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Dear potential client:

Please take this time to read my full patent-process primer. It is accompanied by summaries in outline and flowchart format.

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I. Types of patents

There are three kinds of patents.

A. Utility

A utility patent protects how an invention is put together and what it does. It describes components, connections, methods of manufacture or use, etc. Common categories for utility patents are mechanical engineering (bicycle or car parts), computer technology, and household gadgets. A utility patent is legally defined by words and drawings in conjunction, especially the written "claims" (see below).

B. Design

A design patent protects an invention's looks only. If you invent a clock that looks like a sunflower, you can get a patent on that sunflower design even though you obviously cannot patent "the clock". Think of it as a 3D tangible logo. Common categories for design patents include clothing and shoes, lamps, and toys.

A design patent is defined entirely by its drawings. The drawing requirements are still more strict for design patents than utility patents, so I recommend that you work with a lawyer on your design drawings.

For many simple gadgets, the utility and design go hand-in-hand. For example, I had a client come to me hoping to invent a spatula with two necks, which would strengthen the utensil for flipping heavy food items. The utility of this invention is completely tied in with its physical structure. In this case, I often suggest submitting applications for both a utility patent and a design patent. (In his case, we never did follow up with that application for other reasons).

C. Plant

If you breed a new hybrid plant, you can get a patent on that. I have never seen one in my office, but with the loosening of marijuana laws it could become more popular in coming years.

D. "What about a 'provisional patent'?"

I put this in quotes because it's commonly misunderstood. The "provisional" is not a type of patent but a type of *application*. A provisional application for patent is approximately a 50% complete application. It will provisionally become a patent application, provided that you complete it within a year. Many inventors are attracted to the provisional application, especially those anxious to pitch their product to licensees and investors. It earns you the coveted "patent pending" status (though this is not as protective as inventors think it is; see below) before committing to the full cost of the patent application. It also tends to be an attractive choice because a provisional application does not have to include claims or comparisons to prior art, which are the lawyer's contributions. It is something that an inventor could theoretically write and file by himself. For some inventors, that makes a provisional application very inexpensive. That being said, most inventors are not trained writers or draftsmen, and homemade provisional applications tend to be overly simplistic, non-descriptive, and / or vague. That can hurt you, because you can't suddenly add new features in the non-provisional application.

The decisions and costs involved in a provisional application are highly variable, so we must discuss your personal situation in a consultation before I can advise you on this option. I've had some clients write and file their own. I've done others at half the cost of a regular application. In many other circumstances, I have urged my clients not to file a provisional application at all.

The main thing to remember is that you must complete your application by filing a non-provisional follow-up within a year, or else you lose the chance to patent it forever. Thus, you will end up paying for both the provisional AND non-provisional applications. This might sound like simply spreading out your cost over time. It's not always that simple. An important part of my job is to compare your product to "prior art" (previous ideas). As we get familiar with the prior art, it usually changes our idea of what is patentable about your product. This can involve a fair amount of rewriting. The one-year deadline is another important consideration. A year feels much longer in the future than in the past. For many inventors who are short on time and / or money, that year can come and go before they're ready to continue, and they blow their chance to patent their invention altogether.

II. What a patent is and does

Part of this report's purpose is to educate you as to what a patent is for and how it is put together.

You do not need a patent to make or sell a product. You do need a US patent to stop others (infringers) from making, importing, or selling your product in the US. You would need a Chinese patent to stop others from making, importing, or selling your product in China. Before you can get a patent, of course, you must have invented "it". I put "it" in quotes because an inventor is usually not perfectly clear on exactly what "it" is – exactly what he has invented. The way an invention is described legally in claims is never the inventor's own description. You may have thought of an invention independently, but if anyone else has ever disclosed it in the past, it is not yours to claim. Usually, we can only claim part of the invention, or a narrower or more specific form than the inventor had hoped for. To determine exactly what you have invented, your idea is compared to "prior art" – essentially, everything that came before.

A patent essentially comes in three parts: the specification, drawings, and claims.

A. Specification

The specification is a written description, either in plain English or using the technical jargon of the appropriate field of technology, but not legalistic. The specification explains how your product works and how it is different from the prior art, but it does not legally define the invention. It is helpful to be very inclusive in your specification. Anything in your specification or drawings will prevent future parties from *patenting* the same thing. However, it does not prevent anyone else from *counterfeiting* your product in the US.

B. Drawings

Drawings are required insofar as they are necessary for an understanding of the invention. Many home inventors are able to provide their own drawings. The USPTO is getting increasingly liberal about its format requirements, but the drawings should at least be reviewed by an attorney. I work extensively with drawings to make sure we are pointing out all the important features consistently.

C. Claims

Claims provide the legal definition of your invention. Most patents have several claims. Each claim stands on its own. That is, if your patent has three claims, then there are three alternative ways to define your invention. Your patent would then bar others from counterfeiting any of those alternatives. We write numerous claims in your patent application because we don't know which one(s) the patent examiner will allow. Claims should strike a balance and not be too narrow or too broad. If the claims are all too broad, the USPTO is likely to reject the application. If the claims are all too narrow, then there isn't much of a bar against future counterfeiters. Writing claims is the most important reason you hire a patent agent or attorney. I may sometimes discuss claims with my client, but I will have the final say on how to write them. Clients do not have the training to properly construct claims, and often a client's intuition is exactly opposite his own best interest. My sole exception is that I will permit a client to write one "dream claim" to describe the invention as he sees it.

The claims in a patent determine whether future products infringe that patent. If your product is already described in any one claim of any active US patent, then that patent holder will have the right to sue you for infringement when you make, sell, or import the product into the US. If a future competitor makes a product that is described by any one of your patent claims, then you can sue that competitor for infringement.

D. The application process

The application process takes about two years. You can label your product "patent pending" immediately after you file your application. Your patent application will be published a few months after you file it. Prosecution and patent issuance take place about 1 – 2 years later (see below). After your patent issues, then you'll have the right to sue all infringers. That includes retro-infringers, going back to the date your application was published.

III. Patentability and Prosecution

Now that you know what a patent is and what it does, how do we know if the USPTO will grant your patent application? You must meet four legal requirements. You must demonstrate that your idea is patentable subject matter (this is addressed in 35 USC 101), that it is a novel (102), non-obvious (103) improvement over the prior art, and that you can describe it clearly enough to enable someone to make it (112).

The USPTO's official response to a patent application is called an Office action. Most Office actions raise "objections" to some or all claims on the basis of sections 101, 102, 103, and / or 112 above. We then get to present arguments to overcome those objections. Whichever claims get approved the first or second time are then accepted in the issued patent.

A. Patentable subject matter (101)

A patent may protect a "process, machine, manufacture, or composition of matter." It must be man-made; you cannot patent abstract ideas, laws of nature, or existing products such as trees or sunlight. The 101 requirement is most relevant for inventions that are purely software, e.g. "apps". The USPTO sets a high bar for software to rise above "abstract ideas". Some foreign patent offices expressly forbid the patenting of software.

B. Novelty (102)

To be patentable, your invention must be "novel." An invention will not be considered novel if the *identical* invention has already appeared in a *single* prior art reference. This requires a search of the patent art. The better you can describe the prior art to me, the more money you can save in my patent search!

In order to be novel, an invention must also be "new." In particular, it must not have been in the public domain for more than one year.

C. Obviousness (103)

Beyond novelty, your invention can be patented only if it is "non-obvious." This means, legally, that it cannot be a simple combination of previously existing prior art that would be obvious to a person of ordinary skill in making similar products, if he had knowledge of all prior art at the time the invention was made. In other words, your invention must involve something new and / or improved over previously existing ideas, and even simple combinations of those ideas. You could accomplish this by *adding, removing, modifying, or combining* features of previous inventions, especially in ways that give rise to "unexpected results".

Obviousness is (obviously) related to the complexity of the invention. Simply combining two unrelated ideas into a single product (say, a "blender lamp") is usually considered obvious. A non-obvious invention might combine two related ideas with synergy (a Breathalyzer car key), three or more elements (a blender lamp clock), or two elements that nobody thought could be combined (square wheels). The more specifically your product is defined, the more unique and non-obvious (and hence patentable) it is, but the harder it is to protect.

The simpler your invention is, the more obviousness becomes an issue. Many simple inventions end up being so narrowly defined that it does not justify the cost of the patent procedure.

D. Enablement (112)

You must be able to describe not only what your invention does, but how it does it. An unsupported idea about an invention's purpose is not enough to earn a patent. We need to disclose enough details to enable someone who is skilled in the art of making similar products to bring your plans into practice. The more high-tech your invention is, the more enablement becomes an issue. It is very easy to fully enable a designer to make a spatula. It takes much more work to enable the design of a complex app or something with many moving parts. The bar would be extremely high for "revolutionary" or "magic" products like Star Trek transporters or mind-reading helmets. The ideal inventions are those right at the outer envelope of current technology.

E. The "Dennis the Designer" model

To summarize patentability, think of your target audience as Dennis the Designer. He is a skilled worker in your field of art. Which conversation are you having with Dennis?

> You: "Dennis, please build me a device (or app) that does _____" (summarize the purpose of your invention in one sentence).
> Dennis: "No problem; I have just the solution for that."

Problem: Oops, your invention is too obvious and fails under 103.

You: "Dennis, please build me a device (or app) that does _____" (summarize the purpose of your invention in one sentence).
Dennis: "Wow, that would be a challenge. I wouldn't know how to accomplish that. Can you give me some more details about how it works?"
You: (Provide your specification)
Dennis: "I don't know, that sounds pretty vague and I'm still not sure how I'd put that together. I think I'd have to do a lot of experimentation."
Problem: Oops, you have not yet properly enabled your invention, and it fails under 112.

You: "Dennis, please build me a device (or app) that does _____" (summarize the purpose of your invention in one sentence).
Dennis: "Wow, that would be a challenge. I wouldn't know how to accomplish that. Can you give me some more details about how it works?"
You: (Provide your specification)
Dennis: "Oh wow, that's a great way to achieve your solution! I'll put one together right away."
Congratulations! Your invention is patentable!

Sincerely

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