

AN OVERVIEW OF THE PATENT PROCESS

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GENERAL PROCEDURE. A patent is a government granted monopoly on an invention for a limited period of time. To secure a United States patent, one must file a patent application at the U.S. Patent and Trademark Office. There are no common law or state patent rights. The patent application is assigned to an examiner who reviews the patent application for compliance with various rules; the examiner can either reject or allow the patent application. An allowed patent application is issued and privately enforceable for a period of twenty years from the patent application filing date.

INVENTION STAGE. Creating an invention is no doubt an important, albeit required, step in the patent process. But, besides being concerned with the invention itself, it is good practice to begin keeping records and forming any important agreements. Good record keeping typically involves an inventor's notebook having dates, tests, results, drawings, and any thoughts. Such a notebook can later be relied upon, if necessary, to prove an invention date during a priority contest with another inventor. With regard to agreements, when multiple inventors are involved it is a good idea to have an agreement detailing how the invention and any patent applications or patents granted thereon will be owned. Without such an agreement, inventors can each assign and license their portion of any patent without permission of the others. Additionally, when an employee is an inventor it is good practice to have an assignment agreement early on to avoid future ownership disputes. Without an assignment agreement, the employee inventor may end up owning the invention they were hired to create.

POST-INVENTION/PRE-FILING STAGE. Once an invention is conceived, it is important to exercise reasonable diligence in filing a patent application for the invention. Diligence permits an inventor to rely on the conception date as the date of invention in any priority dispute. However, there will inevitably be time between conception and filing a patent application and there are some important things to consider during this time. First, the record keeping begun during the invention stage should continue for improvements to the invention and should extend to document patent filing preparation. Next, the invention should be kept in confidence using non-disclosure agreements and implementing procedural safeguards, such as marking and securing confidential materials. Keeping an invention in confidence preserves foreign patent rights, preserves trade secret protection, and avoids inventorship disputes. Care should be exercised, however, not to make unnecessary disclosures, even under a confidentiality agreement, because breaches of such confidentiality agreements can still terminate patent rights. Next, activities such as public uses, offers of sale, publications, and other disclosures of the invention should be avoided. These events trigger deadlines to file a patent application that are irreversible and can result in complete loss of ownership of an invention. Also, it is good practice to begin conducting prior art searches to determine whether an invention is new. Other patents and patent applications are a good place to begin and these are accessible at no charge from the US Patent and Trademark website. However, enlisting a patent attorney to assist in searching and interpreting results is a very good idea as will be appreciated upon beginning a search. Any discovered related prior art should be recorded and disclosed to the patent office.

FILING STAGE. There are a number of different patent application types that are at an inventor's disposal. The difference between them is generally their expense, formality level, and time to examination. The primary application is a non-provisional application, which requires a

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specification having certain components, drawings, claims, an oath, and a filing fee. The non-provisional application is examined about a year to three years after filing. The next type of application is a provisional application, which requires a less formal specification and a filing fee. The provisional application is never examined, and must be converted into a non-provisional application within one year of its filing date. The last type of application is an accelerated non-provisional application, which requires the same items in the non-provisional application, a comprehensive prior art search, and a supplementary document that assists an examiner during examination. The accelerated non-provisional application can undergo examination within a year from filing. Thus, the provisional application can be more easily drafted and result in a longer time to examination. In contrast, the non-provisional or the accelerated non-provisional are more difficult to draft and result in a quicker time to examination. These differences are important to a cost sensitive and strategically thinking inventor. Design and foreign patent applications have different requirements. Once an application is pending it is permissible to publicly disclose and attempt to commercialize an invention without harm to patent rights; however, patent applications do not publish for at least 18 months from filing. Thus, an inventor can elect to continue holding an invention in confidence during this time to preserve trade secret rights.

EXAMINATION STAGE. Before a patent application is allowed, it must undergo examination. Examination is the procedure where a patent examiner evaluates a patent application, and more specifically its claims, to determine whether the invention is new and non-obvious over the prior art. Commonly, a patent examiner will initially reject most, if not all, the claims in a patent application. The applicant is then given an opportunity to respond to the rejections by making arguments, amending the claims, and fixing any other problems. It is not unusual for an examiner to reverse his or her position in response to applicant arguments and amendments, but it is certainly a risk that the examiner will not do so. In that instance, the applicant can abandon the patent application or continue the examination process by paying additional fees.

ISSUANCE STAGE. An issued patent is one that has successfully made it through examination and results in a number of rights vesting in the patent owner. These include the right to exclude others from making, using, selling, offering for sale, or importing the patented invention in the United States for a term of twenty years from the filing date. Any of these rights can be licensed or assigned to another entity, but the rights must be privately policed and enforced by the patent owner. An issued patent is presumed valid, but it can be invalidated by a court of law. Finally, maintenance fees must be periodically paid on an issued patent to avoid abandonment.

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