

# PROTECTING EVERYTHING YOU CAN IMAGINE!

## WHAT EVERY INVENTOR AND COMPANY SHOULD KNOW ABOUT PATENTS

Whether you've invented a better mousetrap or cloned a sheep, our patent attorneys are skilled and experienced in advising creative inventors, companies and universities in how best to protect their valuable intellectual property. It's what we do – and it's all we do! Our mission is simple, ***“Protecting everything you can imagine!”***

The patenting process is very complex. Even the U.S. Supreme Court has observed that a patent application is probably the single most difficult legal document to draft. Whether you are an inventor tinkering in your basement or a corporate director of research and development, you probably have questions about the patenting process. To answer those questions, we have compiled a list of “Frequently Asked Questions” culled from thousands of consultations our patent attorneys have provided over the years.

### Part 1 - The Basics

***Question: What is a United States patent?***

*Answer:* A U.S. patent is a government grant of a property right, giving the patentee the right to exclude others from making, using, or offering for sale the patented invention in the United States for a period of time.

***Question: Are there different kinds of United States patents?***

*Answer:* There are three different types of patents in the United States: utility patents that protect useful inventions; design patents that protect ornamental designs; and plant patents that protect plants (e.g., a new species of orchid).

***Question: What are the terms of United States patents – how long do they last?***

*Answer:* Presently the term of a U.S. utility patent is 20 years measured from the date of application (prior to June 1995 the term was 17 years from the date of issue); the term of a design patent is 14 years from the date of issue; and the term of a plant patent is 20 years from the date of application.

***Question: What kinds of inventions are eligible for patent protection?***

*Answer:* Eligible subject matter for patent protection includes new and useful articles of manufacture, machines, processes and

compositions of matter, and improvements of the same. In addition, patent protection is available for ornamental designs of articles of manufacture as well as for certain types of plants.

***Question: What are the general tests for patentability of an invention for a utility patent?***

*Answer:* The invention must be novel (never been done in exactly the same way by anyone in the world before; useful (you can't patent a perpetual motion machine); and, the invention must have been non-obvious to one having ordinary skill in the art at the time the invention was made.

***Question: I understand novelty and usefulness, but how is obviousness determined?***

*Answer:* Obviousness is a question of law based on underlying factual inquiries. The factual inquiries, as enunciated by the Supreme Court, are as follows:

1. Determining the scope and content of the prior art;
2. Ascertaining the differences between the claimed invention and the prior art; and,
3. Resolving the level of ordinary skill in the pertinent art.

In addition to the above-described factual inquiries, the Patent Office is required to evaluate objective evidence of non-obviousness when it exists. These so-called “secondary considerations” may include evidence of

commercial success, long-felt but unsolved needs, failure of others, and unexpected results.

In assessing the scope and content of the prior art, the Examiner is expected to give the claims the broadest reasonable interpretation consistent with the specification. The law also charges a hypothetical person with ordinary skill in the art with knowledge of all of the pertinent prior art known at the time of invention. Factors that may be considered in determining the level of ordinary skill in the art include: (1) “Type of problems encountered in the art;” (2) “prior art solutions to those problems;” (3) “rapidity with which innovations are made;” (4) “sophistication of the technology;” and (5) “educational level of active workers in the field. In a given case, every factor may not be present, and one or more factors may predominate.”



The Supreme Court and the Patent Office have enunciated several different rationales upon which obviousness type rejections may be supported. Prior art is not limited just to the references being applied, but includes the understanding of one of ordinary skill in the art. With this in mind, it should be appreciated that rejections on obviousness cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational understanding to support the legal conclusion of obviousness. These rationales may include one or more of the following:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. Against this backdrop, patent attorneys consider and analyze the references discovered in a patentability search to assess obviousness.

**Question: How do I determine if my invention is patentable?**

*Answer:* The best way to determine the likelihood of obtaining a patent is to have a preliminary novelty search done and an opinion prepared by a patent attorney. A preliminary novelty search comprises a search of published patent applications, issued patents, and other publications. These searches are traditionally conducted by a professional searcher in the public search room of the United States Patent and Trademark Office. Upon completion of the search, a patent attorney reviews and studies the search results and renders an opinion on patentability.

**Question: How high a confidence level can I expect to have in a professional search and opinion?**

*Answer:* That’s anybody’s guess. Patent searches are usually conducted by professional searchers who conduct their searches in the Public Search Room of the United States Patent and Trademark Patent and Trademark Office. Searchers in the Public Search Room have access to databases which include issued United States Patents dating back to 1789; published United States Patent Applications dating back to 2001; applications and patents procured via the European Patent Office (EPO); and applications and patents procured through the Japanese Patent Office (JPO). These combined databases contain more than 30 million documents. Searchers are looking for a needle in a haystack, and the sheer volume of documents they need to search makes it possible, if not likely, that one or more pertinent prior art references may be missed or overlooked. To search intelligently, you need to know where to look. There are approximately 450 major classes in the United States Patent Classification System, and more than 150,000 sub-classes. Foreign patent documents are cross-referenced with the U.S. system.

**EVEN THE U.S. SUPREME COURT HAS OBSERVED THAT A PATENT APPLICATION IS PROBABLY THE SINGLE MOST DIFFICULT LEGAL DOCUMENT TO DRAFT.**

Professional searchers first try to identify where the pertinent documents are likely to be found – which haystacks – or classes and sub-classes – should be searched, and then they try to look at each and every document in each and every pertinent class and sub-class. They also do keyword searching, but this method isn’t always dispositive. Perhaps a rose by any other name would smell as sweetly, but you won’t find a widget in the patent database if someone

called it by another name, which is quite possible when you consider that nearly half of all patent applications filed with the USPTO each year are filed by foreigners. You should also appreciate that a prior publication anywhere in the world can prevent you from getting a patent. It doesn’t have to be a patent document – it could be a book, magazine article, academic article, etc. There are more than 200 countries with patent systems, and not all of these systems are searchable at the PTO Public Search Room. Moreover, not all patent application are published, and even those that are published are not published immediately (U.S. applications that are published are published 18 months after filing). There is always a risk that someone has already applied for a patent for your invention, or for a similar invention that might prevent you from patenting.

**Question: Why don’t you search every patent office in every country to get a more conclusive opinion on patentability?**

*Answer:* Simple economics. There are more than 200 patent offices in the world. To do a search in each patent office would

likely cost more than \$200,000. You would end up with a more conclusive opinion, although you still wouldn't have access to confidential patent applications, and you would have spent far more than the cost of obtaining the patent itself.

**Question: How much does a preliminary novelty search and opinion cost?**

*Answer:* Our firm charges a fixed fee of \$1800 to conduct a search and render an opinion for most inventions; and \$2000 for software and business method type inventions.

**Question: How much does it cost to obtain a Patent?**

*Answer:* It can cost anywhere from \$5,000 - \$12,000 to obtain a utility patent, while most design patents can be obtained for \$2,000 - \$3,000. The cost depends on the complexity of the invention, the number and nature of drawings, if any, necessary to illustrate the invention, the number and nature of prior art publications that must be distinguished, and how complete an invention disclosure (description of the invention) the patent attorney is given to work with. The cost also depends on how much protection the patent application seeks to obtain, and how much resistance the Patent Office imposes during prosecution of the application.

**Question: Why should I do a search and have an opinion rendered on patentability?**

*Answer:* Again, simple economics and something more. If the search results are "negative", i.e., result in a negative opinion on patentability, you have saved the expense of a patent application. Even if the search results are positive and result in a favorable opinion on patentability, the search results will almost certainly assist the patent attorney in drafting claims of appropriate scope – seeking as broad protection as possible for the invention while still distinguishing patentably over the prior art. This may save additional expense during prosecution of the application.

**Question: What does a patent application comprise?**

*Answer:* An application for a patent is both a legal and technical document which includes a recitation of the background of the invention, a brief summary of the invention, a brief description of the invention, a detailed description of the preferred embodiment, a set of claims, and an abstract. The application must describe the invention in such complete detail that it enables a person having ordinary skill in the art to both make and use the invention. It must also set forth the "best mode" of the invention. Some people believe that patents are dull, tedious reading – documents filled with legalese and excruciatingly detailed technical descriptions of inventions.

**Question: What is the most important part of a patent?**

*Answer:* The claims. The claims define the metes and bounds of the invention and tell the world what is protected and what they shouldn't make, use or sell.

**Question: How do I tell if my patent attorney drafted good claims?**

*Answer:* In general, the fewer the words and the fewer number of elements recited – the broader the scope of the claim. For a "pioneer" patent where there isn't much prior art, you should expect to see very broad claims with few elements. In a crowded art area, however, where the invention relates to a narrow improvement, the claim may recite many elements and be somewhat wordy, an indication of a narrower scope of protection.

**Question: How long does it take to obtain a patent?**

*Answer:* It can take between 2-3 years after an application is filed to obtain a patent, if a patent is granted at all.

**Question: What are my chances of getting a patent on my invention?**

*Answer:* Again, your patent attorney should answer this question in a patentability opinion after conducting a search. But no competent patent attorney will give you a guarantee. You will likely receive an opinion that will use terms such as "likely" or "probably" patentable. You may see quantitative terms such as "60-40" or "50-50". If the opinion is "negative" it will likely use terms such as "at best 50-50", or "probably not patentable", or the like. Regardless of the formal opinion, you should appreciate that slightly more than half of all applications filed with the USPTO mature to issued patents.

**PROVIDE YOUR  
PATENT ATTORNEY  
WITH THE MOST  
COMPLETE WRITTEN  
DESCRIPTION AND  
DRAWINGS OF YOUR  
INVENTION POSSIBLE.**

**Part 2 – The Process**

**Question: What happens during prosecution of a patent application?**

*Answer:* Once received by the Patent Office, the application is assigned to an art unit, and then reviewed by the Patent Office and an Examiner from an appropriate art unit is selected to examine the application. The Examiner then searches and analyzes the relevant prior art and compares it to the invention as claimed to determine whether the invention is patentable. The Examiner then mails a first Office Action, which indicates whether the Patent Office has accepted your application as written (which occurs very rarely), or denies your application (as is usually the case). The Examiner may allow all claims, allow some and reject some, or reject all claims. The Applicant is given a period of time to reply to the Office Action (usually 3 months,

although a reply can be filed within 6 months with payment of time extension fees). The reply may include an amendment of some or all of the claims to better distinguish over the prior art, and/or may include a request for reconsideration of the rejection. After consideration of the reply to the first Office Action, the Examiner will either issue a Notice of Allowance, or issue a second Office Action. Again, the second Office Action may include a rejection of some or all claims. At this point, the Examiner may make the rejection “final”. If this happens, the Applicant doesn’t have an absolute right to further amend the claims, although the Examiner may permit it. When facing a final rejection with no hope of amending the claims, the Applicant can appeal to the Examiner to reconsider the final rejection. Where the Examiner rejects the appeal, the Applicant can either file a continuation application, or appeal to the Board of Patent Appeals and Interferences. A continuation application is a second application for the same invention and is generally used to restart the application process. If the Board of Patent Appeals and Interferences rejects an Applicant’s appeal, the Applicant can appeal to the courts.

Thus, as is readily apparent, the application process is very time consuming; the time period between sending in the application and receiving a first Office Action is usually 12-18 months. In addition, response times between Office Actions can vary. Fees incurred to respond to Office Actions varies, but typically range between \$1800-\$2500. Appeals can be more expensive as a result of time and effort required for research and preparation of the appeal and can cost anywhere between \$2000.00-5,000.00.

**Question: How can I best assist my patent attorney to obtain the best patent protection for my invention, while keeping my costs down?**

*Answer:* Provide your patent attorney with the most complete written description and drawings of your invention possible. Respond promptly to all correspondence your attorney sends you during prosecution. In analyzing prior art references cited during prosecution, concentrate on differences between your invention as claimed and the prior art. Never recite in writing similarities between your invention and the prior art – only the differences.

**Question: I am aware of some products/inventions of others that are similar to my invention – do I have to tell anyone about these other products and inventions?**

*Answer:* Yes. Under U.S. law, applicants for patents, and their attorneys, have a duty to tell the Patent Office about any prior art of which they are aware, where the prior art is material to patentability. If in doubt, it is probably a good idea to disclose the information to the Patent Office. Disclosure is made by way of an Information Disclosure Statement (IDS). The IDS is due

to be filed three months after filing the patent application, or by the time of mailing of the first Office Action from the Examiner, whatever occurs last.

**Question: My patent application has been filed, but long periods of time go by without any word from my patent attorney? Is this normal?**

*Answer:* Yes, this is normal. First, you should appreciate that attorneys have an ethical duty under both state and federal rules to keep their clients informed of progress of the matters entrusted to them, although they are not required to perform this communication for free. To meet this duty, the attorneys in our firm communicate with our clients in writing whenever anything of interest occurs during prosecution (notification of impending due dates, receipt of filing receipt, filing of IDS or reply to Office Action, etc.). It is not uncommon for even one year to go by after filing before an Office Action is received, during much of which time you won’t hear anything from patent counsel.

**Question: Are there due dates associated with prosecution? If so, how does my patent attorney ensure that all due dates are met, that everything proceeds smoothly, and that my rights are protected?**

*Answer:* There are several due dates associated with prosecution of a patent application before the United States Patent and Trademark Office, and many of these due dates are critical (if you don’t meet them, rights are lost), or important (if you don’t meet them, it will increase your patenting expense). There are other more general due dates, also critical, such as when your patent application must be filed in the U.S. or in foreign countries to preserve rights. Our firm uses a sophisticated docket software program to track client matters and associated due dates in more than 200 countries. Our paralegals are highly trained to know how to docket due dates, and our attorneys receive weekly written docket reports to help them manage their workloads. Everyone in the firm has immediate access online to the docketing software. We use a “checks and balances” system where paralegals, under attorney supervision, put due dates on the system. Attorneys can browse due dates but can’t remove them, and paralegals can remove them only with permission from the responsible attorney. We bill our clients nominal fees for these very important docketing services, so our clients can see from our invoices that we are taking all necessary steps to protect their rights, and can see exactly how we ensure that we meet critical due dates, and how much time it takes to keep track of them.

**Question: Are there costs to maintain my Patent?**

*Answer:* Yes, if your application for patent is finally granted, an Issue Fee must be paid. Maintenance fees must be paid for

Utility Patents at 3½, 7½, and 11½ years after issuance. Maintenance fees are not required for Design Patents.

**Question: How do I protect my invention in foreign countries?**

**Answer:** A U.S. patent only provides patent protection in the United States. To protect the invention in foreign countries, it is necessary to file patent applications in the countries where protection is desired. There are several possible routes and strategies that can be employed for foreign filing. The United States is a member country of the Patent Cooperation Treaty (PCT), and, in some circumstances, it makes sense to file an international application under the PCT. In other circumstances, it may make sense to file an application with the European Patent Office (EPO), or other regional patent office. In other circumstances, it makes sense to file foreign patent applications directly in the countries where protection is sought.

**Question: Can I file a patent application in a foreign country before I file in the United States (I am a U.S. citizen)?**

**Answer:** Not without first obtaining a foreign filing license from the United States Patent and Trademark Office. Such a license is usually granted automatically when you first file in the United States. One of the first things the U.S. Patent Office does upon receipt of a patent application is to review the subject matter of the application to see if it discloses subject matter of interest to national security. The Patent Office then makes a decision as to whether to grant a foreign filing license, which indication is made to the applicant via the official filing receipt for the patent application.

**Question: Are there time limits and deadlines associated with foreign filing?**

**Answer:** Yes. Under the Paris Convention, applicants for patent in the U.S. generally have one year to file patent applications in foreign countries that claim the benefit of the U.S. filing date. There are other numerous due dates associated with practice under the PCT, and during nationalization of patent applications in foreign countries.

### **Part 3 - Things That Can Jeopardize Patent Rights**

**Question: Can I publish, publicly use or offer my invention for sale before I apply for a patent?**

**Answer:** Doing any of those things can immediately cause you to lose valuable foreign patent rights. In the United States, applicants have a one-year grace period to file patent applications after publication, public use or offer for sale.

**Question: Should I tell anyone about my idea or my invention?**

**Answer:** Until you have filed an application for patent, you should not disclose your idea or your invention to anyone other

than your attorney. Generally, ideas are not protected and if you disclose your invention to another, you may lose or jeopardize your rights to obtain patent protection in the U.S. or foreign countries. If you must disclose your invention to others, you should do so only under the protection of a carefully drafted confidentiality agreement.

### **Part 4 – Myths And Old Wives’ Tales**

**Question: Someone told me that I should create a written description of my invention, seal it in an envelope, and mail it to myself by registered mail. I haven’t opened the postmarked envelope. Does this protect my rights?**

**Answer:** Yes and no! In the United States, patent rights are awarded to the first to invent, and not to the first to file a patent application (as in many other countries). Mailing a description of the invention to yourself is one way, but not the best way, to help prove your date of invention, which might prove useful in an interference proceeding to determine who among competing applicants for patent was actually the first to invent. There are, however, far better ways to establish dates of invention, such as meeting with a patent attorney and disclosing the invention during the meeting, or keeping a hardbound inventor’s notebook in indelible ink, carefully and completely describing progress made in making the invention, recording the dates of such progress, and having the entries in the notebook witnessed by two people who both understand the invention and are bound to confidentiality.

**Question: I’ve heard that a provisional application is a less expensive alternative to a conventional patent application?**

**Answer:** This is a myth, and inventors should beware of invention submission companies and the like who advertise the “provisional patent application” alternative as a gimmick to get inventor business. Here’s the straight scoop on provisional patent applications. A provisional patent application, which first became an option in the U.S. in June of 1995, is a special type of patent application that one can file with the United States Patent and Trademark Office. While it is true that it is less expensive to file a provisional patent application, as opposed to a conventional utility application, it is also true that a provisional application is never examined, and can never mature to a patent. A provisional patent application must be “converted” to a conventional application within one year after filing. When this is done, of course, the conventional filing fee must be paid, and so it actually costs more to file a provisional application and to convert it than it would cost to file the conventional application in the first place. It is also true that provisional patent applications don’t require submission of claims, but that doesn’t mean that it is good practice not to draft them before filing. There are solid legal reasons why a patent attorney would consider it good practice to draft claims before filing a

provisional patent application, even though they are not required. For example, the law requires that the patent application include a complete written description of the invention “as claimed” sufficient to enable one having ordinary skill in the art to make and use the invention. Well, if you don’t draft the claims, how do you know if the description in the provisional application is sufficient? Another disadvantage to filing a provisional application has to do with foreign filing. The one year time limit to foreign file under the Paris Convention runs from the date of filing the provisional application. This means that both the U.S. conventional application and foreign applications are both due to be filed within one year of filing the provisional application, if one desires to claim priority of the provisional application filing date. Since provisional applications aren’t examined, you don’t get the benefit of perhaps receiving an Office Action (to get an indication of whether the invention is patentable) before the time comes to foreign file, as you would enjoy in the case of a conventional filing. So, when is it prudent to file a provisional patent application? They are most commonly used in emergency situations, where an inventor has to publish his invention, and there is insufficient time to prepare a conventional application; where a company has an urgent need to file due to an impending trade show, etc. It may also make sense in cases where foreign filing is simply not contemplated. Finally, provisional applications may make strategic sense for independent inventors who want to minimize expense while using the one year period before the conventional conversion application is due to be filed to “test the waters” and try to market the invention.

## Part 5 – Marketing My Invention

**Question: I have an idea for an invention and I want to sell it to a company, what do I do?**

**Answer:** The first thing to do is to understand that marketing inventions is not easy and that there are many pitfalls. It should be appreciated at the outset that many companies will not even meet with individuals with whom they do not have an ongoing business relationship. In addition, even before they will meet to discuss licensing or assignment of an invention, many companies require “ideas” to be in the form of working inventions that are “patent pending” or already patented and proven to make or save them money. Indeed, many companies do not have the time or the resources to meet with every inventor who has a good idea or spend the time discussing the potential for an invention that may be marginally profitable. Thus, be aware of the market for your invention and maintain a reasonable outlook concerning the actual value of your invention.

**Question: A company has shown interest in my idea and wants to see my invention, what should I do?**

**Answer:** While such scenarios are very rare, you should not disclose your invention to a company unless it is patent pending or disclosed pursuant to a confidentiality agreement prepared by

a patent attorney. However, please know that many companies will not meet with inventors under terms of a confidentiality agreement and, if they do, the agreement is probably not very good, or is so one-sided that it actually benefits the company and not the inventor. In addition, keep in mind that if you offer to sell your invention pursuant to a confidentiality agreement, you may still lose valuable foreign filing rights.

**Question: How can Simpson & Simpson, PLLC help me market my invention?**

**Answer:** While we would like to, we really cannot help you “beat the bushes” to market your invention. However, we can help you by obtaining strong patent protection for your invention, by preparing meaningful confidentiality, licensing and assignment agreements, and by assisting in negotiations relating to the licensing or assignment of your invention to others.

## Part 6 – Where To Learn More

**Question: Where can I get additional information on the patenting process?**

**Answer:** We advise and invite individuals to familiarize themselves with patents, patent law, and the patent application process more thoroughly by visiting the U.S. Patent and Trademark Office Website site located at (<http://www.uspto.gov>); the website is full of valuable information that can help individuals learn more about patents. You can also find useful resources at the public library.

**Question: I have looked at the USPTO website, need more information, and I am seriously considering obtaining patent protection, what should I do?**

**Answer:** Call our office to schedule an appointment to have an initial consultation with one of our attorneys.

**Question: How much does an initial consultation cost?**

**Answer:** We are pleased to offer free initial consultations to all our clients.

## Conclusion

We hope that our brief summary has answered many of your questions. Again, if you have additional questions, we invite you to explore the U.S.P.T.O. website ([www.uspto.gov](http://www.uspto.gov)). If, after that, you have additional questions, or would like to set up an appointment to consult with one of our attorneys, please do not hesitate to call.

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