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*Maximizing a Company's Growth and Value By Strategic Use of Its Knowledge and Creations™
Managing Intellectual Property Consistent with the Company's Business Plans™*

Patent II - The Non-Provisional Patent¹

This article is the fourth in PIPS' series on Intellectual Property – what it is, the different types, when to use it, how to protect it and how it can be used to increase a company's growth and value.

This article will discuss the non-provisional patent, what it is and some key aspects of it. This article should not be considered as legal advice. Please discuss your specific situation with a knowledgeable expert.

What is a Patent?

The United States Patent and Trademark Office (USPTO or patent office) is the government agency responsible for examining patent applications and issuing U.S. patents. A patent is a type of property right. It gives the patent holder the right, for a limited time (usually 20 years from the date of filing the application) to prevent others from making, using, offering to sell, selling, or importing into the United States items within the scope of protection granted by the patent.

For U. S. patents, while the USPTO determines whether a patent should be granted in a particular case, it is up to the patent holder to enforce his or her own rights if the USPTO does grant a patent.

Patent rights are country specific. A patent only gives you rights in the country for which it is issued. There is no such thing as a world patent or even a European patent. Further information is provided below under "**International Patents**".

What Can Be Patented

Any person who "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," subject to the conditions and requirements of the law."

"process" is defined by law as a process, act or method, and primarily includes industrial or technical processes.

"machine" used in the statute needs no explanation.

"manufacture" refers to articles that are made, and includes all manufactured articles.

"composition of matter" relates to chemical compositions and may include mixtures of ingredients as well as new chemical compounds.

These classes of subject matter taken together include practically everything that is made by man and the processes for making the products.

A patent cannot be obtained upon a mere idea or suggestion. The patent is granted upon the new machine, manufacture, etc., as has been said, and not upon the idea or suggestion of the new machine.

Preparing for Patent Preparation

Preparing a patent is not a do-it-yourself activity. Patent rules are very complex and one needs to be very careful in writing the patent application to meet the patent office requirements and to obtain the maximum coverage allowable. The actual patent as filed with the patent office should be prepared by a trained individual (either a patent agent or a patent attorney). However, persons knowledgeable in patents and their use can help the patent agent or patent attorney by preparing the information resulting in a more efficient use of their time and in a patent that best fits with the company's business strategy.

¹ U.S. Patent and Trademark Office, "General Information about Patents",
<http://www.uspto.gov/web/offices/pac/doc/general/index.html#whatpat>

Before approaching a patent agent or patent attorney you, as an inventor/business owner/decision-maker, need to understand why you want to file for a patent and understand the pros, cons and alternatives. Since a U.S. patent will usually cost in excess of \$20,000, you will want to make sure that the patent will have a business value and not be simply a very expensive piece of “wall paper” with little or no strategic value to you or your company.

What is a Non-Provisional Patent?

As differentiated from a provisional patent (see article “*Patenting I - Provisional Patents*” at *Articles at www.protectiveipservices.com*), a non-provisional patent is evaluated by the respective patent office and can result in the granting of a patent which gives the inventor all of the rights mentioned above.

There are three different types of non-provisional patents.

1. “Utility” patents ([click here for more information](#))

The applicant must prove in the application that the patent is useful, novel and not obvious.

Useful – The term “useful” in this connection refers to the subject matter having a useful purpose and also includes operativeness. A machine which will not operate to perform the intended purpose would not be called useful, and therefore would not be granted a patent.

Novelty and Obviousness are discussed below.

2. Design patents ([click here for more information](#))

A design consists of the visual ornamental characteristics embodied in, or applied to, an article of manufacture. A design for surface ornamentation is inseparable from the article to which it is applied and cannot exist alone. It must be a definite pattern of surface ornamentation, applied to an article of manufacture. To be protected, a design cannot be functional – it must only be ornamental.

3. Plant patents ([click here for more information](#))

A plant patent is granted by the Government to an inventor who has invented or discovered and asexually reproduced a distinct and new variety of plant, other than a tuber propagated plant or a plant found in an uncultivated state.

Novelty and Non-Obviousness Criteria for Obtaining A U.S. Patent

In order for an invention to be patentable it must be new as defined in the patent law, which provides that an invention cannot be patented if:

“(a) 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 for patent,” or

“(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country more than one year prior to the application for patent in the United States . . .”

- If the invention has been described in a printed publication anywhere in the world, or if it was known or used by others in this country before the date that the applicant made his/her invention, a patent cannot be obtained.
- If the invention has been described in a printed publication anywhere in the world, or has been in public use or on sale in this country more than one year before the date on which an application for patent is filed in this country, a patent cannot be obtained. In this connection it is immaterial when the invention was made, or whether the printed publication or public use was by the inventor himself/herself or by someone else.
- **If the inventor describes the invention in a printed publication or uses the invention publicly, or places it on sale, he/she must apply for a patent before one year has gone by, otherwise any right to a patent will be lost. The inventor must**

file before or on the date of public use or disclosure, however, in order to preserve patent rights in many foreign countries.

Even if the subject matter sought to be patented is not exactly shown by the prior art, and involves one or more differences over the most nearly similar thing already known, a patent may still be refused if the differences would be obvious. The subject matter sought to be patented must be sufficiently different from what has been used or described before that it may be said to be nonobvious to a person having ordinary skill in the area of technology related to the invention. For example, the substitution of one color for another, or changes in size, are ordinarily not patentable.

Who May Apply For A Patent

According to the law, only the inventor may apply for a patent, with certain exceptions. If an inventor refuses to apply for a patent or cannot be found, a joint inventor or a person having a proprietary interest in the invention may apply on behalf of the non-signing inventor.

If two or more persons make an invention jointly, they apply for a patent as joint inventors. A person who makes only a financial contribution or was involved in any way other than making an intellectual contribution to the invention is not a joint inventor and cannot listed in the application as an inventor.

Publication of Non-Provisional Patent Applications

Publication of patent applications is required by the American Inventors Protection Act of 1999. Publication will occur 18 months after the earliest claimed priority date or under the Patent Cooperation Treaty.

There is an exception to the publication of a patent application that applies only to utility or plant applications that will not be filed in a foreign country that requires publication of the application. Following publication, the application for patent is no longer held in confidence by the USPTO and any member of the public may request access to the entire file history of the application. This will happen whether or not a patent is eventually issued.

As a result of publication, an applicant may assert provisional (this is not related to a provisional patent) rights. These rights provide a patentee with the opportunity to obtain a reasonable royalty from a third party that infringes a published application claim provided actual notice is given to the third party by applicant, and a patent issues from the application with a substantially identical claim.

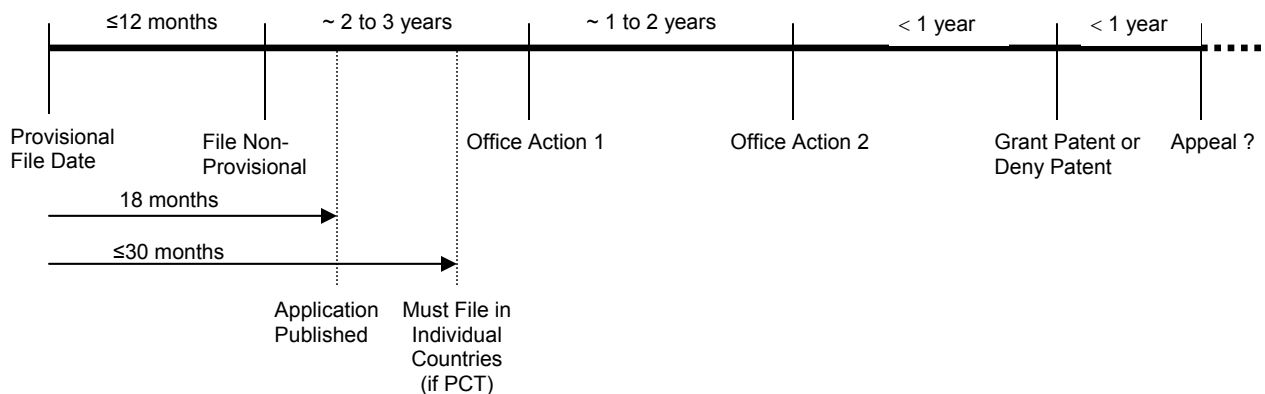
International Applications

International patents can be applied for by filing applications in each individual country or patent regions for which patent protection is desired, or by filing a Patent Cooperation Treaty application (PCT). The PCT procedure consists of two main phases. It begins with the filing of an international application and ends (in the case of a favorable outcome for the applicant) with the grant of a number of national and/or regional patents: hence the terms “international phase” and “national phase.” ([Click here for more information including a list of the PCT countries](#)).

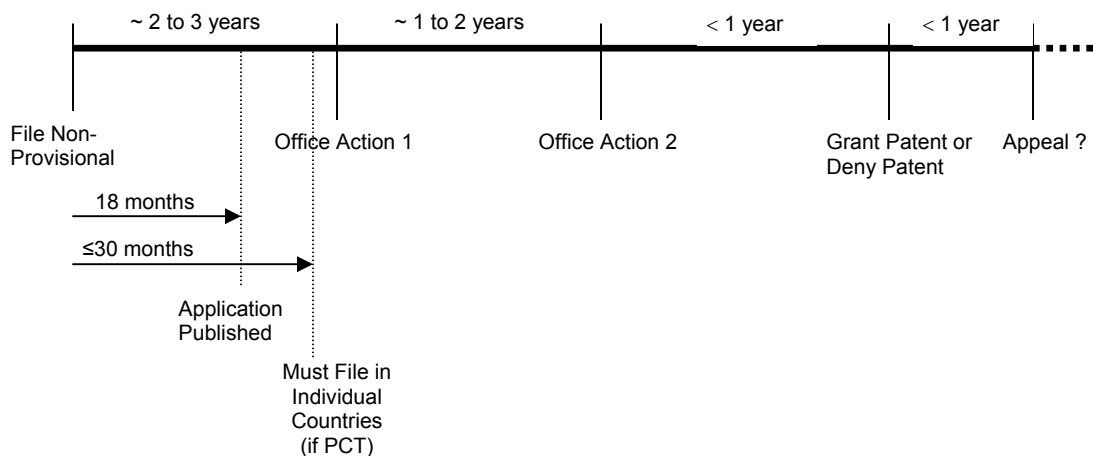
The PCT facilitates the obtaining of protection for inventions where such protection is sought in any or all of the PCT Contracting States. It provides for the filing of one patent application (“the international application”) instead of filing several separate national and/or regional patent applications. The PCT does not eliminate the necessity of prosecuting the international application in the national phase of processing before the national or regional Offices, but it does facilitate such prosecution in several important respects.

Timeline – The times vary according to the subject of the invention (art area) and the work load in the patent office. Times shown below are approximate and are for the U.S. Patent and Trademark Office.

If you are filing a provisional patent first, the approximate timing of your application's prosecution may be:



If you are NOT filing a provisional patent first, the approximate timing of your application's prosecution may be:



PIPS works with decision making executives in small to medium size technology and manufacturing companies who want to maximize their company's value and growth by use of its knowledge and creations. We do this by identifying a company's knowledge and creations and develop and assist in implementing an intellectual property strategy that is consistent with the company's business plans. We also evaluate a company's systems for protecting its knowledge and creations and that which it receives under agreements with other companies.

For a free analysis of how much energy your knowledge and creations can provide for the growth and value of your company please contact:

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