Supplemental Materials
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Patents

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Patents

What is a Patent?

A patent is a set of rights granted by the government to an inventor. A patent gives the inventor the right to exclude or prevent others from making, selling, offering for sale, or importing the patented invention in the United States for a fixed period of time, usually for 20 years from the date the application is filed. For additional information on what a patent is see the article at: http://www.ericksonlawgroup.com/law/patents/patentfaq/what-is-a-patent/

You must keep your invention confidential

Using your invention commercially or publicly, publishing your invention, offering your invention for sale, or publicly disclosing your invention, before a U.S. patent application is filed, can jeopardize your right to file a valid patent application in the U.S. and in foreign countries. In some countries, "publicly disclosing" can be as little as telling one person who is not under an express or implied agreement of confidentiality. There are some exceptions and grace periods depending on the country and the circumstances. For example, the United States has a one year grace period under some circumstances. However, it is best to file a patent application in the U.S. before any disclosure of the invention. If you have already made a disclosure of your invention, check with a patent attorney, as you may still be able to file a U.S. patent application.

Most foreign countries have no such grace period and instead a U.S. patent application must be filed at the United States patent office before any public (non-confidential) divulgation of the invention. If you then want to file foreign patent applications, once a U.S. application is on file, most foreign countries recognize the U.S. filing date if a corresponding foreign application is filed within one year (for utility application) or 6 months (for design application) of the U.S. filing date.

What can be patented?

There are three types of patents:

Utility patents may be granted to anyone who invents or discovers any new and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereof.

Design patents may be granted to anyone who invents a new, original, and ornamental design for an article of manufacture.

Plant patents may be granted to anyone who invents or discovers an asexually reproduces any distinct and new variety of plant.

Requirements for patentability

There are four requirements for an idea to be patentable:

- The idea must be a subject that Congress defined as patentable (**patentable subject matter**). For utility patents, machines, processes/methods, and compositions of matter are patentable. The courts have stated that Congress had intended patentable subject matter to include anything under the sun that is made by man.
- the idea must be **new**;

- the idea must be **useful** for a utility patent or **ornamental** for a design patent;
- the idea must be **non-obvious** (sufficiently different or new enough). The concept of "obviousness" has a different legal meaning than its everyday meaning. Consider whether the invention is sufficiently different from the prior art when considered by a person having ordinary skill in the area of technology related to the invention. It is very difficult to predict what the United States Patent and Trademark Office (USPTO) will consider obvious due to the multifactor, fact intensive, inquiry required in an obviousness analysis. Even very small improvements may be patentable.

For more information on what an invention is see the article at: http://www.ericksonlawgroup.com/law/patents/patentfaq/what-is-an-invention/

Rights granted by a patent

Many people believe that a patent gives the inventor the right to make his or her invention. This is not correct; a patent only grants the inventor the right to *exclude others* from making or selling his or her invention. It is possible to obtain a patent on an improved device but not be able to sell the *improved* device because it infringes an earlier patent on the *basic* device.

Patent novelty searches

Although not required, you should consider having a patent search completed before drafting or filing a utility patent application. A patent search may reveal "prior art" that would suggest that proceeding with a patent application would not be worthwhile. Prior art includes (1) patents or printed publications anywhere in the world, or (2) public knowledge, public use, or sale of the invention. Generally, a novelty patent search covers patents and published patent applications. A novelty patent search is useful to determine whether there is a chance of obtaining a patent. A novelty patent search is not a clearance search and will not tell you whether commercializing your invention would violate an earlier patent.

For more information on patent novelty (or patentability) searches see the article at: http://www.ericksonlawgroup.com/law/patents/patentfaq/what-is-a-patentabiliy-search-opinion/ For a patent novelty search guide: http://www.waltmire.com/2015/05/27/how-to-patent-search/ For more information on clearance searches and freedom to operate opinions see the article at: http://www.ericksonlawgroup.com/law/patents/patentfaq/freedom-to-operate-and-clearance-searching-opinions/

Types of Patents and Applications

Utility Patents

A utility patent covers functional attributes of an invention. The "patented invention" of a utility patent is defined by numbered claims in the patent. To be patentable, the claims must describe in words an invention which is useful, new and non-obvious. For more information on whether to pursue a utility application or a design application see the article at: http://www.ericksonlawgroup.com/law/patents/patentfaq/do-i-need-a-utility-patent-or-a-design-patent/.

What is a Patent Application?

To obtain a utility patent, a non-provisional utility patent application is filed with the

United States Patent Office. The utility patent application includes a complete description of your invention, including informal drawings, and a set of numbered claims. The claims describe in words the breadth of your invention and define the legal boundaries of your invention. One valuable service a patent attorney provides is using the proper language in drafting the application, so that the invention concept is captured. A properly worded application, depending on the extent of the prior art, will likely have broadly worded claims that are not easily circumvented by competitors.

What happens after a Non-Provisional Patent Application is filed?

The U.S. Patent Office will (1) examine the non-provisional utility patent application, (2) search for similar prior patents or publications in Patent Office files, and (3) issue an office action (written decision) deciding whether the patent claims are allowed or rejected (usually for being too broad). Such rejections are typical and require a written response from your patent attorney, typically amending the words of the claims and including arguments for patentability.

The written correspondence between the U.S. patent examiner and your patent attorney will continue until allowable claims are agreed upon, or will cease if you decide to abandon the application. This patent pending period is referred to as "patent prosecution." This period usually lasts between 18 months to up to 5 years, depending on the Patent Office processing, and the degree of Examiner cooperation and agreement on the allowability of the claims.

Once a utility patent application is filed, the applicant can mark his or her product or literature with "Patent Pending." For more information on what happens after a patent application is filed, see the article at: http://www.ericksonlawgroup.com/law/patents/patentfaq/what-happens-after-the-patent-application-is-filed/.

Foreign Patent Applications

Foreign patents are needed to protect your invention from being exploited in foreign countries. Foreign patents are *not* needed to prevent the importation of infringing products into the U.S. A U.S. patent is enforceable against importation of infringing products into the U.S.

Any foreign utility patent applications must be filed within one year of the filing date of the non-provisional (or provisional) application to benefit from the filing date of the non-provisional (or provisional) application. An international (PCT) application can be filed within the one year to extend the deadline to nationalize applications in foreign countries.

Provisional Patent Applications

As an alternative to a U.S. non-provisional utility application, a U.S. provisional utility application can be filed. The provisional utility application must be followed within one year by the filing of a non-provisional utility application and any foreign utility applications, to benefit from the filing date of the provisional utility application. The Patent Office does not examine provisional utility applications. For additional information on whether to start with a provisional or a non-provisional patent application, see the article at: http://www.ericksonlawgroup.com/law/patents/patentfaq/start-with-a-provisional-or-a-non-provisional-patent-application/.

Design Patents

The "patented invention" of a design patent is defined by the drawings. To be patentable the invention must be ornamental, new and non-obvious.

To obtain a design patent, a design patent application is filed in the United States Patent Office. The design patent application includes an identification of your article, and includes drawings showing multiple views of the article.

The U.S. Patent Office will examine the design patent application, search for similar prior patents or publications in Patent Office files, and issue an office action (written decision) deciding whether the design patent is allowed or rejected. Such rejections require a written response from your patent attorney, typically amending the words or drawings of the application for formal reasons. This patent pending period is referred to as "patent prosecution." Once a design patent application is filed, the applicant can mark his or her product or literature with "Patent Pending."

Any foreign design applications must be filed within six months of the filing date of the U.S. design application to benefit from the filing date of the U. S. design application.

For more information on whether to pursue a utility application or a design application, see the article at: http://www.ericksonlawgroup.com/law/patents/patentfaq/do-i-need-a-utility-patent-or-a-design-patent/.

How long does it take to get a patent?

There are a number of factors that affect the time until you receive a patent. Generally it can take between 3 and 5 years to obtain a patent. If an accelerated path is taken, a patent may be obtained in a year. For more information see the article at: http://www.ericksonlawgroup.com/law/patents/patentfaq/how-long-does-it-take-to-get-a-patent/

Co-Inventors

If there are two or more inventors for an invention, under patent law, each inventor will own the resulting patent jointly with the other inventors. However, under the law this allows each inventor to make, market, sell, license, or otherwise grant rights in the patent and receive moneys therefrom without splitting the funds with the other inventors. Further, each inventor does not need to get permission from the other inventors to undertake such activities with respect to the patent.

Whenever there is more than one inventor it is best to form a legal entity in which the inventors own an interest (e.g. own shares). The ownership of the invention can be transferred to the legal entity. The internal operating documents of the entity can describe (1) the ownership interest of each inventor (and other non-inventors, if desired), (2) how the invention will be commercially exploited, (3) how disputes are resolved between inventors, (4) what happens if one or more inventors wants to proceed but other inventors do not, and (5) many other business considerations.

The legal entity formed can be a written partnership, a corporation, an LLC, or other entity. The legal entity provides the vehicle for owning the patent, making decisions with respect to the patent and its commercial exploitation, and dealing with situations where an inventor wants out of the business. Further the legal entity may be attractive to potential business partners and licensees because they would need to deal with one entity and not multiple inventors. For more information on this topic see the article at: http://www.ericksonlawgroup.com/law/patents/patentfaq/what-if-someone-else-invented-withme/