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Frequently Asked Questions: Patent

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Q: What does a patent protect?

A: An issued U.S. patent provides an inventor "the right to exclude others from making, using, offering for sale, or selling" the patented invention in the U.S. or "importing" the invention into the U.S. The patent owner is not necessarily granted the right to make, use, offer for sale, sell or import the invention, as other rights may be required to undertake those activities.

Q: How many types of patents are there?

A: In the U.S., there are three types of patents: Utility patents apply to inventions or discoveries of any new and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement. Design patents apply to a new, original, and ornamental design of an article of manufacture. Plant patents apply to inventions or discoveries of a distinct and new variety of plant that is capable of asexual reproduction, such as by grafting.

Q: What is a U.S. provisional patent application?

A: A provisional patent application is a placeholder application that only exists for 12 months, at which time it expires. It is not examined by the U.S. Patent and Trademark Office (USPTO), and will not directly develop into an issued patent. A regular, formal patent application for the same invention filed on or before the anniversary date of the provisional filing will substitute for the placeholder, will be examined by the USPTO, and will otherwise be treated as if it had the filing date of the earlier provisional application.

Q: Why file a U.S. provisional patent application?

A: A provisional patent application can represent a fast and less expensive way to secure a filing date for your invention than a full, formal application, while at the same time providing you a year to explore the invention's commercial potential before filing a formal patent application.

Q: What are the basic requirements for U.S. patenting of an invention?

A: U.S. patent law requires that the invention must be novel, useful, and non-obvious (when considered in light of the prior art). And there may be a bar to patenting an otherwise worthy invention. See the next reference regarding the one year on-sale bar.

Q: What is the one year "on-sale bar"?

A: The term "on-sale bar" refers to one of the provisions of the U.S. patent law that can be used to bar patenting an invention based on pre-existing use or knowledge of the invention. The on-sale bar generally comes into play from commercial use of the invention occurring prior to the filing of the patent application. In the U.S., the rule bans the grant of a patent for an invention if there is any definite sale, or offer to sell, the completed invention more than one year prior to the date the patent application is filed. Most foreign countries have a similar bar but without the one-year grace period.

Q: When should I contact a patent professional?

A: Because of the risk of losing rights to your patent by prior disclosure, you should always consult with a patent attorney before you attempt to market your invention,

i.e., before sending out letters contacting manufacturers, conducting test marketing or surveying potential customers. These activities should only be done under strict, formal and written terms of confidentiality with the third party in which your invention, and any trade secrets, are clearly defined.

Q: How long does a U.S. patent last?

A: The term of a patent is the maximum period during which it can be maintained in force. The term of a utility or plant patent for applications filed on or after June 8, 1995, is 20 years from the earliest claimed filing date. A design patent has a term of 14 years from the date of issuance.

Q: Can the ownership of a patent be assigned or transferred from one person to another?

A: Yes. A patent is assignable. Transfer and assignment documents may be recorded with the assignment branch of the USPTO.

Q: What is "patent infringement"?

A: "Patent infringement" is the term used to describe the unauthorized making, using, offering for sale or selling of a patented invention. A U.S. patent can only be enforced in the federal courts of the U.S., and by certain federal agencies. To determine if a patent is infringed, the patent's "claims" are carefully examined and compared to the allegedly infringing practice. Patent claims are found in a separate section of the issued patent and provide the legal definition of the patent's scope of protection. Each element, or limitation, of each claim must be compared with the limitations of the accused device or method. You should consult an experienced attorney to obtain a legal opinion of whether a product reads on patented claims.

Q: How is a U.S. patent enforced?

A: When patent infringement occurs, the patent owner may sue for infringement in a U.S. federal court. The court may issue an injunction to prevent the continuation of the patent infringement, and the patentee typically requests an award of damages from the infringer.

Q: What happens in a U.S. patent infringement case?

A: First, a judge will determine the scope of the claims of the patent, then either a judge or a jury will decide if there is infringement of the patent claims, and will resolve any issues relating to the patent's validity or enforceability. If the limitations of a valid patent claim are found to match the elements of the device or method (called "reading on" the device or method), an infringement has occurred. If all of the determinations of validity, enforceability, scope and infringement are found in the patent owner's favor, judgment against the infringer will be ordered by the court.

Q: What should I do if I think my patent is being infringed?

A: You should immediately consult an experienced patent attorney. Your attorney can provide an opinion regarding your patent claims and the alleged infringement. Your lawyer can also prepare a cease and desist letter and/or prepare a lawsuit.

Q: Should I be concerned about patent infringement if I create or distribute a new product?

A: Yes. You do not want to be accused of patent infringement if you create a new product or if you distribute a product created by someone else. Contact an

experienced patent attorney to determine whether the product reads on an issued and outstanding patent.

Q: What is a Patent Cooperation Treaty (PCT) patent?

A: The PCT is a treaty that provides an international platform for processing patent applications. PCT applications may be filed up to 12 months following the original filing date in a national patent office, and will be given that earlier filing date, the priority date, for purposes of examination in all following proceedings. The PCT application allows a single filing to be processed by the International Bureau, and then transmitted to a chosen number of signatory national patent offices. The process allows the delay of entry into those selected countries up to 30 or 31 months from the original filing date.