

PATENT LAW BASICS

A patent is a grant from the federal government, provided for in Article 1, Section 8, of the U.S. Constitution, "securing for limited Times to...Inventors the exclusive Right to their...discoveries." Congress set up a first patent board, originally consisting of Thomas Jefferson, Henry Knox, and Edmund Randolph. A patent gives an inventor a monopoly over his/her invention; or, in other words, an exclusive right to make, use and sell an invention for 20 years from the date of filing an application to the U.S. Patent and Trademark Office (the "PTO"). A patent can only be obtained for that subject matter which is non-obvious, useful, and novel, to someone with skill in the art. The subject matter may be a process, a machine, an article of manufacture, or a composition of matter. A patent may also be obtained for a design or for a plant. Unauthorized making, using or selling of a patented invention constitutes patent infringement. Under the Patent Cooperation Treaty, A U.S. citizen may file for patents in multiple countries on the same invention. Patents may be transferred by assignment, and the assignment recorded with the PTO.

To obtain a patent, an inventor must fill out an application with the PTO. First, a patent search should be conducted, and an opinion on the patentability of any invention obtained, to determine whether an invention is new (novel) and non-obvious. Patent searches may be conducted at patent depository libraries within each state or at the search room of the PTO in Arlington, Virginia. A patent application must set forth invention specifications in a manner so that someone with skill in the prior art is "enabled" to make the invention.

It is important for inventors to note that an application for a U.S. patent must be filed within one of the first "public use" or "offer to sell" or disclosure of the invention. These one year time frames constitute "statutory bars" to the filing of a valid U.S. patent application. A patent application may be deemed invalid after these one-year "bar" dates. Similar prohibitions generally exist to preserve a right to a foreign patent.

The patent application typically has three parts: (1) the specification - a description of the background of the invention, and its improvements over prior inventions, and the "preferred embodiment" for making and using the invention, (2) drawings of the invention and (3) a set of claims -which establish the scope of the invention. Also generally included with a patent application are an invention disclosure statement ("IDS") and an oath or declaration. The IDS provides a disclosure of all information known by an inventor about past inventions, developments and products in a particular prior art filed.

The process of PTO examination of a patent application, PTO rejections and claim amendments and responses is termed the "patent prosecution." It may take from 2 to 4 years for a utility patent to be granted by the PTO. Fees for a patentability search and opinion, application filing, patent issue and patent maintenance will be required. Additional fees may be required during the patent prosecution process.