Spradley PLLC

Applying for a Patent: A Necessary Protection before Practicing your Invention

What is a Patent?

A patent is an intellectual property right granted by the Government of the United States of America to an inventor "*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*" for a limited time in exchange for public disclosure of the invention when the patent is granted.

There are three types of patents.

Utility Patent

A 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. This by far is the most common patent applied for by inventors.

Design Patent

A plant patent may be granted to anyone who invents a new, original, and ornamental design for an article of manufacture. This patent cannot protect a utilitarian aspect of an invention.

Plant Patent

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

Why does the United States Issue Patents?

Art. 1 Sec. 8 Cl. 8 of the U.S. Constitution directs Congress to "promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." Our founding fathers understood the importance of a patent system. The patent system is essentially a quid-pro-quo between the U.S. government and the inventor. In exchange for public disclosure of an invention, the inventor is granted a patent.

Public disclosure fuels innovation by giving future inventors new ideas to build on, and tools to build with. Patent rights in turn give the patent owner the ability to keep copycats out of the market. Allowing a patent owner to profit from the invention further provides incentive for future innovation. Furthermore, public disclosure of a patent serves as a catalyst to technological innovation. Sir Isaac Newton elegantly stated "If I have seen a little further, it is by standing on the shoulders of giants."

What is included in a patent application?

A patent application teaches an invention to the Patent Office, precisely point out the invention, and tells the patent office information about the filing.

Specification

The specification describes the invention and prior related inventions or technology upon which the current patent is expanding or improving upon. The specification must be sufficiently described so as to enable a person who is ordinarily skilled in the art to be able to make and use the invention without undue experimentation.

Drawings

The drawings are used to illustrate the invention and to showcase some of the inventor's ideas for various embodiments. Spradley, PLLC has professional draftsmen capable of drawing even the most complex inventions for any application.

Claims

Claims are the legal boundaries of the patent and operate as the metes and the bounds of the invention. This is the most important part of the patent, because the claims encompass a patent owner's legally enforceable rights.

USPTO Paperwork

Your application must include a number of required forms from the United States Patent & Trademark Office. These forms introduce to the Office to the inventor, the owner of the application, and the attorney that will be prosecuting the application, as well as tell the office in general about the invention and the state of the art before the invention.

What are the benefits of obtaining a patent?

Obtaining a patent offers many benefits to the patent holder. Those benefits include:

Competition Exclusion: If you are looking to start a new company, a new product line, or just change an existing product or service, such change can take time to

implement and monetize. The ability to exclude others with your patent can give your business the breathing room it needs to make necessary changes without direct competition from others making and selling your product.

Licensing: A license is a special contract that conveys to a non-patent holder rights that a patent holder could otherwise exclude the non-patent holder from doing. Such rights in a license could be the right to make, use, offer to sell, sell, and/or import the product into the United States. A license may be exclusive, non-exclusive, and can be limited in scope of time and geography.

Assignment: Assignment transfers ownership of the patent so that the assignee becomes the new patent holder. Typically, assignment will allows the original patent holder an ability to receive a larger sum of money immediately in lieu of protracted smaller payments more typical in a license agreement.

Enforcement: A patent owner may seek legal action in the form of an injunction or damages against an unauthorized user who is making, using, offering for sale, selling, or importing the patent into the United States or territories thereof. Legal action in Federal Court can entitle the patent holder to compensation by payment of a reasonable royalty from the infringing party.

What are the dangers in waiting to file a patent application with the USPTO?

Waiting to file a patent application can have devastating consequences for an inventor. Failing to file an application could prevent the inventor from ever obtaining a patent, and if another files first, the inventor could be prevented from practicing the invention. Here are some specific pitfalls awaiting inventors who fail to timely file a patent application.

One-year Time Bar

According to 35 U.S.C. § 102(b), an inventor who discloses his invention to the public more than one year before filing a patent application is not entitled to a patent. Public disclosure includes offering for sale or selling a product that includes the invention, disclosing in print the invention, telling others about the invention, or even using the invention in public.

First-to-File Rule

In the United States, the first inventor to file a patent application for a new invention is entitled to a patent, regardless of who invented first. By disclosing your invention to the public before filing a patent application, you are exposing yourself to the possibility that someone could learn of your invention, and file a patent application, claiming to be an inventor. Proving someone is not an inventor can be incredibly difficult, and if you fail, you could be prevented from practicing your invention.

Market Competition

If someone begins practicing your invention before you file your application, a number of problems arise. First, their use can prevent you from obtaining a patent if you had not previously disclosed your invention. Further, even if you receive a patent, you may be barred from enforcing your patent against prior users of the invention.

What is the difference between a provisional application and a utility application?

Non-Provisional: A non-provisional application is reviewed by a patent examiner and may mature into a patent if the examiner deems the application and content meet all patentability requirements.

Provisional: A provisional application is merely a placeholder for a utility application. The filing date may later be claimed in a non-provisional application disclosing the same information. However, the non-provisional application must be filed within 12 months of the provisional's date of filing in order to claim the provisional's filing date. The provisional application is not reviewed by a patent examiner and therefore will not issue as a patent. Additionally, any new information disclosed in the utility application will not be afforded the filing date of the provisional application. Instead, any new material will be given a filing date on the date the utility application is filed.

When is it safe to disclose my invention to the public?

You can disclose your invention to the public immediately after filing your patent application. The patent office will not disclose your patent application for the first eighteen months after filing, giving you additional time to introduce your invention to the market.

Why should I choose Spradley PLLC to represent me?

Spradley PLLC possesses the experience, knowledge, and skill to compose a patent application that will give you broad protection. Our knowledgeable attorneys will guide you through the prosecution process to give your application the greatest likelihood of issuance. Attorney at our firm have drafted applications for clients ranging start-up ventures to Fortune 50 companies. In addition to filing your patent application, Spradley PLLC can help you negotiate licensing agreements and assignments, as well as form your business and register your trademarks.