

Do You Need to Patent It?

A patent is a legal protection granted only by the federal government. It lets the patentee exclude others from making, using, or selling an invention, or offering it for sale. However, it does not carry the unrestricted right to make, use, sell, or offer an item covered by the patent, because other patents may cover aspects of the same item.

An invention must meet all of the following criteria to be patentable:

- “novelty,” in that it was previously unknown to others,
- “unobviousness,” to a person having ordinary skill in the technology, and
- “utility,” in that it has a useful purpose, actually works, and is not frivolous or immoral. (Working models are no longer required to provide this attribute, except for inventions that are claimed to be perpetual motion devices.)

In recent years, the U.S. Patent and Trademark Office (PTO) has broadened the scope of the things it considers patentable to include genetically altered plants and animals and computer-related business methods. Some critics have contended that patents are being granted for basic science and to inventions lacking novelty. The PTO has reacted to these criticisms, in part, by enhancing the training of examiners, revising its examination materials, expanding its research activities, and increasing the quality of its review procedures.

There are several types of patents. You can obtain a *utility patent* (also called a *functional or mechanical patent*) for the following classes of new and useful inventions:

- Processes: chemical, mechanical, or electrical procedures, such as a method for refining petroleum.
- Machines: mechanisms with moving parts, such as a motor.
- Articles of manufacture: man-made products, such as a hand tool.
- Compositions of matter: chemical compounds, combinations, or mixtures, such as a plastic.

In addition, you can obtain a *design patent* for a new original and ornamental design for a manufactured article, and a

plant patent for a new variety of seed or plant or any of its parts.

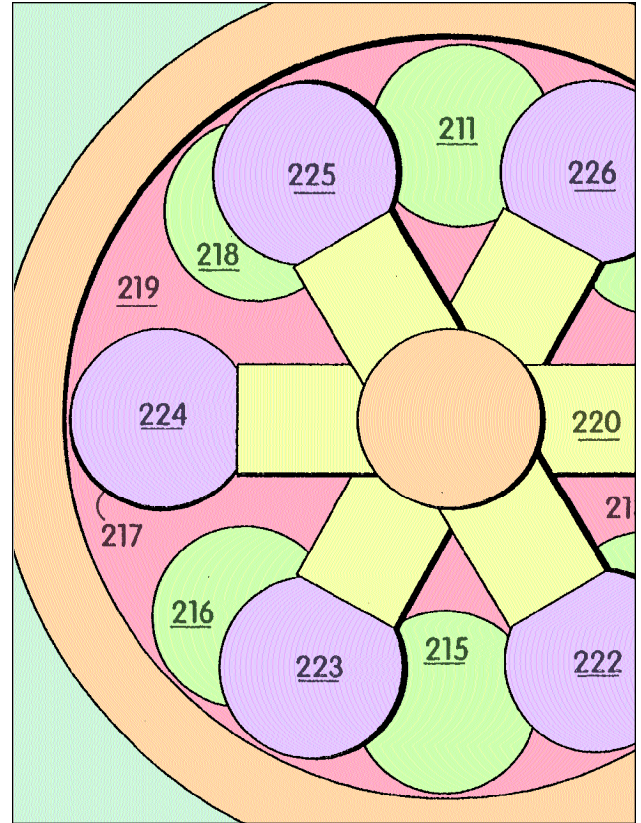
Procedure

Care must be taken in applying for a U.S. patent. You have one year after the first public disclosure of an invention in which to file a U.S. patent application for it. A patent is barred if any one of several things has occurred more than one year before the filing date of the application: the patenting of the invention by anyone; a description of it appearing in a printed publication anywhere in the world; its public use or availability for sale in the United States; or the inventor being granted a foreign patent before the filing date of the U.S. application.

However, within one year after first public disclosure, you may file a simple, inexpensive application describing the invention. This provisional application gives you an additional year in which to file a complete patent application.

A patent application is not made public until a patent is issued (or for applications from outside the United States, 18 months after the earliest filing date). You do not destroy trade secret rights by filing a patent application. However, unless a patentable invention can be kept secret for many years, as the Coca-Cola formula has been, it is desirable to file a patent application without undue delay.

A preliminary patent search usually is indispensable to learn whether an invention is novel. In your application, seek to explain the novelty of your invention as specifically as possible so the patent will be upheld if it becomes necessary to enforce it.



Drawing for "Planar micro-motor and method of fabrication," U.S. Patent No. 5,412,265 by Ed Sickafus, May 2, 1995 (color added).

The PTO thoroughly examines applications for patentability. Moreover, anyone may seek a patent's re-examination at any time by raising a substantial new question that challenges its patentability, such as the prior existence of the technology. It normally takes several years before a patent is issued, and it may take even longer if complications arise. The PTO Web site offers further information about the patent process, including the cost of obtaining and maintaining a patent, and answers questions frequently asked by independent inventors (www.uspto.gov/web/offices/com/iip/index.htm).

Patent rights

When you have filed a patent application, you may use the informal legend "patent applied for" or "patent pending" on an invention and in advertisements for it. After a patent is issued, you may use the notice "patent" or "pat." and the number of

the patent. This notice is not mandatory, but it may be necessary if you ever try to get damages from an infringer. Use of an improper patent notice is punishable by a fine.

All patents in force on June 8, 1995, or issued on applications filed before then, automatically have a term of 20 years from filing or 17 years from the grant, whichever is longer. Utility or plant patents filed after that date generally last 20 years from the filing date.

The term can expire earlier if you fail to pay specified maintenance fees. You can get the term extended for up to five years for certain patents if issuance is delayed for various reasons. A design patent lasts 14 years from the date of issuance.

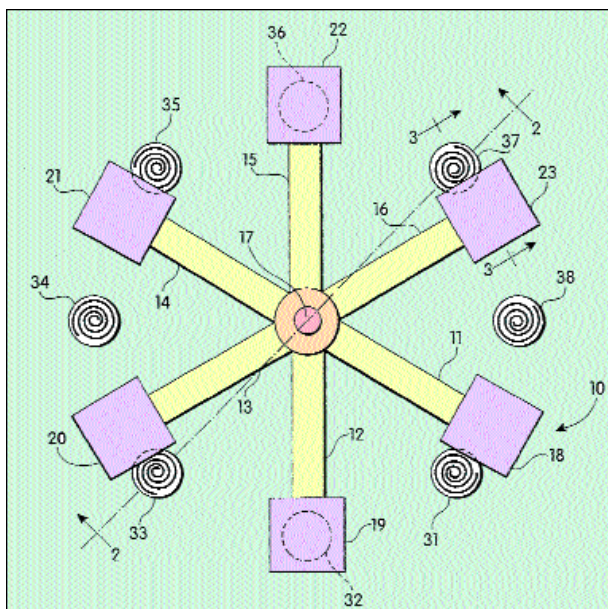
You cannot renew a patent, and because the invention is publicly disclosed when the patent is issued, anyone can make, use, or sell it in the United States after the patent expires or it is declared invalid.

Who owns a patent

If you are the first to conceive a patentable invention, you normally own it if you work with reasonable diligence to reduce it to practice by making a working device embodying the invention or by filing a U.S. patent application. You should evidence conception by making a disclosure record, which may be a simple written description and sketch of the invention, dated and signed by the inventor and by a witness capable of understanding the invention.

Normally, only the actual individual inventor can apply for a patent. If the invention is a team effort, as it often is in industrial research, all joint individual inventors must sign the application. Otherwise, the resulting patent will be invalid, although errors arising without any deceptive intent can be corrected.

You can record in the PTO a written assignment of the entire invention to an individual, group, or corporation—or a part interest in it—either when you file the patent application or later. Employers often require the assignment of future inventions and patents to them.



Small businesses and nonprofit organizations can elect to own inventions made under federal grants, but the government retains a nonexclusive, royalty-free license, and U.S. industry has preference in the use of such inventions.

Infringement remedies

If a patent is valid, it protects against the unauthorized manufacture, use, sale, or offer for sale in the United States of all devices or processes (except for medical or surgical procedures) embodying the invention, or of components intended for assembly abroad into such devices. It also protects against the importation, use, or sale in the United States of a product made from a patented process without authorization. A prior-use defense, however, permits you to continue using a software-driven business method, if you reduced it to practice and used it commercially at least one year before the effective filing date of someone else's patent application.

A patent protects against even innocent infringements, not just infringements by those breaching a confidentiality obligation, and it is the only way to protect an invention after it is no longer secret.

There are no criminal penalties for patent infringement. The civil remedies are an injunction against future infringement and compensatory damages, in no event less than a reasonable royalty, which may be trebled. The penalty for infringing a design patent includes the infringer's profits. However, you can recover damages only if the


infringer was notified of the infringement and continued to infringe, or the patented article bore a patent notice.

Federal law makes it a crime to steal unpatented trade secrets. Depending on the type of theft, individuals who are convicted can be fined up to \$500,000—and organizations up to \$10 million—imprisoned for up to 15 years, or both. In addition, a court may order forfeiture of any property involved in the violation.

International protection

If a U.S. resident intends to seek patent protection in other countries, it is essential to file in the United States before public disclosure. But under U.S. law, you cannot file a foreign patent application until six months after the filing date of your U.S. patent application, unless you have obtained a license for foreign filing from the Commissioner of Patents and Trademarks. The Commissioner can refuse the license and order the invention to be kept secret for national security reasons.

You can patent inventions only on a country-by-country basis. However, within one year after filing your U.S. patent application, you can file in the PTO an application under the Patent Cooperation Treaty, which preserves the original patent application's filing date and postpones for 20 to 30 months the need to file patent applications in other countries. You will find that many foreign countries charge patent maintenance taxes that increase annually and require either the local use of a patent or its compulsory licensing.

The process of obtaining a patent requires time and effort, but without a patent, your invention becomes free to all, once it is publicly known. 

B I O G R A P H Y

William M. Borchard is a partner in the law firm of Cowan, Liebowitz & Latman in New York City (wmb@ccl.com).