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Presents...

What Every Inventor Needs to Know About Patents

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What Every Inventor Needs to Know About Patents …

The Internet contains volumes of information for inventors. Here are some of the important points to be aware of:

1. Keep it confidential

You're excited that you just developed a new product and you'd like to know if it will be well received. You might think it's a good idea to approach companies and see how well they like your idea before considering a patent. But beware…showing your invention to a company before filing a patent application is not a good idea. Firstly, the company (believe it or not) might take your idea and claim it as its own. Secondly, your disclosure to the company might be considered either an offer for sale or a public disclosure of your invention. In the U.S. if you do not file a patent application by the first anniversary date of such an offer for sale or public disclosure, you will not be able to file for a patent at all. In many foreign countries, if not all, public disclosures or offers for sale may immediately result in loss of potential patent rights.

Non-disclosure Agreements: You may think that a non-disclosure agreement will provide you with enough protection to present your concept to a company without filing a patent application. Beware! There is no substitute for a regular non provisional utility United States patent application. Even if a company is willing to sign a non-disclosure agreement, such agreements are not fool proof. The company may argue that they already knew about your concept or that your concept is not new. And what if the company discloses your idea to another company which didn't sign the non-disclosure agreement? This could eventually result in someone else using your concept and the loss or your potential patent rights.

The bottom line is: file first and do your marketing later. After you file, it doesn't hurt to get the additional possible protection of a non-disclosure agreement.

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2. Prepare Written Documentation

It is important that you write down your ideas in detail, and provide at least rough sketches, drawings and/or diagrams. The format is not important at this time. The main thing is to work out all of the details of your invention, and to file a patent application as quickly as possible.

The following example illustrates the importance of filing a U.S. regular utility non provisional patent application, if possible. Suppose you first prepared a written description of an invention in 1980 but, never disclosed it to anyone in any way, and then stuck the description in a drawer for twenty years. You didn't file a patent application. Another person files a patent application in 2000 (twenty years after you came up with the idea). After doing nothing for 20 years you find out that the other person has filed, pull your dusty material out of your drawer, and file for a patent application in 2001. Who wins? Assuming the other person is honest (i.e. he or she didn't steal the invention from you) in all likelihood the other person wins. Your 20 year delay and failure to file in all likelihood causes the loss of your potential patent rights.

3. Do a Search

Doing at least a preliminary patentability search is important for a few reasons:

a. You want to know if your invention is already patented.

b. You want to know the details about similar inventions to show how your invention is new.

There are several sites on the Internet that allow you to search existing patents, for free:

A. US Patent & Trademark Office – Free Searching on full text since 1976, full page images since 1790 http://www.uspto.gov/patft/index.html

B. Google.com- Search over 7 million patents

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After you've done as much as you can, it may be worthwhile to hire a professional searcher, preferably one near the United States Patent & Trademark Office. These searchers can use electronic searches as well as visiting the PTO to talk with examiners.

Call us at 866-PAT-1NOW and we can help you get a search done by a professional.

Be aware that many sources of information can impact whether you can get a patent. For example U.S. and foreign patents, U.S. and foreign publications, and items sold or publicly used in the U.S. can impact whether you can get a patent. Any search that someone will do for you typically would be a "preliminary" patentability search and will certainly not be fool proof. It is very possible and even likely that the United States Patent and Trademark Office will find additional material that you or the professional searcher did not find in a search.

4. "Look before you leap" with Invention Promotion firms

You've seen it before…the TV commercial that claims every invention is worth millions of dollars so call immediately!

Unfortunately, there may be a lot of unscrupulous companies who make false promises about making money from inventions. Don't believe any company that guarantees you financial success for your invention.

Marketing your invention is a difficult process. Often manufacturers do not even want to hear about your invention unless you've already started the patenting process. The Federal Trade Commission (FTC) is a government agency that investigates invention promotion companies on behalf of consumers. They have a web page at:

FTC Consumer Alert:

Spotting the Sweet Sounding Promises of Fraudulent Invention Promotion Firms

US Patent and Trademark Office Warnings:

USPTO- Scam Prevention & Invention Promotion Firms

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5. *Don't Think it's Simple to Patent it By Yourself*

There are books & software available promoting the "do it yourself" patent. If you've already completed some of the patent searching, you may be thinking about filing the patent application yourself, without a patent attorney. That would be a big mistake.

There are many laws, rules, and regulations associated with United States Patent Law. Many times when a non patent attorney files a patent application, they make mistakes which cannot be fixed. This may result in the loss of your patent rights.

In addition, you might be able to get a patent, but your patent may be worthless. A patent attorney can help you get a patent that affords the most protection.

Some patents are written so narrowly that they are worthless because a tiny change in your concept by someone else would not be protected. A good patent attorney has the experience to know how to write and how to get the best possible claims. Often they will try to claim as much as possible and the Patent office may reject some parts. This is not an attempt to make the process last longer or cost more but rather it's a way to try to get you the most protection possible for your patent. The patent attorney you select will often have a degree in a technical area that allows them to fully understand your idea and they already have the legal background to understand the finer points required to develop the claims for the patent application, help you with contracts, licensing and more. For more information see our blog:

CHANCES OF GETTING A PATENT WITHOUT A PATENT ATTORNEY: NOT GOOD

- or - **Call us at 866-PAT-1NOW for a free phone consultation**

Walter J. Tencza, Jr. has a Bachelor of Science degree in Electrical Engineering from Lehigh University and a Juris Doctor law degree from Fordham University. He has been working in the patent field for over 25 years and has obtained a large number of patents for a diverse set of clients.

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6. Don't Underestimate the Value of Patents…

If you receive a new utility patent, you may be able to exclude others from making, using or selling your invention for a term ending 20 years from filing! You could also sell your patent or license the technology with the potential to make back the cost of the patent many times over.

That is why you need to get the patent application completed by an experienced professional. The only persons permitted to file and prosecute patent applications on behalf of individuals are patent attorneys and patent agents. You can confirm that an individual is authorized to practice before the United States Patent and Trademark Office by looking up the individual's name on the USPTO's web site at **www.uspto.gov**

With infringement awards often in the millions of dollars, "patents, trademarks and copyrights have become corporate treasures that their owners will do almost anything to protect" [1]

[1] Source: Time Magazine: "Creativity: Whose Bright Idea?" 6/10/91

7. Patent Attorney vs. Patent Agent

If you are filing a U.S. patent application, you may be tempted to use a patent "agent" instead of a patent "attorney".

After all a patent "agent" will probably be cheaper than a patent attorney.

A U.S. patent "agent" has the legal authority to prepare, file, and prosecute U.S. patent applications, just like a U.S. patent "attorney".

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So why not just hire a patent "agent"? What is the big deal?

Well, when you consider what a patent "agent" is not, and what a patent "agent" cannot do, you realize how much better it is to have a patent "attorney" or "lawyer" prepare and file your U.S. patent application.

A patent "agent" is not an "attorney" or "lawyer".

This is the heart of the matter. An attorney or lawyer typically has gone to law school for 3 years, has received a Law Degree (such as a Juris Doctor) from a law school, and has passed the rigorous requirements of one or more U.S. state bar examinations. For example, Walter J. Tencza, Jr. Esq, (732-549-3007; email: patent@patentnow.com; PATENTNOW.COM®) is a registered patent attorney, who went to Fordham Law School for 3 years, received his Law Degree from Fordham and passed both the New York state bar and the New Jersey bar examinations.

In addition, an "attorney" or "lawyer" may have practiced law on a range of legal matters, not just preparing, filing, and prosecuting patent applications. For example an attorney may have experience preparing patent infringement opinions, filing patent appeals to the Federal Circuit, litigating intellectual property matters in court, and preparing, filing, and prosecuting trademark matters.

Walter J. Tencza, Jr., Esq. has been practicing patent, trademark, copyright and other law for over twenty-five years, including not just preparing, filing, and prosecuting patent applications but litigating intellectual property related matters in courts, preparing patent infringement opinions, preparing non disclosure agreements and licensing contracts, and preparing, filing, and prosecuting trademark matters.

Patent "Attorneys", from going to law school, from obtaining a Law Degree, from passing one or more state bar examinations, and from practicing law on a range of issues, have a deep understanding of the Law. How to research it. How to apply it.

How different cases, statutes, rules, and regulations can interact and affect one another.

- Patent "Agents" have not gone to law school, have not gotten a law degree, and have not passed any state bar examination.

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- Patent "Agents" cannot litigate intellectual property matters or any other matters in courts.

- Patent "Agents" cannot render any opinion on patent infringement.

- Patent "Agents" cannot prepare licensing agreement or non disclosure agreements.
- Patent "Agents" cannot prepare, file, and prosecute trademark matters.
- Patent "Agents" cannot file patent appeals in the Federal Circuit court or challenge a decision in a District Court.

Furthermore, client communications with a Patent "Agent" are not protected as broadly as Communications with a Patent "Attorney"

For example, communications with a Patent "Agent" regarding possible patent infringement, possible patent litigation in courts, trademark issues, and licensing issues would in all likelihood not be protected by Attorney (or Agent) Client Privilege, whereas communications regarding such subject matter with a Patent "Attorney" in appropriate circumstances would be protected by Attorney-Client Privilege.

Because of all of the foregoing, Patents prepared by Patent "Agents" may be Inferior to Patents prepared by Patent "Attorneys"

There is a saying that patents should be prepared with "an eye toward litigation".

However, If a patent "agent" cannot go to court, cannot even render a legal opinion on infringement, and did not go to law school, what kind of an "eye" will a patent "agent" have for preparing strong patents.

And if a patent "agent" is not qualified to give an opinion of infringement, what incentive does a patent "agent" have to keep up with, or even be aware of patent "infringement" law.

Most inventors don't just want patents. They want patents that will protect them. They want patents they can use to sue someone for infringement if someone "takes" their invention.

How can a Patent "Agent" prepare a strong patent, when a Patent "Agent" cannot even answer the question every inventor wants to know:

Would that infringe my Patent?

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8. Learn, Learn, Learn

The more you know about what else is out there and the details of the patenting process, the better off you will be. Here are some other sites for inventor's information:

US Patent & Trademark Office – General Information on Patents

US Patent and Trademark Office- Trademark Basics

For example, did you know the process could take years to complete? Your patent attorney can take anywhere from a few days to many weeks (depending on how complicated the invention is) to write up the patent application. You, as the inventor, should be involved in this process. You should review the application very carefully and the patent attorney should revise the application based on your comments. After both the inventor and the patent attorney are satisfied with the application, it is filed with the US Patent and Trademark Office (USPTO).

Assuming the application is filed electronically, your patent attorney will get a filing receipt back from the patent office immediately confirming that your patent application is pending and giving you a serial number for your application.

However, the USPTO has a huge volume of patent applications to process. For an average application, it might take 16 months to get a first response (known as a first office action) from them. For very complicated inventions or areas where the patent office has a backlog, it could take 2-4 years to get a first office action from the USPTO.

In the first office action you should expect one or more claims to be rejected. This is typical. Often the patent attorney is able to make arguments, amend claims, or add claims to achieve a more favorable result.

Both the patent and marketing of an invention are complicated and the more you educate yourself about the correct steps to take and how it all works, the better off you will be.

We hope this has been helpful, but if you have additional questions and would like **a free phone consultation,** please call us at:

1-866-PAT-1NOW.

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- Trademark and Copyright matters
- Licensing Agreements
- **Patent Infringement Litigation**
- **Preparation of Infringement Opinions**

Small Sample of Patents (View many more online)

Past clients run the gamut from solo inventors to large corporations like AT&T® & Lucent®:

7,824,445	Nov- 2010	Corpectomy vertebral body replacement implant **system**
7,594,636	Sep-2009	Picture frame positioner
7,589,793	Sep-2009	Television receiver that can receive both regular broadcast satellite television and digital terrestrial broadcast
7,465,052	Dec-2008	Image projection lighting devices with visible and infrared imaging
7,128,644	Oct-2006	Coin roll type coin operated redemption game where rolling coin turns into image on video screen
6,506,123	Jan-2003	Golf Putting Target
6,049,613	Apr- 2000	Method and apparatus for encrypting, decrypting, and providing privacy for data values

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