—Thomas Edison. Whether you are looking at AT&T, Dow Chemical, Goodyear, Eastman Kodak, Xerox, 3M, or Hewlett-Packard—it doesn't matter. The fact is that most of the greatest American innovations started as ideas with very humble beginnings.

There is truth to the statement that TODAYS BIG IDEAS are tomorrow's big businesses.

The fact is that most of the greatest American innovations started as ideas with very humble beginnings.

> **"TODAYS BIG IDEAS are tomorrow's big business."**

Patents are valuable property. Like other property, a patent can be sold outright. Of course, patents can also be licensed. They can be licensed for a percentage of the sales price. Over a billion dollars of patent rights are licensed every year.

How do patents differ from other intellectual property?

Before we look at the different types of patents, I want to distinguish patents from other types of intellectual property. I am frequently asked by inventors to explain how patents differ from trademarks and from copyrights. They are fundamentally different. Lets take a quick look at trademarks and copyrights now.

> **"An example of a service mark is The Idea Attorneys® since it is a registered mark for services—namely, legal services. The KEY is that a trademark identifies the origin or source of a good or service."**

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First, lets look briefly at trademarks. A trademark can be a word, logo, design, or even a combination of these. A service mark is similar to a trademark except that it is used to express the origin of services. Examples of trademarks are Band-Aid® bandages, McDonald's®, and Coca-Cola®. An example of a service mark is The Idea Attorneys® since it is a registered mark for services—namely, legal services. The KEY is that a trademark identifies the origin or source of a good or service. It is valuable because consumers identify the mark with a particular quality of goods or services.

What about COPYRIGHTS? Copyrights protect the literary, artistic, commercial, or other original expression of an idea. Unlike patents, copyrights do not protect the function of a piece. For example, a copyright may protect the look of a screen of a website. A patent, however, would be more appropriate in protecting the way a website works or the specific methodology it employs.

II. Types of Patents

Now, with that brief overview of other types of intellectual property, let's turn to the main event—patent protection. We will start by looking at the different types of patents that are available. These are Utility Patents, Design Patents, and Plant Patents. Plant patents are very rare. As the name suggests, they can only be used to protect newly developed plants. Therefore, my focus during this lecture will be on Utility and Design Patents.

Utility Patents

The vast majority of new inventions should be protected with a utility patent. A utility patent protects the function of an invention. Utility patents are granted for any new, useful, and non-obvious process, machine, manufactured article, or

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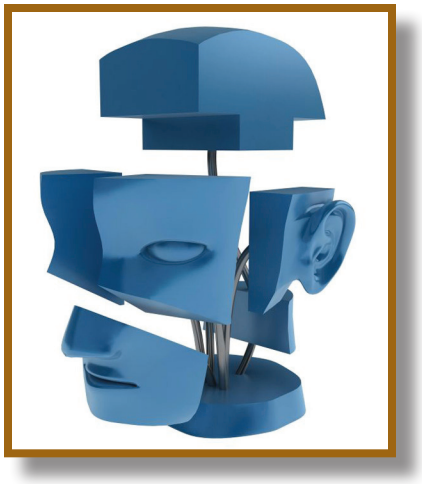
composition of matter. Patents are also granted for new and useful improvements to existing inventions.

> **These are Utility Patents, Design Patents, and Plant Patents.**

How long does utility patent protection last? The term of a utility patent is 20 years from the date of filing. For twenty years, the inventor is given the power to exclude anyone from making, using, or selling his or her invention.

Design Patents

Unlike a utility patent, a design patent is not concerned with the function of an invention. A design patent protects the overall appearance of an invention and is granted for any new, original, and ornamental design. The term of a design patent is shorter than that of a utility patent and is only valid for a term of 14 years from issuance. A design patent should only be chosen if the specific appearance of the invention is important. Otherwise, utility patent protection should be sought.



A design patent protects the overall appearance of an invention and is granted for any new, original, and ornamental design.

> **A design patent should only be chosen if the specific appearance of the invention is important. Otherwise, utility patent protection should be sought.**

Now that we have gone over what a patent generally is and the different types of patents that are available, we can get down to the practical steps an inventor needs to take in order to help protect their ideas.

III. Initial Idea Protection

What Should You Do The Moment You have a New Idea?

There are some things an inventor can do immediately to help protect their new idea. These steps cost close to nothing and give some protection to an inventor before he is able to file a patent application. You do not need a patent attorney in order to complete these initial steps.

Inventor's Log Book

Detailed Record Keeping—I will emphasize this...detailed record keeping. Ideally, this is done in a bound notebook. The first step is to purchase a suitable notebook. You may have heard the term "Inventor's Log Book." This is just a fancy name for a notebook that has permanently bound pages. Professional Inventor's Log Books have green grid-lined paper for drawings and are usually marked "Inventor's Notebook" on the cover. Many inventors spend a lot of money investing in a Professional Inventors Log Book.

This is not necessary. You don't need to spend a lot of money on a professional fancy 'Inventor's Notebook.' Anything that has permanently bound pages is sufficient. I recommend stitched English composition notebooks available at Wal-Mart and other department stores. You may have used similar composition books to write essays in school.

> **You don't need to spend a lot of money on a professional fancy 'Inventor's Notebook.'**

The important thing to remember is to make sure the pages can't be taken out, such as they can in spiral-bound notebooks, loose-leaf binders, or legal pads. You will want to go through and number every page of the notebook if it is not already numbered.

What Do You Do With the Book?

The purpose of the inventors notebook is to keep detailed records of when you first came up with your idea. You will want to record a written description of your invention and a drawing. As you develop your invention, record your progress. It is a good idea to have two trusted friends sign and date your notebook periodically. It is important that they understand your invention and they sign your notebook indicating that they understand it. For example, they may write "read and understood by John Doe, January 1st, 2017." Preferably, the witnesses will not be close relatives, and they will not be someone who has a financial interest in your invention.

Mailing Yourself a Self-Addressed Envelope Does Not Protect the Idea

You may have heard that sending yourself a description of your invention in a sealed envelope by registered mail will document the idea as your own. This is a waste of time and complete NONSENSE. Courts and judges are naturally suspicious of self-addressed sealed envelopes—especially since there have been dishonest inventors that have been known to secretly open and reseal envelopes.

Although this seems like a low-cost way of securing some immediate protection, in reality it does nothing and provides you with a false sense of security.

> **Mailing Yourself a Self-Addressed Envelope Does Not Protect the Idea**

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THIS BRINGS ME DIRECTLY TO OUR NEXT TOPIC–DISCLOSING YOUR INVENTION.

Now, the possibility of having your new idea stolen before you have applied for a patent is something that has haunted every new inventor.

It is important to keep the details of your new idea SECRET until you have at least applied for a patent.

In addition to the possibility of your idea being stolen, there are other potential pitfalls of disclosing your invention before a patent application is applied for.

> **"The possibility of having your new idea stolen before you have applied for a patent is something that has haunted every new inventor."**

Most importantly, prematurely disclosing your invention WILL JEAPORDIZE YOUR ABILITY OBTAIN PATENT PROTECTION.

> **"Prematurely disclosing your invention will jeapordize your ability to obtain patent protection."**

This is crucial and I will say it again. Prematurely disclosing your invention WILL JEAPORDIZE YOUR ABILITY TO OBTAIN PATENT PROTECTION.

In the United States, there are certain deadlines which an inventor must meet in order to avoid the loss of patent rights. One of these is that in the United States an inventor must

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FILE a patent application with the United States Patent & Trademark Office within one year of the first date on which the invention was in public use or sale or described in a printed publication.

Be CAREFUL...the terms PUBLIC USE or SALE and PRINTED PUBLICATION are very broad and encompass an almost infinite variety of circumstances. I cannot over-emphasize the importance of maintaining absolute secrecy when dealing with your invention. A lot of inventors have lost valuable patent rights due to failure to keep their invention secret. Do not show your invention to your friends until a patent application is filed. Certainly do not permit anything to be published about your invention. Many university professors and research assistants have lost patent rights because they revealed their invention in articles, journals, or scientific publications, and even websites.

> **A lot of inventors have lost valuable patent rights due to failure to keep their invention secret. Do not show your invention to your friends until a patent application is filed.**

What if you think you may want patent protection in other countries as well as the United States? If you are interested in foreign patent protection, the need to avoid public disclosure of your invention is even MORE IMPORTANT. In most countries, a patent application must be filed before the invention is in public use or on sale. There is no grace period.

With that being said, what about REVEALING YOUR INVENTION TO YOUR PATENT ATTORNEY

It is important that I point out that revealing your invention to your patent attorney is not considered PUBLIC DISCLOSURE of your invention and you will not jeapordize your patent rights. It is important, however, that you verify that you are dealing with a REGISTERED PATENT ATTORNEY

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who is bound by the Cannons of Professional Conduct and the Attorney/client fidiciary duty. This can easily be verified by checking with the United States Patent And Trademark Roster of Registered Attorneys. For further peace of mind, you may also have your attorney sign a Non-disclosure agreement. I will now discuss what these are.

Non-disclosure agreements

A Non-Disclosure Agreement (sometimes called a confidentiality agreement) is used by an inventor to reveal an unpatented idea to a party. The inventor has the other party sign a document that says they will not disclose any of the information to anyone else, and will not compete with the inventor.

I strongly discourage revealing your invention until you have filed a patent application even if you have a Non-Disclosure Agreement. Non-Disclosure Agreements should be used sparingly and only when disclosure of your idea to another party is required.

It is far better to discuss your invention in general terms and not reveal how it works than to reveal important details and rely on a Non-Disclosure Agreement.

Remember that to enforce a Non-Disclosure Agreement, you may have to go to court. Although you are eventually likely to win, this will cost alot of time and money that should be going towards developing and marketing your product.

You can keep the details of your invention secret yet still satisfy investors and venture capitalists. Remember, they are more concerned with whether your product has marketing potential and consumer appeal than how it works.

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Tell them what it does and how it does it better. DON'T TELL THEM HOW IT WORKS.

A LOT OF INEXPERIENCED INVENTORS BELIEVE THAT THEY CAN SELL LARGE COMPANIES ON THEIR IDEA AND PROTECT THEMSELVES WITH A NON-DISCLOSURE AGREEMENT

-This is a myth.

Most established companies will refuse to sign an individual inventors Non-Disclosure Agreement. In fact, many will only accept new ideas only if they are patented or if a patent has been applied for.

"Most established companies will refuse to sign an individual inventors Non-Disclosure Agreement. In fact, many will only accept new ideas only if they are patented or if a patent has been applied for."

The reason is that large corporations usually have hundreds, if not thousands, of new ideas in their pipeline at any one time and many more in storage. It is logistically uneconomical and impractical for them to know with any certainty that they do not have something similar to your idea already being developed in their research labs.

Instead of signing your Non-Disclosure Agreement, you are likely to be asked to sign a "release" in which you give-up the right to sue the corporation if they later develop a product similar to yours.

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The best protection against having your idea stolen is to establish your date of conception, keep accurate records in your inventors Log Book, and apply for a patent as soon as possible.

NOW I WILL TALK ABOUT PROVISIONAL PATENT APPLICATIONS

Some inventors have heard about a new type of patent application permitted by the Patent and Trademark Office in 1995 called a "provisional application.

There is a lot of misinformation about the provisional application and I would like to help clear some of it up.

Filing a provisional application is cheaper than filing a regular patent application and a lot of inexperienced inventors rush to file provisional applications.

Keep in mind that a provisional patent application will expire after one year! If you do not file a regular patent application within the one year period, your provisional application is THROWN AWAY by the patent & Trademark Office and you will have no legal protection for your invention.

It is important to note that a provisional application is not reviewed by the patent & trademark office, it just sits there until the year is up and then it is discarded. Also, remember that a provisional application CAN NEVER ISSUE AS A PATENT.

Because the costs involved in filing a provisional are low and there is no review of the provisional patent application, many fraudulent marketing companies and document preparation firms with no lawyers on staff will offer to file a provisional application on behalf of unwary inventors who believe the application will give them substantive protection. Because there is no review of this application by the Patent Office, often document preparation companies will file whatever you give them and only

charge a couple hundred dollars for this "service". Be careful, if someone is only charging you a few hundred dollars for a provisional patent application, it is extremely unlikely the application will be properly written and entitle you to a real filing date. You may be paying for a false sense of security.

Having said all that, when is filing a provisional application a good idea?

A provisional application can be a life-saver when you are under extreme time pressure to secure a filing date at the Patent & trademark office.

For example, you want to display your invention at a tradeshow in 3 days and there isn't enough time to file a patent application.

If you use a provisional application under such circumstances, remember that it will be useless after 12 months UNLESS you follow it up with a patent application. It is best not to wait until the last minute to do this.

Other times when a provisional application make sense include protecting ideas that are in the early stage of development and might undergo changes during the following year. With a provisional application, you can include those changes prior to filing the regular patent application at the end of the year.

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When properly filed by a Registered Patent Attorney, a provisional patent application is a safe and secure way of obtaining a filing date and becoming "patent pending" for a year. Ask your patent attorney if filing a provisional patent application makes sense in your case.

When properly filed by a Registered Patent Attorney, a provisional patent application is a safe and secure way of obtaining a filing date and becoming "patent pending" for a year.

V. What is Patentable?

We have now looked at several preliminary steps that an inventor can take to help prevent the loss of patent rights before an application is filed. Now, let's turn to the U.S. patent laws to see just what is patentable.

In the U.S. there are four (4) classes of patents:

1) A machine (any device or apparatus)

2) A manufacture (a manufactured article)

3) A composition of matter (combinationof ingredients—for example, chemicals)

4) A process (a method of doing something—most new Internet Patents fall in this category)

VI. Requirements of Patentability

An invention must be useful, novel, "non-obviousness," and adequately described in a patent application. We will look into each of these areas separately.

Useful

In short, this means that your invention should work. This is fairly simple. Your invention cannot be inoperable.

> **An invention must be useful, novel, "non-obviousness," and adequately described in a patent application.**

Novel

In order for an invention to be novel it must be new as described in the patent law. This means that the same invention has not been known or described by others in this country or patented or described anywhere before its invention by the applicant.

Keep in mind that if the inventor describes the invention in a printed publication, uses the invention publicly, or places it on sale, he/she must apply for a patent before one year has gone by; otherwise, any rights to the patent will be lost.

Non-Obvious

What if the EXACT invention is not shown in the prior art? What if there are small differences that your invention has over what is already known?

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This is where the requirement of NON-OBVIOUSNESS comes in. The patent law does not permit a known invention to be patented.

However, the law goes beyond that.

It also does not permit the patenting of an invention that is so close to something that is old that the differences would be obvious. Obvious to who? Obvious to someone skilled in the art to which the invention pertains.

> **It also does not permit the patenting of an invention that is so close to something that is old that the differences would be obvious.**

This is an over-simplification of the Non-Obviousness standard. Indeed, entire books and treatises have been written on the Non-Obviousness requirement in the patent law and a lot of litigation surrounds this area.

Description Requirement

Under the patent laws, an invention must be adequately described in the patent application in order for the patent to be valid and offer protection.

Because of the strict description requirements, open communication between an inventor and his patent attorney is critical to the preparation of a patent application. A patent application must clearly communicate to a person skilled in the art what the invention is.

> **Because of the strict description requirements, open communication between an inventor and his patent attorney is critical to the preparation of a patent application.**

It ABSOLUTELY must describe how to make and use the invention.

Do not hold back the best way of practicing your invention. Sometimes I will meet with an inventor who is willing to describe most of his invention in a patent application. However, through trial and error the inventor has learned of certain materials or procedures, which he wants to keep secret. This is fatal to a patent. An inventor is required to describe what is called the BESTMODE of his invention—the best way he knows of making and using his invention. An inventor that fails to describe the bestmode of his invention risks having his patent invalidated.

> **An inventor is required to describe what is called the BEST MODE of his invention-the best way he knows of making and using his invention.**

VII. The Patent Search

Overview

First of all, what is a patent search?

Well, it is important before filing your patent application to know if anything like it has been patented before. A patent search is a search of all the patented items in the U.S. Patent and Trademark Archives.

Many inventors have looked for their invention on store shelves, specialty stores, and industry publications. However, this is only the very first step. There are many pre-existing patents for products which have not yet been marketed. These must be searched to see if the inventions described are similar to yours.

Professional Patent Search

A professional patent search is recommended before proceeding with the patenting of your invention. The

most expensive searches are those where a registered patent attorney physically searches through paper patents in the Public Search Room at the U.S. Patent & Trademark Office. Today, many patent attorneys are able to search for patents anywhere in the world by using specialized commercial databases. Costs for such a search are typically $1,500 or so on the lower end and should include an opinion of patentability by a U.S. Registered Patent Attorney.

Most patent searches reveal prior inventions that are close. An experienced patent attorney can determine whether differences between a prior invention and your invention are significant enough to permit a patent to issue on your invention.

> **An experienced patent attorney can determine whether differences between a prior invention and your invention are significant enough to permit a patent to issue on your invention.**

While I recommend having a patent search done by a U.S. Registered Patent Attorney, sometimes an inventor may be able to perform preliminary searches themselves. If a preliminary search reveals that the exact idea already exists, the inventor can abandon the idea without having spent any money on professional searches.

I will now look at several ways an inventor can conduct preliminary searches themselves.

U.S. Patent and Trademark Depository Libraries

Patent depository libraries are an excellent resource for patent research. The United States Patent & Trademark Office has established around 80 depository libraries throughout the United States, with at least one in each state. Many states have several; for example, Florida has a depository library

in Miami, Ft. Lauderdale, Orlando, and Tampa. These libraries have extensive collections of issued patents that can be searched physically. Many of them have qualified department staff who can help you with any questions or problems you are having while you conduct your search.

The Internet

You CAN do a rough patent search on the Internet. I say "rough" patent search, because an Internet search is certainly not even close to being comprehensive, and its reliability is still questioned. However, such searches are an excellent way to increase your knowledge and learn more about the general field of your invention. As long as you do not rely upon the results of the Internet search, they can be a fast, convenient way for inventors to increase their knowledge at almost NO COST.

Now lets turn to the mechanics of performing such searches.

As a start, you will want to go the the IBM Patent Server. This was one of the first online search databases for patents and is still very popular. The URL for that site is www.patents.ibm.com.

The US Patent & Trademark Office website is also an excellent place to search. That URL is www.USPTO.Gov

What if your preliminary patent search turns up your exact invention?

Most patent searches turn up pre-existing patents that are close to their invention. In many cases, the improvement that your invention provides will

still warrant patent protection. An experienced Patent Attorney should be consulted to determine whether your invention is still patentable.

> **In many cases, the improvement that your invention provides will still warrant patent protection. An experienced Patent Attorney should be consulted to determine whether your invention is still patentable.**

Sometimes, a 'knock-out' patent is found by an inventor. What's a 'knock-out' patent? This is a term for a preexisting patent that EXACTLY describes your invention. If you find a knock-out patent, further searching is not necessary because your invention is not patentable.

VIII. Foreign Patent Protection

In today's economy, any discussion of patent law will be incomplete without reference to foreign filing requirements.

Having a U.S. patent will permit an inventor to exclude anyone else from making, using, selling, or even importing their patented invention into the United States. Some inventors, however, are interested in obtaining legal protection for their

> **Having a U.S. patent will permit an inventor to exclude anyone else from making, using, selling, or even importing their patented invention into the United States.**

> **Inventors who anticipate sales of their products overseas will want to consider filing for patent protection outside of the United States.**

invention in countries other than the United States. Inventors who anticipate sales of their products overseas will want to consider filing for patent protection outside of the United States.

Absolute Novelty Requirement

Keep in mind, however, that most foreign countries require ABSOLUTE NOVELTY in order to grant patent protection. This means that if you want to file outside of the United States, any public disclosure of your invention will cause a loss of your patent rights overseas.

Let's compare this to the UNITED STATES: You may recall that for U.S. patent protection, an inventor is given a grace period of 1 year within which to file his application after public disclosure of the invention. This is not the case in most foreign countries—where absolute novelty is required!

International Treaties

What do you do if you're interested in filing a patent application in several countries?

You can file separately in each country; however, while filing a patent application in several foreign countries will establish an applicants right to their invention—filing in each foreign country can be very expensive.

Luckily, international agreements have been established such as the Patent Cooperation Treaty, which allow a U.S. patent applicant to DELAY the filing of foreign patent applications. In some cases, an inventor may be able to delay foreign filing up to 30 months in certain countries while still maintaining rights to his invention.

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By utilizing international treaties, an inventor can evaluate the commercial potential of his product in foreign countries before spending a substantial amount of money on foreign patent protection.

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It is important, however, to first verify that the foreign country is a party to the relevant treaty, convention, or legislation.

IX. The Patent Application

A Utility Patent application must include the following:

1) a specification
2) at least one claim
3) an abstract
4) an oath or declaration
5) a verified statement of small entity status, if such status is desired
6) a filing fee
7) (usually) at least one drawing

Now, let's turn to each of these items in more detail.

Specification

The specification contains a written description of the manner and process of making and using the

invention. It is critically important that the specification be clear and concise so that any person skilled in the art can make and use the invention.

The specification must set forth the 'best mode' of carrying out the invention. The best mode of the invention is the best manner and process of making and using the invention as believed by the inventor at the time of filing. This standard is tested at the time the application is filed. In other words—at the time the application is filed—if the inventor does not disclose the best way of making and using his invention the patent may be invalidated.

> **. . . if the inventor does not disclose the best way of making and using his invention the patent may be invalidated.**

As mentioned before, for this reason it is very important for an inventor to completely and fully disclose his or her invention to their patent attorney.

Claims

The claims are the most important part of the patent application, since they form the basis of a patent infringement suit in court. Like a description in a deed for land, the claims define the scope of protection provided by the patent application. Patents are valuable property, and the scope of the property is determined by the claims. The more general or broader the claim language, the greater protection a patent provides.

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A patent must have one independent claim. The first claim of a patent is usually the broadest claim and is the independent claim utilized to determine whether a competing product is infringing.

Dependent claims are narrower than independent claims because they include additional limitations.

A good patent attorney will initially submit very broad claims with the expectation of narrowing the claims as necessary depending upon the nature of the examiner's rejection and the existing patents cited by the examiner. The examiner's rejection of claims forces an attorney to explain the differences between his client's invention and the referenced prior art. In most instances, the attorney will amend his initial claims to meet an appropriate examiner rejection.

The claim negotiation process between a patent attorney and a Patent and Trademark Office Examiner is an ADVERSARIAL PROCESS. The

The claim negotiation process between a patent attorney and a Patent and Trademark Office Examiner is an ADVERSARIAL PROCESS. The inventor's patent attorney represents the inventor's interest and the patent examiner protects the rights of the public.

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inventor's patent attorney represents the inventor's interest and the patent examiner protects the rights of the public. The examiner's role is to prevent an inventor from obtaining a broader monopoly right than to which the inventor is entitled. The inventor—and the inventor's attorney, of course—would like to obtain the broadest monopoly possible under the law.

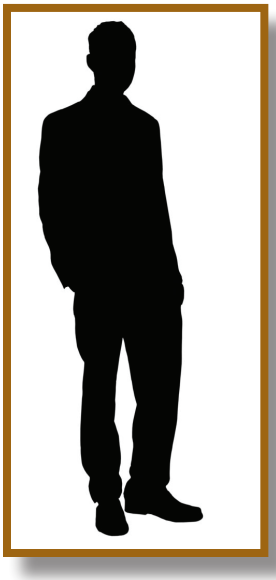
This adversarial system balances the rights of the inventor against the rights of the public. This is done by only issuing patents that have undergone a thorough and exhaustive examination. It is a system that has withstood the test of time and has been proven to work.

Abstract

An abstract is a very short description of the invention. It should be one paragraph and less than 150 words. The point of the abstract is to permit others looking at the patent to understand the essence of the invention without having to read the entire patent.

Oath or Declaration

A patent application must include an oath or declaration by the inventor stating that he believes that he is the original and first inventor of the claimed subject matter.



Verified Statement of Small Entity Status

Many inventors have heard of 'small entity status.' What is it, and what does it do? The Patent & Trademark Office realizes that not all inventions come from large corporations. In fact, the most innovative and progressive inventions of this century have been possible due to the perseverance and ingenuity of individual inventors and very small businesses. Individual inventors are seen as improving the quality of life for everyone. For this reason, the Patent & Trademark Office offers discounted fees for patent applications filed by those meeting small entity status.

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How does one qualify for small entity status?

In order to qualify for small entity status, a patent applicant must be (i) an independent inventor, (ii) a nonprofit organization, (iii) an accredited university, or (iv) a company having 500 or fewer employees.

How much lower are the fees for inventors meeting the small entity status? If an inventor qualifies for small entity status, almost all patent office fees are reduced 50%. This is an incredible incentive for individual inventors and small businesses to obtain small entity status.

It is important to remember, however, that as soon as an inventor's status changes from a small entity, the applicant must notify the Patent & Trademark Office. Past paid fees will not be affected, but all future fees will not be reduced.

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Drawings

Most patent applications include at least one drawing. The drawing helps illustrate the written description so that a person skilled in the art of the invention can read the patent and understand the process of making and using the invention. Remember, the goal of the specification and drawings is to clearly and concisely describe the process of making and using the invention.

> **The goal of the specification and drawings is to clearly and concisely describe the process of making and using the invention.**

We have now covered all the major parts of a patent application.

Once again, those are:

1) a specification

2) at least one claim

3) an abstract

4) an oath or declaration

5) a verified statement of small entity status, if such status is desired

6) a filing fee

7) (usually) at least one drawing

Now, we file the application!

X. Patent Prosecution and Issuance

The first concern many inventors have regarding filing the application is confidentiality. Until now, the inventor has been able to keep his invention a secret from everyone except his patent attorney. What happens when you file?

Well, patent applications are highly confidential. The Patent and Trademark Office will not disclose any information regarding pending applications to anyone without permission from the inventor or owner.

Filing Receipt

Usually within a few months after the application is filed, the Patent and Trademark Office will send a 'filing receipt' to the applicant or their attorney. This filing receipt is important because it establishes a filing date and also assigns a serial number to the patent application. The inventor is now officially in the 'patent pending' stage.

Patent Pending Status

After a patent application is filed with the Patent & Trademark Office, all products should be marked 'Patent Pending' as a warning to potential infringers that a patent application has been filed. This is often a strong deterrent to competitors.

Patent pending status is often helpful in initial marketing efforts, as consumers view patented products as being inherently more valuable. Further, many venture capitalists and angel investors will look for patented products or at least products that have a patent pending before committing funds.

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While a patent is pending, a patent attorney is prosecuting the patent.

Having said that, what exactly does 'Patent Prosecution' mean?

Patent Prosecution is a broad term for the process of getting a patent through the Patent and Trademark Office. As mentioned earlier, the inventor's interest is in obtaining a broad monopoly while the U.S. Patent and Trademark Examiner has a duty to limit the amount of coverage to that permitted by the law.

Patent examiners are assigned to specific groups of technologies so that they become experts in a limited field. For example, a patent application for a golf club may be assigned to an examiner specializing in golf club patent applications.

The patent examiner's job is to review the application and search United States and Foreign patents and any other available written materials to see if the application describes a new and non-obvious improvement in the field. In our example, the field would be golf clubs.

> **The patent examiner's job is to review the application and search United States and Foreign patents and any other available written materials to see if the application describes a new and non-obvious improvement in the field.**

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The Patent Examiner will typically examine a new application within 9 to 15 months after the application is filed.

However, in some cases the applicant can request an expedited examination. In order to have an expedited examination, an applicant must file a petition to make his application 'special' and pay an additional fee.

This additional fee can be waived if the inventor qualifies under some limited exceptions. Some examples of these follow:

1) The inventor is seriously ill

2) The inventor is older than 65

3) The invention has an alleged positive impact on the environment

4) The invention relates to energy or superconductivity.

If the inventor or his or her invention is granted the petition to make the application special, the examination process is substantially expedited.

Office Action

When the examiner has reviewed the application he or she will send the applicant's attorney what is called an 'office action.' The office action describes the examiners decision on the patentability of the applicant's invention.

As I described earlier, it is typical for a patent application to be rejected initially during the patent application process. When presented with a rejection, the patent attorney studies the examiner's referenced patents and looks at the examiner's reasoning. The patent attorney can then formulate legal arguments to counter the examiner's position and amend the claims in response to the rejection. In

some circumstances, a telephone conference may be held with the examiner. This helps the patent attorney and the inventor to understand the nature of the examiner's rejection and to help find common ground and areas of agreement.

The patent attorney then files a response with the United States Patent & Trademark Office. The response is directed to the same examiner and asks the examiner to reconsider his position in light of the attorney's amendments and legal arguments.

Notice of Allowance vs. an Appeal

At this stage, the examiner may send a second office action deciding to grant the application and issue a 'NOTICE OF ALLOWANCE.' He also may decide to issue a 'FINAL REJECTION.'

If the examiner issues a Final Rejection, the applicant has the option of appealing the decision.

Where a Notice of Allowance is issued, the patent applicant will be issued a patent upon the payment of an issue fee and will receive notification of when the patent will be printed. On the grant of the patent, the patent file becomes open to the public and the abstract of the patent is printed in the Official Gazette. This is the official publication of the Patent and Trademark Office and is printed weekly.

Marking

Once a patent is issued, every product protected by the patent should be clearly marked with the patent number.

This puts potential infringers on notice that your product is patented. An infringer who has notice of your patent rights is subject to a finding of 'willful infringement' and can then be held liable for increased damages when you bring an infringement lawsuit.

> **Once a patent is issued, every product protected by the patent should be clearly marked with the patent number.**

Of course, some products cannot be marked directly. For example, if you invent a special type of salt or powder, you can't really mark a patent number on the patented product. In such cases, it is important to mark the packaging and sales material accompanying the product.

Finally, remember that in order to keep a patent in force, maintenance fees must be paid after 3-1/2, 7-1/2 and 11-1/2 years from the date the patent is granted.

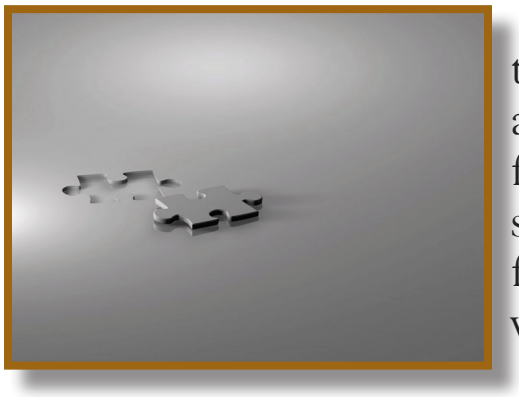
XI. Quick Review

Before I conclude this lecture, I just want to finish up with a quick review of some 'dos and donts' that we have already discussed in more detail.

- Do keep good records detailing your inventive efforts.
- Do purchase a bound notebook.
- Do not mail a description of your invention to yourself.
- Make sure you file a patent application as soon as possible.
- You must fully disclose your invention to your patent attorney.
- Do not disclose your invention to anyone else until a patent application has been filed.
- Be very careful when dealing with invention promotion companies.
- Do not publicly use, sell, or write about your invention before a patent application is filed.

- Think about whether or not you would like foreign patent rights.
- Be very selective about using Non-Disclosure Agreements.
- Make sure you understand the limitations of a provisional application.
- Become familiar with the closest Patent & Trademark Depository Library to your home.
- Consider doing a no-cost patent search yourself on the Internet.
- Remember that free Internet searches are for rough background information only. Never rely on a free Internet search.
- After your patent application is filed, mark your product 'Patent Pending.'
- Take advantage of the reduced fees offered to 'small entities' and individual inventors. (Check and see if you qualify.)
- Explore whether or not you may be eligible for expedited examination.
- Do not be alarmed if your patent application receives a first office action rejection. Work with your patent attorney in countering the examiner's arguments.
- After your patent is granted, mark the patent number on your product.
- And finally, be careful not to miss your maintenance fee due dates.

XII. Conclusion



This brings me to the end of my materials for this lecture on patent protection. I have looked at the law regarding the protection of inventions from the practical standpoint of the inventor. I strongly believe that a person has a right to profit from their ingenuity and that their ideas and inventions should not be subject to theft.

It truly has been a pleasure for me to compile and present this lecture, and I hope you find it to be helpful as you navigate the patent application process.

If you have questions or comments about the patenting process or your own invention, or you would like to receive an email notification as follow-up information becomes available, I encourage you to email me at JohnRizvi@ThePatentProfessor.com

I look forward to hearing from you. In the meantime...

Keep inventing and keep innovating.

Thank you.

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