

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of [Title 35].

35 U.S.C. § 101

3 Patent Protection and Enforcement

Businesses generally refer to “patent protection” when meaning the protection afforded by utility patents. There are, however, three different types of patents: utility patents, plant patents and design patents. Each type of patent protects different intellectual properties.

A. Utility Patents

A utility patent protects machines, processes, articles of manufacture, compositions of matter, and improvements thereon. The invention itself must be novel, useful, and not obvious to one skilled in the art. Obtaining and protecting the patentable invention is neither quick nor inexpensive. However patent ownership allows the owner to exclude others from making, selling, or using the invention. In addition to their inherent value, patents are powerful marketing tool and affects the business’ valuation.

1. Preliminary matters

Before spending the time and resources in preparing and filing a utility patent application, businesses should consider several preliminary matters, including the use of patent searches and consideration of time bars, to avoid unnecessary expenses and more completely identify the patentable invention.

a. Patent Searches

The first step in determining whether a utility patent application should be filed and the scope of that application is typically a search. The business must first completely disclose the invention to the patent attorney and identify any publications and other inventions which describe or disclose, in whole or in part, related inventions.

The content of the invention disclosure varies depending on whether the invention is generally mechanical, electrical, or chemical, software, or is the result of a process. For mechanical inventions, the disclosure should include well-labeled drawings of the components and their interaction and provide a detailed description of the invention’s operation. For electrical inventions, the disclosure should include circuit diagrams. Chemical invention disclosures should provide a detailed written description of the methods of making and using the invention, its chemical structure, and end products.

Based on the disclosure, the patent attorney then examines the invention in light of the more than five million United States patents and any additional related publications identified to determine the possible scope of patent protection. While this search provides valuable information, it is limited to issued patents which have not been lost, misplaced, or incorrectly classified. Such searches are considered an indicator of potential impediments to patent protection. A more thorough search of patents in various countries and publications in indexed journals is possible and more reliable but may not be cost effective for the typical invention.

The patent attorney provides a written evaluation of the possible extent of patent protection. The search report with an evaluation identifies the prior art identified, the scope of the prior art, and the extent to which the invention may be patentable.

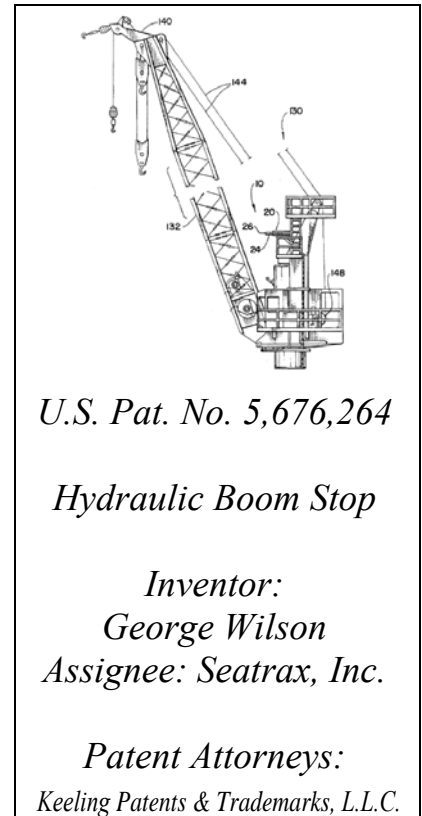
The patent attorney and client must then determine whether to pursue patent protection based on the written evaluation. Alternatively the patent attorney and client may elect not to pursue patent protection or instead to protect the invention as a trade secret, if possible.

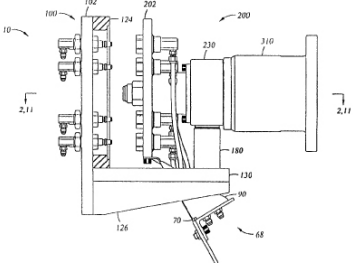
b. Time Bars

Even if the patent attorney determines the invention is not obvious to one skilled in the art and is useful, the patent attorney must identify dates which may render the invention unpatentable for lack of novelty. These bar dates preclude patent protection if:

1. the invention was in public use or offered for sale more than one year prior to the date of the application for patent protection in the United States; or
2. the invention was patented or described in a printed publication in the United States or a foreign country before the invention thereof by the applicant of a patent; or
3. the invention was known or used by others in this country or patented or described in a printed publication in this or a foreign country before the invention thereof by the applicant of a patent; or
4. the invention was first patented, caused to be patented or was the subject of an inventor's certificate by the applicant in a foreign country filed more than twelve months before the filing of the application in the United States.

In addition, many foreign countries bar patent protection of an invention if the invention is publicly disclosed before filing the patent application.





U.S. Pat. No. 6,017,065

*Remotely Operable
Underwater Connector
Assembly and Method*

*Inventor:
Bernt H. Hellesø*

*Patent Attorneys:
Keeling Patents & Trademarks, L.L.C.*

2. Preparation and Filing of the Application

The inventor or assignee may pursue a provisional or a non-provisional application. Both require a specification that completely discloses the invention. The provisional application is not examined by the Patent and Trademark Office but does obtain a filing date that may be of consequence regarding time bars. Unlike the non-provisional application, the provisional application is not required to contain the specific claims that identify the metes and bounds of the invention. However, if claims and all other required materials are not filed within one year, the provisional application will be abandoned.

a. Foreign filing rights

United States inventors can claim the benefit of the filing date of their United States patent applicable in foreign countries which are signatories to specific international treaties. Foreign patent applications filed under such treaties must be filed within twelve months of filing of the application with the United States Patent and Trademark Office. If an inventor intends to file for patent protection abroad, the application will be published eighteen months after filing. A potential patent owner should confer with the patent attorney before public disclosure of the invention as some countries bar patent protection to any invention publicly disclosed.

In the event the applicant chooses to pursue patent protection abroad, the United States patent application may be translated if necessary and the drawings modified to comply with the specific foreign patent office's regulations.

3. Office Actions

The patent attorney typically receives correspondence from the patent examiner at the United States Patent and Trademark Office less than one year after the complete patent application is filed regarding the patentability of the invention and the detail of the drawings, if applicable. This office action is the result of a search by the patent examiner of prior art, including patents and other materials cited by the Applicant as relevant to the invention at issue.

The inventor must decide based on the patent attorney's advice whether, in whole or in part, to (1) pursue the application as filed and argue the patent examiner's objection is in error, (2) revise the application as necessary to overcome the patent examiner's objection, or (3) abandon the application. The response to the office action is due within three months, although the deadline may be extended to six months with payment of additional fees. Responses to office actions and telephone conversations with the patent examiner may result in further office actions or in allowance of the application. Typically after the second office action, the application is either allowed or "finally rejected." The average time between filing of an application and issuance of the resulting patent is nineteen months. The Patent Office has a system for appeal of final rejection.

a. Patent Issuance

If the patent application is allowed, the patent examiner will issue a formal "Notice of Allowance" which will identify the three month period for payment of the issue fee. If this fee is paid, prosecution of the patent application ends and a patent will issue. If any patent applications which are continuations in part of the patent application at issue are to be filed, they must be filed before issuance of the patent.

b. Maintenance Fees

To preserve the utility patent for its lifetime (20 years from the date of filing), the patent owner must pay maintenance fees during the six month periods beginning at three and one-half years, seven and one-half years and eleven and one half years (3.5 yrs, 7.5 yrs, 11.5 yrs) after issuance. Failure to timely pay maintenance fees results in loss of the patent. Patent attorneys calendar such dates to notify clients when these deadlines approach. As a result it is imperative that clients advise their patent attorneys of any change in address or patent ownership.

An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Director.

35 U.S.C. § 111(a)(1)

U.S. Pat. No. 5,793,312

Data Entry System

Inventor:
Ryozo Tsubai

Patent Attorneys:
Keeling Patents & Trademarks, L.L.C.

4. Patent Infringement Issues

Receipt of a patent does not in and of itself prevent others from making, using, offering for sale, or selling any patented invention within the United States or importing any patented invention into the United States. This is accomplished through litigation or the specter thereof. Patent attorneys provide opinions and assist in litigation to enforce or defend patent rights, typically on an hourly rate basis.

a. Patent infringement opinions

Patent attorneys often provide opinions to clients regarding the potential of infringement between the client's invention or product and that of someone else. The patent attorney's opinion may include issues such as the validity of the patent, interpretation of the claims and whether a patent anticipates or is anticipated by the invention in question. In addition to providing some foresight regarding litigation, such opinions, when reasonably based on the law and relied upon by the client, provide a basis for good faith, which may minimize the damages at issue.

b. Patent infringement actions

Some disputes over patent rights cannot be resolved without litigation. Patent attorneys regularly participate in patent-related actions, either as primary counsel or as co-counsel for other trial attorneys. Recognizing the potential pitfalls in the patent's prosecution history and subsequent use is a specialized skill which is essential in such actions when determining whether there is literal infringement or infringement under the doctrine of equivalents.

B. Design Patents

"A design patent protects any new, original and ornamental design for an article of manufacture" for fourteen years and affords protection distinct from a utility patent.