

Introduction to Patents



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What we will cover today...

- What can be patented
- What to expect from the Patent Office
- Realities of patenting
- Tools available on websites
- Patent searching
- Where to access information at SIBL

Nature of a patent

A U.S. patent *grants* a right to **exclude** others from:

- Making
- Using
- Offering for sale
- Selling the invention throughout the U.S.
- Importing the invention into the U.S.

Types of patents

- Utility
 - New and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereon
- Design
 - Any new, original and ornamental design
- Plant
 - Whoever invents or discovers and asexually produces and distinct and new variety of plant

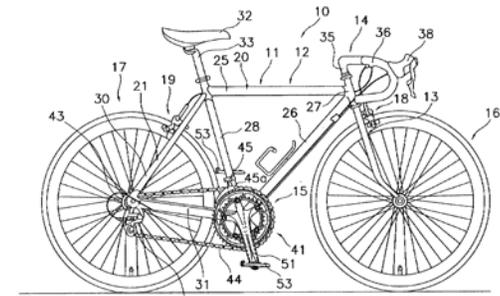
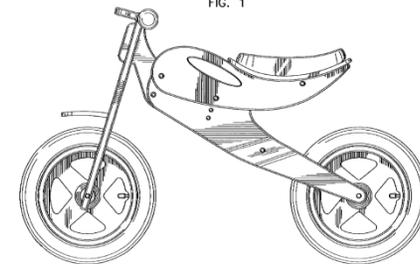


Fig. 1

FIG. 1



Types of Applications

- Provisional
 - one year period
 - no claims required
 - written disclosure
 - must meet same requirements as non-provisional
 - not allowed for design
- Non-Provisional
 - claims required
 - written description must meet requirements of 35 U.S.C. § 112, 1st paragraph
 - Examined for patentability
 - can result in a patent

Pitfalls of Provisionals!

- Must file a non-provisional within one year to keep filing date
- Might affect foreign filing
- May not give full coverage to non-provisional application
- Attorney cost almost equal to non-provisional

Patent Value

- Patents have the attributes of **personal property** and may be:
 - Sold to others
 - Mortgaged
 - Assigned
 - Given away
 - Bequeathed in a will and inherited
 - Licensed and taxed

Pitfalls of Patents!

- Patent does not assure patentee can practice the invention during the entire term
- May be a dominant, “background,” patent owned by another
 - Must be honored until that patent expires

Who can get a patent?

- Current law
 - the real person or persons who first made the invention (i.e. the first to invent), or his/her assignee, is entitled to a patent
- Change in US law under AIA
 - the first inventor to file a complete application is entitled to a patent, provided the invention was not copied from another

Application Requirements

- **Filing date**
 - Date Received in the USPTO
 - Via EFSweb
 - Express Mail Certificate
 - Certificate of Mailing will NOT establish filing Date
 - Walk-up window
 - Itemized postcard receipt
 - Written description
 - Drawings – where necessary
 - At least one claim
- **Examination**
 - Fees
 - Signed oath/declaration

Other Parts - Recommended

- **Transmittal Sheets**
 - Application Transmittal
 - Fee Transmittal
- **Express Mail label**
- **Prior Art - Information Disclosure Statement**
- **Nucleotide or Amino Acid sequences - when necessary**
- **Application Data Sheet**

Parts, Form and Content

Arrangement of Application

- Title,
- Cross-Reference to Related Applications,
- Statement Regarding Federally Sponsored Research or Development,
- Background of the Invention,
- Brief Summary of the Invention,
- Brief Description of the Drawings,
- Detailed Description of the Invention,
- Claims, Abstract, & Drawings
- Sequence or Computer Program Listings

Application examination

- Prior art
- Novelty vs. Anticipation
- Non-obvious vs. Obvious
- Best Mode, Enablement & Written description
- Time periods
- Amendments

Allowance, Issue and Patent

- Time period
- Term
 - Utility, Plant and Design
- Maintenance of a Patent
- Patent Marking & “Patent Pending”

Territoriality

Each country has its own patent laws

U.S. patent only effective in the U.S.

What is done here may affect rights elsewhere
and vice versa

Inventor Challenges

- First time inventor
- Million \$ product/idea
- Others will steal
- Everyone will want your product/idea
- Investors provide funding
- Government grant

Reality for inventors

- No one wants to steal idea
- Your idea probably not new
- Over 8,000,000 patents issued in USA
- Investors not looking for “ideas”
- Few if any government grants available



Ideas!

- The way to have a good idea is to have lots of ideas and throw the bad ones away
 - Linus Pauling, 20th Century chemist
- Invention isn't some impenetrable brand of magic, anyone can have a go
 - Trevor Baylis, inventor, wind-up radio

The Good News

- Public looking for the next Thing
- Businesses now starting to look at individual inventors
- Good time for inventors
 - Depression saw many great products and companies start from single idea
 - Recessions spur new ways of doing things

Inventors Genius

- “Genius is one percent inspiration and ninety-nine percent perspiration.
Accordingly, a genius is often merely a talented person who has done his or her homework.”
 - Thomas Edison
- Like genius, inventors need to do homework to make the most from their inventions and patents

What To Do!?

- Homework
 - Find out if idea already patented
 - Learn about intellectual property system
- Learn your strengths/weaknesses
- Assess market and/or product
 - Multiple companies available
 - Find them on-line

Where to find Help

- USPTO
 - Inventor Resource page
<http://www.uspto.gov/inventors/index.jsp>
- Inventor Groups
 - List at www.uiausa.org
- Government agencies
 - FTC; SBA; local SBDC; SCORE and others
- Books and magazines

Where to find Help

- Searching
 - USPTO
<http://www.uspto.gov/patents/resources/classification/index.jsp>
 - Google <https://www.google.com/?tbs=pts&hl=en>



Thank you



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