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# US PATENT PROTECTION: A STEP-BY-STEP GUIDE

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## 1. PROTECTABLE SUBJECT MATTER

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A patent protects ideas and their practical implementation. It is a government grant conferring a title for a set period, especially the sole right to exclude others from making, using, importing, selling, or offering to sell an invention covered by the patent. Specific statutory criteria must be met as part of the examination process.

## 2. RECORD KEEPING

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It is important to maintain records of your inventions. They may be in the form of lab notebooks, or more formal "Invention Disclosure Records". Maintaining records not only memorializes who inventors are and when the invention was made, but also provides a format for review by management or a Patent Review Board tasked with determining which inventions merit protection. It is also important to maintain Employment Agreements and ensure that they include an explicit provision related to Intellectual Property ownership. If an inventor is unwilling to sign an Assignment document (such as if an employee has been terminated), then a properly worded and executed Employment Agreement may be used in lieu of an executed Assignment in some circumstances.

## 3. SHOULD YOU PROCEED?

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| <input type="checkbox"/> Is it marketable?   | <input type="checkbox"/> If a utility or provisional application -- Is the invention a process, a method, a machine, an article of manufacture, a composition of matter, or an improvement to one of the foregoing?   |
| <input type="checkbox"/> Did you invent it? – Even if you did you might have a duty to assign to a third party   | <input type="checkbox"/> If a design application – Is it non-functional?  |
| <input type="checkbox"/> Do you own it, or do you control the inventors who did?   | <input type="checkbox"/> Search for prior art – In determining novelty and non-obviousness a patentability search is highly recommended although not required. Even if an invention appears patentable, having good art helps refine application preparation and claim scope. Please appreciate that such a search is a "smell test" and there is no guarantee that the best art will be located since prior art encompasses "anything under the sun that is made by man." ( <i>1952 Patent Act Committee Report</i> ). |
| <input type="checkbox"/> Has the invention been made available to the public and if so, is a potential one-year grace period still available?                                  |   |
| <input type="checkbox"/> Is it new? -- Invention must be novel, meaning that it differs from all pre-existing knowledge  |   |
| <input type="checkbox"/> Is it non-obvious? – Inventions must not be obvious to normal practitioners in the field to which the invention pertains                              |   |
| <input type="checkbox"/> A plant patent may be available to protect asexually reproduced plants, other than a tuber propagated plant or a plant found in an uncultivated state |   |

## 4. PREPARING AND FILING A UTILITY APPLICATION

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- Utility patent application transmittal form – Provides a list of the elements of a patent application and must be completed and signed by the applicant if submitted with the application
- Fee transmittal form – Form used to identify the fees that are being submitted with the patent application
- Application data sheet – Form that lists bibliographic data including inventor information, applicant information, correspondence address, application, domestic benefit, foreign priority, and assignee information
- Small and micro entity status – Applicants who have small or micro entity status are entitled to discounts on certain fees, which is based on criteria such as company size and income level
- Assignment – If someone other than the inventor(s) will own the application
- Power of Attorney – Permits legal counsel to represent the applicant
- Specification – A collection of documents that describe the invention and how it is made or used. It must be written in full, clear, concise, and exact terms such that any person knowledgeable in the same technology would understand the invention. A specification typically includes a title, cross-reference to related applications, whether the federal government was involved in sponsoring the research or development, reference to a “sequence listing” (if applicable, in the case of some biological related applications), a background to the invention, a brief summary of the invention, brief description of the drawings (as well as the drawings themselves, which are almost always necessary to understand the subject matter to be patented), a detailed description of the invention, claims (defining the scope of legal protection), and an abstract
- Inventor’s Oath or Declaration

## 5. FOREIGN PATENT PROTECTION

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If foreign protection is desired, foreign filings must generally be made within one year of a priority filing for either a first filed provisional or utility application, or within six months for design applications. In some cases, an international application may be filed under the Patent Cooperation Treaty (PCT) to extend the time for entering various national phases until typically thirty months after a priority filing. A PCT application provides a strategic advantage in that a decision to file for patent, in foreign countries and in the US, can be deferred as any related products mature in the global marketplace.

## 6. PROSECUTION

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Once filed with the United States Patent and Trademark Office (“USPTO”), the application is first subject to procedural consideration. It is reviewed for completeness, and if necessary various communications will take place to address procedural issues. Once the procedural review is complete or a confirmation made of timing for making select later filings (e.g., a later filed declaration or oath), a filing receipt is generated.

The application is then put in queue and eventually subjected to substantive examination. The Examiner will send out one or more office actions and your legal counsel will prepare and file responses to the office actions to address the concerns raised by the examiner including differentiating your invention from cited references. While not required, an examiner interview is often encouraged to resolve issues and shorten the prosecution process. The examination process typically involves at least one and often two office actions. It is also possible to continue examination or to submit an appeal for consideration by a specialized appeal board in the USPTO after responding to a final office action and receiving an advisory action if agreement is not reached.

If your application is allowed, any remaining procedural issues must be addressed, and an issue fee paid to the US government. Then the patent issues – at which point it may be enforced.

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## 7. EXPEDITING OR EXTENDING THE UTILITY PATENT PROCESS

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If desired it may be possible to expedite utility patent prosecution once a utility application is filed, although in some cases an additional fee is required. A provisional application, on the other hand, provides a year grace period before a full utility application and any corresponding foreign application must be filed. A provisional application automatically expires a year after it is filed. It is also typically less expensive to prepare or file although it is never examined, so may be useful if timing, cost, or ongoing development are factors.

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## 8. MAINTENANCE FEES

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The USPTO requires payments at 3.5, 7.5, and 11.5-year intervals, subject to extensions, after issuance to maintain a utility patent. No maintenance fees are due for design or plant patents. Most other countries require annual payments. Docket these dates on your end and keep track of them even if you are still using legal counsel. Ultimately, you are responsible for these dates and not your legal counsel!

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## 9. PRODUCT MARKING

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Products associated with patents should be marked, accordingly. When a patent application is filed, it is permissible to mark any related product as “Patent Pending”. However, once any patent issues it is imperative to mark any related products with any corresponding patent numbers, to maximize possible damages that may be available for infringement. Marking may take different forms, such as marking the product itself, its packaging, and/or utilizing a virtual mark in combination with a website. The statute is strict in its requirements, designed to ensure that the public, and competitors, are properly placed on notice about any related patents.