

Patenting Your Product or Process

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If you are in the business of thinking up new products or processes, or even if you are just a back-yard tinkerer, consider obtaining patent protection for your inventions.

What a Patent Is - And Is Not

A patent is a form of protection for intellectual property, which is property generated by human thought and invention. Other forms of intellectual property include copyright and trademark.

Patents provide their owners with an exclusionary right. They grant 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, and, if the invention is a process, ... the right to exclude others from using, offering for sale or selling throughout the United States, or importing into the United States, products made by that process," 35 USC 154(a)(1). A patent is not the exclusive right of the patent owner to make, use, offer for sale, sell, or import the invention or products made by using a patented process; rather it is the right to *exclude others* from doing so.

A patent is personal property. It can be bought, sold, given away, or licensed. It can be hoarded. The patent owner does not have to practice the invention to keep the protection afforded by the patent.

Types of Patents

Patents come in three basic varieties.

Utility patents are what we usually think of when we think of patents. The utility patent protects "...any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof," 35 USC 101. Utility patents protect most inventions. A utility patent usually expires 20 years from the date the patent application was filed, and it is not renewable.

Plant patents protect new plant varieties (except tubers) that can be reliably reproduced asexually and that do not occur in nature. A plant patent expires 20 years from the date the patent application was filed, and it is not renewable.

Design patents protect ornamental designs that serve no useful function on otherwise useful devices. A design patent expires 14 years from the date the patent issues, and it is not renewable.

Why Your Business Needs to Hold At Least One Patent

Patents are valuable commodities. A small company with at least one patent (and preferably a patent portfolio) is almost automatically a more attractive investment

for venture capitalists and market investors than is a company that holds no patents. Even banks have been known to take an interest in a patent or a patent portfolio as collateral on a loan. Thus, patent protection can make marketing or research and development significantly easier because funding becomes easier to access.

Patents can become a source of significant income to their owners. Licensing fees paid to patent holders for the right to use the patented technology have turned small companies, or even individuals, into major players within their industries.

Obtaining A Patent

Although the US Patent and Trademark Office (USPTO) accepts patent applications from unrepresented inventors, writing a worthwhile patent application is a skill that is honed with practice. It therefore behooves the inventor or company to hire a registered patent practitioner to develop the patent application in cooperation with the inventor. Patent prosecution (the process of developing the patent application and shepherding it through to issuance as a patent) is a specialty within the legal and scientific/engineering professions.

To obtain a patent, the inventor applies to the USPTO and pays the requisite fees to have the application examined. If the examiner agrees that the invention is novel, useful and non-obvious, and meets the standards for patentability set out in the statutes and regulations that govern patents, then a patent will issue on the invention.

The Patenting Process

When an inventor develops a novel, useful and non-obvious invention, she must reduce that invention to practice before a patent application can be submitted to the patent office. Years ago, "reduction to practice" meant building a model of the invention. Today, the patent application itself can serve as a constructive reduction to practice of the invention, so long as the application tells the reader how to make and use the invention.

Once the invention has been reduced to practice, an application is sent into the USPTO. If desired, this application can have the effect of filing a patent application in approximately 90 countries. This does not actually file the patent application for examination in all of these countries; you must eventually select the countries where you wish to have the application examined and have a patent issued. You may select to have only one country examine the application (if you file in the US, you should select the US), or any combination of all of the countries. You must pay examination fees in each country you select.

The USPTO initially examines the patent application for defects. If a part required by statute or regulation is missing, the USPTO rejects the application entirely. If a part that is needed but not required is missing, then the USPTO grants a filing date but sends the applicant a notice requiring that the defect be cured before the patent issues.

The application is then assigned to a patent examiner, who works with the applicant's representative to determine the exact metes and bounds of the invention. This process is time-consuming, often taking several years to complete. When the examiner is satisfied that the patent application claims the invention properly and

the invention is patentable, a patent will issue upon payment of issue fees and correction of any outstanding defects.

Patent Considerations

The following is a list of some of the more common problems with obtaining a patent on an otherwise patentable invention. This list is not all-inclusive.

A patent cannot issue in the US if the invention was patented or published in any country, or in public use or on sale in the US, more than one year before the filing date in the US. Ideally, you should therefore submit a patent application to the USPTO before publishing the invention in any country (including on the internet) or putting the invention on public use or sale in the US.

A patent cannot issue in the US if you file for a foreign patent or inventor's certificate more than 12 months before you file your US patent application. If you file a patent application in a foreign country and wish protection in the US, you must file the US application within 12 months of the foreign application.

You cannot file for a patent on an invention that you did not make yourself. That invention may be patentable, but it is patentable to the inventor or inventors only.

You cannot file for a patent once you have publicly abandoned the invention. If you publish that you dedicate your invention to the public, it is no longer patentable.

Most inventions dealing with atomic or nuclear reactions are not patentable.

You should consult a registered patent practitioner with any questions about the patentability of your invention and to see the invention through the patenting process.

You can find more information about patents at www.USPTO.gov.

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