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This white paper discusses U.S. patents and how to obtain a U.S. patent. The article also discusses how a patent attorney can help.

What Is a U.S. Patent?

A patent is a type of intellectual property. In general, intellectual property is an intangible creation by a human that can be protected by the law, although not all intangible creations are legally protectable. Intellectual property is distinguishable from real property (e.g., land) and tangible property (e.g., a car). Four types of intellectual property are: patents, trade secrets, trademarks, and copyrights.

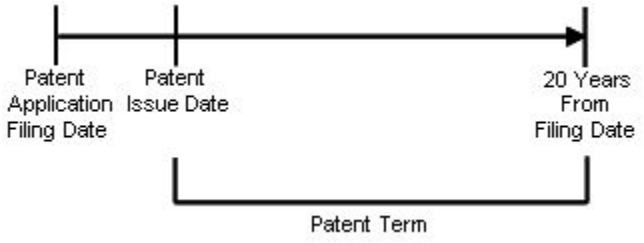
A U.S. patent provides the right to exclude others from practicing an invention; it does not provide the right to practice the invention. This is an important distinction, and one that is often overlooked. In particular, a patent provides a bundle of rights for excluding others from practicing the invention, including the right to exclude others from making the invention, using the invention, selling the invention, offering the invention for sale, and importing the invention.

A U.S. patent provides this bundle of rights only in the United States. To obtain patent rights in other countries, patent applications must be filed in the countries where patent protection is desired.

There are three types of patents: utility patents, design patents, and plant patents. A utility patent is issued for an invention of a process, a machine, an article of manufacture, a composition of matter (e.g., a chemical compound), or a useful improvement of one of these. A design patent is issued for an invention of an ornamental design for an article of manufacture. A plant patent is issued for an invention of certain plants. This discussion addresses only utility patents.

For utility patents, two types of patent applications can be filed, namely a so-called regular patent application and a provisional patent application. A regular patent application is examined and can eventually issue as a patent. A provisional patent application is not examined, will never issue as a patent, and is used to establish a date of invention for a subsequent regular patent application. A provisional patent application has a term of one year. The remainder of this discussion addresses regular patent applications.

The term of a U.S. patent depends on the filing date of the patent application which results in the grant of a patent. For patent applications filed on or after June 8, 1995, the patent term is the time from the patent issue date to 20 years from the earliest effective filing date of the patent application. The following figure illustrates a patent term for a patent application filed on or after June 8, 1995 and which does not claim priority to a previously filed patent application:



Hence, for a patent issuing from a patent application filed on or after June 8, 1995, the term of the patent depends on the time that the patent application is pending in the U.S. Patent and Trademark Office. For patent applications filed prior to June 8, 1995, the patent term is either the time from the patent issue date to 20 years from the earliest effective filing date of the patent application, as illustrated in the figure above, or 17 years from the patent issue date, whichever is longer. Further, the patent term may be extended for certain delays during the pendency of the patent application at the U.S. Patent and Trademark Office.

How Do I Obtain a U.S. Patent?

Before filing a U.S. patent application, an inventor should generally consider the following questions:

1. Was the invention offered for sale in the United States? If so, when?
2. Was the invention disclosed in a printed publication? If so, when?
3. Was the invention publicly disclosed in the United States without an executed written confidentiality agreement? If so, when?
4. Who are the inventors?

An affirmative answer to the first part of any of questions (1)-(3) may cost an unwary inventor potential patent rights. In general, to preserve U.S. patent rights, a patent application must be filed within one year after any event in questions (1)-(3), and to preserve foreign patent rights, a patent application should be filed prior to any event in questions (1)-(3).

Once question (4) is answered, an employer may find that one of the inventors is not required to assign the inventor's rights in the patent application to the employer. This may be the case if the inventor is not under an employment agreement or is an independent contractor. In general, to avoid this problem, an employer should take appropriate measures to ensure that patent rights for the appropriate type of inventions are assigned to the employer.

To obtain a patent, a patent application must satisfy several statutory requirements: eligible subject matter, novelty, nonobviousness, utility, and proper disclosure, which includes a written description, enablement, and best mode. Of these requirements, novelty and nonobviousness generally

address whether the invention claimed in the patent application has been disclosed previously or is an obvious modification of whatever has been disclosed previously. Further, the requirement of eligible subject matter dictates, in general, what types of inventions may receive patents.

The basic patenting process has several typical steps. Initially, an invention disclosure describing the invention should be prepared, and a search of the relevant literature should be conducted to ascertain whether the invention has been published or patented. If the search is clear, a patent application is prepared and filed with the U.S. Patent and Trademark Office. Usually, a back-and-forth correspondence occurs between the inventor and the Patent Examiner over the scope of the claims of the patent application. A personal interview with the Patent Examiner may also occur during the proceedings. To overcome any objections or rejections by the Patent Examiner, an Applicant may amend the claims and argue against the objections or rejections, or only argue against the objections or rejections. If the Patent Examiner determines the patent application has met all of the requirements, a patent is issued from the patent application.

How Can a Patent Attorney Help?

A patent attorney can team with a company to build and monetize the company's patent portfolio and even defend against other company's patents. To assist in protecting the investment in innovations by a company, the patent attorney can work with the company to build the company's patent portfolio as follows:

- Analyze the company's innovations to identify patentable inventions and recommend a process for obtaining patent protection for the identified patentable inventions;
- Review the company's procedures for assigning patent rights from the company's inventors to the company to ensure that the company is the owner of the patent rights;
- Arrange for prior art patentability searches of the company's inventions, and analyze the results of the searches;
- Prepare patent applications for the company's inventions and file them in the U.S. Patent and Trademark Office
- Manage the filings of U.S. patent applications with other patent offices around the world; and
- Prosecute the filed patent applications before the U.S. Patent and Trademark Office and other patent offices around the world, including conducting personal interviews with the Patent Examiners.

Once the patent portfolio is developed, the patent attorney can team with the company to monetize the patent portfolio as follows:

- Provide advice to the company on the licensing of the company's patents;
- Negotiate and draft patent licenses; and
- Enforce the company's patents against infringers.

As a company brings products to market, the patent attorney can work with the company as follows:

- Arrange for product clearance searches of the company's new products, and analyze the results of the searches;
- Provide advice to the company on the design around and/or licensing of other patents; and
- Negotiate and draft patent licenses.

If a patent is ever asserted against the company, the patent attorney can assist with the following:

- Analyze the patent and the assertion of patent rights against the company;
- Provide opinions as to the validity, infringement, and enforceability of any asserted patents;
- Advise the company on the possible licensing of the asserted patent; and
- Defend the company against the assertion of patent rights.

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