

Patents Exposed

A Complete Crash Course for Inventors



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Introduction

Mankind has been inventing since its beginnings. The wheel, fire, arrows...I'm sure you've heard of them.

It wasn't too long after these novel, useful inventions were created that society began rewarding inventors for their creativity. It's true, even early inventors were rewarded for their inventions.

Fast forward to today. The United States Patent Office alone has approved of over 6 million patents since its inception in 1790. Many of these patents were granted during or after the 19th century, sparked by the industrial revolution. A great deal of ideas was flowing then as well as today. And you can bet on new revolutions in the not too distant future bringing in even more new inventions.

But it isn't too late, not everything has been invented. Nor will that time ever come (or I can't imagine it at least). Imagination and creativity can always build on old ideas, transforming them into new ones. Think about all the advances in medicine, the biotechnology revolution, the computer revolution, the internet revolution. New inventions are hiding out in each of these broad areas.

The US Patent Office allows new types of inventions to be patented where they never were before. New, untapped areas of human creativity abound where it wasn't even a possibility before. You just need to seek them out! Software can now be patented, as

can methods for doing business on the internet. The possibilities are endless for the creative mind.

Where this book comes in

This book is not a get rich quick guide. It is not even a do it yourself patent kit! What it will accomplish is to show inventors just like you how to best protect your ideas. As an inventor, it is essential for you to learn about the patent process, even if you use a professional patent practitioner. You alone are ultimately responsible for ensuring that your invention stays yours.

Please keep in mind that this book is not legal advice or a supplement for it. You must meet with an attorney in order to gain legal advice.

Setting the Stage

» Why Bother with a Patent at all?

- Thieves
- The ticking clock

» Who is Involved with Patent Law?

- Inventorship
- The USPTO
- Patent examiners
- Patent practitioners
- Power of attorney
- Owners and assignees

» Where does Patent Law Come from Anyway?

Why Bother with a Patent at all?

As you will see, gaining a patent is an expensive and time consuming process. First, you must write a well-crafted patent application and file it along with a substantial application fee. After this, your application will enter the examination stage (also known as the prosecution). During this examination stage, you must patiently wait for an examiner to decide if your invention qualifies for a patent. You will probably need to re-file paperwork and you may possibly even need to send in more fees.

With every turn, your application may be rejected. Unfortunately, the Patent Office won't refund your filing fees in the event that it is rejected. Plan to spend money and plenty of your time waiting and hoping for the news that your application will be accepted as a patent.

With all this trouble and the high level of risk, you would think there must be something fabulous gained by obtaining patent. Or is there? The fact is, after obtaining a bona fide patent, you will be granted a special property right to your invention. It's called an intellectual property right (people own cars and real estate, why not ideas too?). This property right is granted by the all powerful United States Patent and Trademark Office (USPTO or sometimes just PTO).

So, just what is gained by this intellectual property right? Well, a common misconception is that patents grant the right to make, use, offer to sell, sell or import the invention into the U.S.

Sorry, but this is incorrect.

A patent actually grants the owner the right to *exclude* others from all of these activities. Therefore, a patent owner has the right to *exclude* others from making, using, offering to sell, selling or importing the invention into the U.S. For example, if a patent owner discovers that an unauthorized individual is making and selling his or her patented

invention, the owner may sue in an infringement case. Hey, it's the American way.

In the event that you are granted a patent, you will need to fully disclose all the secrets of your invention. Not only that, but all these secrets will be fully and freely available to the public. Everyone and anyone will have access to your invention once it is patented.

The advantage is that once your invention is patented, no one will be allowed to make, use, offer to sell, sell or import your invention into the U.S. other than you. You will essentially be granted a monopoly on it. You will control the production and sales of your invention, and therefore, you will make the profits.

Thieves

So just who enforces these patent rights? Due to the trouble, expense and the risks involved with gaining a patent, you might be lulled into thinking that the government will be there to lend you a helping hand when it comes time to enforce the rights your patented invention.

Sorry, but once again this is incorrect.

In reality, once a patent is issued, the inventor or patent owner (i.e. you!) must enforce the patent without the aid of the USPTO. So, if your patent is infringed upon, it is all up to you to finance any lawsuits that may arise.

No one will be there to police other companies from making or selling your invention. You will have to keep a sharp eye out on your own. Luckily, the U.S. legal system is set-up so that you may always retroactively sue for damages. That means if you don't catch these thieves in the act, you might still be able to initiate a lawsuit against them and have them tried in a court of law later. As you are probably aware, infringement cases are common; you can hardly turn on the news these days without hearing of a legal battle between big corporations.

The ticking clock

There is a limit on your own private little monopoly. Your patent rights will only last about 20 years and then that's it, they're gone. And once your patent rights have ended, you may no longer exclude others from making, using, offering to sell, selling or importing your invention to the U.S. That means another company may come along and legally manufacture your invention and sell it to whomever they wish, keeping any profits for themselves.

Just remember that even with the restrictions placed on patents, many people have made it big with their inventions. And you have every reason to believe that you can too. If you've come up with something that is unique, useful and marketable, you should definitely seek patent protection for it.

Now that we've exposed you to some of the cold, hard facts about patents, let's put these risks behind us and forge ahead. After all, the most worthwhile things in life are never easy!

Who is Involved with Patent Law?

Inventorship

The most basic player in the role of patents is the inventor. He or she is the person inventorship is granted to. Inventors and inventorship sound like pretty easy topics to grasp, don't they? And thankfully, they are.

Simply put, inventors are the individuals who have invented the subject matter in the patent application; i.e., YOU! You have dreamt up an idea, (a.k.a - your invention) and produced it into a real, tangible object. Therefore, you are the inventor. You are still considered the inventor even if you have someone else make your actual prototype for you as long as you came up with the idea yourself.

Now for the technicalities. For starters, a single individual or even a group of individuals may hold the inventorship of a patent. However, corporations or other such entities never qualify for inventorship, only the people within these entities.

If more than one inventor is responsible for inventing the invention, inventorship will be granted to both of them. Joint inventors may work together as a team or they may work entirely isolated from one another. One inventor may work on one aspect, while another works on an entirely different aspect of the invention. Oddly enough, joint inventors needn't have even known each other or what the other was working on at the time they were developing their invention!

Inventors may invent something as simple as the paperclip or as complicated as a rocket propulsion system. Either way, once their invention is complete and in working order, an inventor may apply for a patent with the United States Patent and Trademark Office (USPTO). When and if the inventor applies for a patent, they will also be considered the patent applicant.

The USPTO

This sub-branch of the Department of Commerce is located in Arlington, Virginia; just a hop, skip and a jump away from the White House. In addition to the vast library archives of patents they have housed there, the USPTO also has an active component to it. This component includes the departments involved in receiving, processing and examining new patent applications. The individuals responsible for examining patent applications are known as the patent examiners.

Patent examiners

Patent examiners are fairly well paid individuals who scrutinize the patent applications assigned to them, ultimately determining whether or not the application is worthy of a patent. Examiners check the invention in regards to previous inventions and scour all sorts of reference materials to determine whether the invention is new, or as they like to put it, novel. Of course, if the idea isn't novel, it doesn't qualify for a patent.

Examiners also decide whether or not the invention is patentable and nonobvious, but we'll get more into that later.

Patent Practitioners

No matter how wonderful your idea is, you will not gain a patent if your application is not satisfactory and up to standards (and just what else would you expect from a government agency?). The process of determining whether or not an application is worthy of a patent is called the prosecution or examination of the application.

The examination of your application is initiated after an examiner has been assigned to and begins reviewing your application. Once the examiner has thoroughly scrutinized your application, he or she will send a complex bundle of paperwork back to you rejecting your application (yes, in all likelihood it will be rejected at first even if a professional helps you file it). This paperwork will describe all the faults the examiner could find with your application.

Now, after you receive this "rejection" paperwork, you will be expected to send an appropriate reply countering all the faults back to the USPTO within a set time period. If you do not at least attempt to counter the faults and send in your reply, your application will no longer be examined and you will lose out on the patent! The USPTO doesn't mess around.

So not only does the application need to be written, but the rejections must be countered by specific, fairly short deadlines. This is one of the main reasons many inventors decide to hire an individual skilled in patent law; a registered patent practitioner. The business of getting a patent is complex and often there is quite a bit at stake. Hiring a professional to help write and handle the replies for the patent application is well worth it for many inventors.

Here's something most inventors don't realize. There are actually two types of patent practitioners; patent agents and patent attorneys. Both have the proper skill set,

which involves technical training and experience in either science or engineering. Both have passed a qualifying exam known as the Patent Bar exam and both may write and prosecute patents. This means they may aid you by writing your patent application and helping you reply to those nasty bundles of paperwork the examiner will send out.

The only thing that separates a patent attorney from a patent agent is a law degree. Patent attorneys have completed a law program and may practice in regular courts of law in addition to the special courts of the PTO. Therefore, a patent attorney may help you protect and uphold your rights once you receive a patent. For instance, if you are granted a patent, and later you need legal help protecting your patent in an infringement case, you will need a patent attorney. Because of these extra services, patent attorneys usually charge more than agents, although a particular inventor may not ever need them.

Therefore, if you are just getting ready to file your patent application, you may want to consider using a patent agent. In all likelihood, a patent agent can save you considerable amount money and get the job done just as well. If you ever find yourself in the middle of an infringement suit, you can always find a patent attorney when and if that time comes. We'll talk more on tips for selecting your patent practitioner in a later chapter.

Just so you know, you don't have to hire a patent practitioner to help with the writing or prosecution of your application if you don't want to. You may gleefully attempt to get a patent all on your own. Applications that are sent in without the help of a patent practitioner are termed "*pro se*" applications. Many of these applications are granted each and every year. The PTO will not penalize you for attempting to get a patent all on your own as long as you send in an acceptable application.

So you will have to learn the ropes, and stay on-top-of the process, but it can be done. Since patent practitioners help inventors write patents for a living, you can probably expect the quality of your application to be higher if you use a professional. And we'll talk more about this later.

Keep in mind that only registered patent practitioners may help you write and prosecute your patent application. Individuals who are not recognized patent practitioners are not allowed to help inventors with the patent process (and why would you want them to?).

The Power of Attorney

A registered patent practitioner (even an agent) may act as your power of attorney during the patent examination process. In addition, if a group of people hold the inventorship of your invention, you may choose to select one of the inventors to act as the power of attorney in matters concerning the invention.

This option was set-up to help simplify the process for inventors like you. An agent, attorney or inventor acting as the power of attorney may sign certain paperwork for you, authorize withdrawals from your deposit account, and will receive all the correspondence concerning your application from the USPTO.

The power of attorney will be entirely responsible for replying to the USPTO within the proper deadlines. If you grant the power of attorney to someone else, that means you won't have to worry about accidentally mistaking an examiner's reply for junk mail!

Now, just so you know, it is always possible to revoke the power of attorney if things aren't going well. If you hire a patent practitioner or select an inventor from within your group and discover that they are not doing a good job, you are not obligated to continue using their services. By all means, "revoke them" if you are not satisfied.

Reciprocally, the acting power of attorney may choose to withdrawal from their responsibilities provided he or she follows the proper procedures, which includes giving you sufficient notice.

Owners and Assignees

Ownership is something altogether different from inventorship. The ownership of a patent or a patent application is always held by the inventors unless they have “assigned” the invention over to another party in what is known as an “assignment”.

Patents may be bought and sold just like any other type of property (be it real estate or an automobile). Therefore, these assignments may be made to an individual or to a corporation. Whomever the assignment is made to is called the assignee. If all the patent rights are assigned, the inventor(s) will generally lose all their privileges to the patent.

Corporations or even individuals have often paid large sums of money for the ownership rights to a patent they see potential in. As an inventor, you may be interested in finding an assignee at some point during your patent’s lifespan. And speaking of which, assignments may be made at any time during the life of the patent or even before a patent application is ever filed.

Regardless of when they are made, assignments must be recorded with the PTO in order to be recognized by the PTO. That means you must file official documents referring to the assignment. If there is no recordation of the assignment to the PTO, it is assumed that none exists, and this may cause trouble down the road. The inventor will always be considered the owner of the patent rights unless there is a recorded assignment.

Where does Patent Law Come from Anyway?

Patent Law is a very dynamic and complicated area of the law. These laws come from the laws and rules established by the USPTO, which is a division of the Department of Commerce. All the in's and out's of these laws and rules are explicitly written and described in the Manual of Patent Examining Procedure (MPEP). The MPEP is several thousand pages long and it references many of the official rules and laws established by the Patent and Trademark Office (PTO).

There are two sources for the laws and rules covered in the MPEP. The first is described in "United States Code Title 35 - Patents". The second source includes the rules described in the "Code of Federal Regulations - Patents, Trademarks and Copyrights". As far as patent law is concerned, you only need to worry about the Regulations covered in the Patent section of the code.

The MPEP includes all the relevant laws and rules you need to know in order to gain a patent. Within it, every angle of each law and rule is covered, in addition to the forms used to file a patent application. The writers of the MPEP have also made sure to fill it up with important court case citations used over the years to help establish the laws and rules of the Patent Office. I doubt the MPEP is something you really want to read, but you should at least know it exists.