

# THE ESSENTIAL GUIDE TO PATENT FILING



POWERED BY GUTWEIN LAW

*Notations to be made.*

*Visual description. Functional properties.*

*Key features documented on page 6.2.*

*Invention draft 3.2A*

*Rotation 360°*

*x45, y90, z15*

*variables*

*Movement*

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## THE PURPOSE OF PATENTS

Patents serve a dual purpose that goes beyond helping inventors secure the rights to their creations.

It's true. Despite granting inventors a "monopoly" over their product or process, patent protection exists to "advance the sciences."

How? By giving others a chance to improve on patented work.

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*"A PATENT IS AN EXCLUSIVE RIGHT GRANTED FOR AN INVENTION, WHICH IS A PRODUCT OR A PROCESS THAT PROVIDES, IN GENERAL, A NEW WAY OF DOING SOMETHING, OR OFFERS A NEW TECHNICAL SOLUTION TO A PROBLEM. TO GET A PATENT, TECHNICAL INFORMATION ABOUT THE INVENTION MUST BE DISCLOSED TO THE PUBLIC IN A PATENT APPLICATION."*

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– World Intellectual Property Organization (WIPO)

In other words, to acquire a patent, you must provide full disclosure of your invention, including how it works and how it came to be.

### **THE BENEFIT OF HAVING A MONOPOLY**

According to the United States Patent and Trademark Office (USPTO), a patent allows recipients “to exclude others from making, using, offering for sale, or selling the (patented) invention throughout the United States or importing the invention into the United States” for 20 years from the original filing date.

Of course, if someone else improves on your work in a way that wasn’t obvious before, that person can apply for a patent on that specific improvement, while you still maintain rights over your original invention.

The fact is, most of today’s inventions are improvements made to existing devices or technologies.

## HOW TO LEVERAGE A PATENT

While many people initially think of enforcement, the reality of patent enforcement is that it's long, expensive and uncertain. Most companies don't randomly engage in patent litigation, and neither should you.

Here are six more important ways you can put a patent to work:

- **To prevent or delay the competition from invading your turf** Having the ability to apply "patent pending" to your intellectual property puts your competitors on notice. They'll know that should you eventually receive a patent, you will have the ability to claim damages dating back to the first act of infringement.
- **To use as a marketing tool** Filing for a patent gives you the ability to communicate that your invention is "patent pending." This can help you build market penetration earlier while positioning you as a thought leader in your market segment.
- **To explore licensing** If your invention improves on an existing product or would be of value to another party, you can receive compensation each time your patented item is used or sold by negotiating a licensing agreement.
- **To counteract your competitors** If your direct competitor is obtaining patents, you can seek patents of your own as a way to maintain leverage should your marketplace nemesis ever bring litigation against your company.
- **To build corporate value for potential and current investors** In most cases, investors will see patents as added value. To attract venture capital, having formal patent protection surrounding your inventions can pay off big.



## PATENT TYPES

There are three types of patents, although only a few companies need to be worried about “plant patents.” The main patent types most businesses should be familiar with are:

### UTILITY PATENTS

Utility patents protect an invention or “article of manufacture” itself, including processes to make and use it.

Utility patents remain in effect for

20 years from the original filing date, although protection does not begin until a patent has been issued.

Apple Inc.’s iOS operating system is an example of technology that is protected by a utility patent.

### DESIGN PATENTS

Design patents protect the appearance of a product as seen by others, which covers “unique, non-functional design

elements considered important to product differentiation.”

Design patents remain in effect for 14 years from the original filing date, although protection does not begin until a patent has been issued.

The graphical user interface of the computer, tablet or phone you’re using right now is almost certainly protected by a design patent.



# HOW TO KNOW IF YOUR INVENTION IS PATENTABLE



## **YOUR INVENTION MUST BE "USEFUL"**

You may be thinking, "well, maybe no one will think my invention is useful," but you'd be thinking about this requirement all wrong. "Useful" just means your product or process does what it was created to do, which cannot be anything that could be considered "immoral, frivolous or mischievous."

For instance, the invention of a device that enables motor vehicles to "cheat" emissions testing would likely be labeled "immoral" and "mischievous" and perhaps ineligible for patent protection.

## **YOUR INVENTION MUST BE "NON-OBVIOUS"**

Also known as the "inventive step," this requirement states an invention cannot be identical to prior art or be obvious to someone with ordinary skill in the art. How can you determine what differences are "obvious" and which are not? That's actually where a company will realize the most help from a patent attorney, because there is no hard and fast rule. Instead, there are various factors that need to be considered.

For example, some factors that argue in favor of an invention being "non-obvious" is when that invention fulfills a "long-felt but unmet need," is the result of the "failure of others" to develop it first, delivers "unexpected results" or has the potential "for commercial success."



## **EXAMPLE: TOYOTA HAS PATENTS THROUGHOUT THE WORLD FOR ITS "HYBRID SYNERGY DRIVE" GAS/ELECTRIC ENGINE TECHNOLOGY BECAUSE:**

- It met a "long-felt but unmet need" for ultra-fuel-efficient automotive engine technology
- It was the result of the failure of other manufacturers to develop such technology

- It delivered unexpected results by combining extremely low fuel consumption with performance that fit the needs of today's drivers
- It had the potential for commercial success due to a combination of consumer demand and Toyota's vast production capabilities investors will see patents as added value. To attract venture capital, having formal patent protection surrounding your inventions can pay off big.



## **YOUR INVENTION MUST BE “NEW”**

This is known as the “novelty” requirement. To be considered “new,” your invention must be different from “prior art.” Prior art encompasses all devices, compositions and processes that currently exist. To put it in layman’s terms, your creation cannot be identical to someone else’s.

To protect the patentability of your invention, your product or process cannot be previously known or used by the public before filing, sold or offered for sale, described in a printed publication or invented by another more than one (1) year before your patent application is filed

### **THINGS TO AVOID:**

- Commercialization and marketing activities: Put a hold on the radio ads – the catchy jingle can wait.
- Disclosure without the use of an agreement: Before you talk, make sure they’ve signed an agreement with you, such as one of the following:

**Non-Disclosure Agreement (NDA)** – Commonly referred to as a “confidentiality agreement,” an NDA is a contract where the recipient agrees not to disclose any of the confidential information you’re about to share.

**Joint-Development Agreement (JDA)** – A contract signed by you and another party with whom you will be working that outlines details regarding ownership, distribution and financial obligations.

**Joint Venture (JV)** – A business agreement where two or more parties decide to work together for a set period of time to finance and develop a new product or process.



## **EARLY PUBLIC DISCLOSURE – WHY IT MATTERS**

Public disclosure is a big deal. In the rest of the world, once you publicly disclose your invention, you can't get a patent on it. In the U.S., we're gracious. We give you one (1) year to get your application filed. But if you go to a convention and share your work before filing for a U.S. patent, you sacrifice your ability to file for a patent anywhere else.

Limited or controlled testing is OK as long as you've filed a provisional patent application first. Otherwise, make sure people hearing your pitch have signed a non-disclosure agreement before you get things underway.

## **DON'T WAIT TOO LONG**

Not long ago, the United States was a "first-to-invent country." If you created something first but someone else beat you to the patent office, as long as you had documentation to prove your invention was the original, you got the patent.

But with the implementation of the America Invents Act (AIA) in March 2013, the United States joined the rest of the world as a "first-to-file country," which means that if two people come up with the same idea, the first person to file their patent application wins.

## **THE VALUE OF PROVISIONAL PATENTS**

Provisional patent applications give you the ability

to claim an "early effective filing date" in a later filed formal or "non-provisional" application, positioning you ahead of any applications your competitors may submit down the road.

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**THEY ALSO GIVE YOU THE RIGHT TO APPLY "PATENT PENDING" TO YOUR PRODUCT OR PROCESS SO THAT YOU MAY PUBLICLY EXPLAIN, TEST OR DEMONSTRATE IT WITHOUT HURTING YOUR PATENT CHANCES IN THE U.S. AND ABROAD.**

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To be eligible for a non-provisional patent and claim priority from a provisional application, you must apply within 12 months of filing a provisional application.

## **IDENTIFYING NEW OPPORTUNITIES**

At this stage in the game, you may be looking to file a single patent for your first and only invention. But the key to growth for many startups involves teaching others – your partners, employees or both – how to recognize a patentable technology or invention.

When everyone is on the lookout, you're more likely to be in position to file for patents before your competitors. But maximizing that benefit takes diligence and a solid process for documenting ideas while helping your employees generate new ones.

# THE PATH FROM “INVENTION” TO “UTILITY PATENT”



After developing a new product or process, you'll want to consider submitting an **invention disclosure** to an experienced patent attorney. A patent attorney can use your disclosure and an optional search of related art to determine if your invention is actually patentable, so you're not wasting time on something that isn't.

When investigating patentability, a patent attorney will help you think about:

- If your idea is “new,” “useful,” and “non-obvious” based on current legal criteria
- If prior art exists that could present a problem during the application process
- If your idea is “valuable” in light of the resources required to patent it
- If your idea would be better served by trade secret protection
- The likelihood that your product or process could be licensed or commercialized
- If your invention should be considered a “final version”
- If it would be detrimental for someone else to file for a patent on your product or process. If the answer is “no,” you may not need a patent for your invention after all.

If it looks like your invention is in fact patentable, your attorney would then recommend the drafting of a **patent application**.

## WHAT TO INCLUDE IN A PATENT APPLICATION

A duplication of your invention. Well, not exactly. Your patent application must include a disclosure – usually a detailed description accompanied by some figures – that is specific enough for your work to be recreated without “undue experimentation”

Invention claims, or a list of statements that define your product or process

An oath and declaration that identifies you as the inventor and states your belief that you are the original architect of your invention

After review and approval from you, the inventor, your attorney will file your patent application with the United States Patent and Trademark Office (USPTO), giving you the right to use “patent pending” on your invention.





## WHAT HAPPENS AT THE USPTO

- A **patent examiner** will review your application and perform a search for prior art to determine whether your invention meets current legal standards.
- That same patent examiner will then send an “Office Action” back to you, the inventor, which either rejects your application or grants you a patent.

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**ACCORDING TO THE USPTO, THE AMOUNT OF TIME BETWEEN APPLICATION SUBMISSION AND THE ISSUANCE OF AN INITIAL OFFICE ACTION AVERAGED 18.2 MONTHS IN 2013.**

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The reality is, **most patent applications face some sort of initial rejection**. If that happens, you have three options:

- Filing an **argument** against the rejection’s merits
- **Amending** the claims of the patent application
- **Abandoning** the application

Should you choose to file an argument or amend your claims, you have six (6) months to submit your response.

Based on your response, your patent examiner will either grant you a patent or send you another rejection.

- The process continues until you receive **allowance** from the patent examiner or choose to abandon your application altogether.
- According to the USPTO, the total amount of time between an application submission and the issuance of a patent averaged **29.1 months** in 2013.

### **THE EXPEDITED REVIEW OPTION**

If you're looking to speed up the review process and you have the funds, you have the ability to request an expedited review, which requires you and your lawyer to complete a more rigorous application and pay an additional \$4,800.

This may be seen as unfair to smaller players who lack big funding, although it remains to be seen whether individual inventors and small businesses are losing out on patents because of it.

The U.S. government has tried to offset any perceived inequity by being more "user friendly" to small businesses and individual inventors and introducing the "micro entity" designation discussed earlier.

# FIRST THINGS FIRST

## **TAKE A LOOK BACK**

Before you file for a patent, explore whether or not you are bound by an agreement you signed with a former employer. Review past employment contracts for IP clauses and contact your former employer's HR Director with any questions.

Generally, the rights to intellectual property you create as a part of your duties as an employee belong to your employer.

## **TAKE A LOOK AROUND**

Examine your competitive landscape. Patents grant you the right to prevent others from duplicating your invention, but don't automatically give you the ability to market that invention if it infringes on an existing patent.

A basic patent search can be performed by visiting [patft.uspto.gov](http://patft.uspto.gov) or Google Patents, but an experienced patent lawyer can execute a more thorough and strategic evaluation.

## **HAVE A PLAN**

Before you pursue a patent for your invention, decide what it is that you ultimately want to do with that invention – bring it to market yourself, or license it out to a bigger player?

If you're leading a startup, you'll want to formulate an exit strategy early on. Think about where you are now and decide where you want to be once things are up and running. Will you keep building or look to sell?

## NEXT STEPS

Contact

### **Enhance Innovations**

11180 Zealand Avenue N  
Minneapolis, MN 55316

**[enhancepd.com](http://enhancepd.com)**

[support@enhancepd.com](mailto:support@enhancepd.com)

877.99.ENHANCE (877.993.6426)



### REFERENCES

- (1) United States Patent and Trademark Office (USPTO).
- (2) World Intellectual Property Organization (WIPO).
- (3) Gutwein Law is a full-service intellectual property firm with offices in Indianapolis, Lafayette, and Minneapolis. [gutweinlaw.com](http://gutweinlaw.com)

### DISCLAIMER

These pages do not constitute legal advice, nor do they create any attorney-client relationship.