

Legal matters

PATENT TALK FOR THE NEW INVENTOR

What is a patent?

A patent is deal between an inventor and a government. The inventor discloses a novel, useful and not obvious invention. The government grants a temporary right for the patent owner to keep others from making, selling, using, or importing the invention without permission.

Are there different types of patents?

Yes. There are three types of U.S. patents.

- A *Utility Patent* covers useful processes, machines, articles of manufacture, compositions of matter, and improvements thereof.
- A *Design Patent* covers new, original, ornamental designs for articles of manufacture.
- A *Plant Patent* covers certain asexually reproduced plants.

When the public thinks of a patent, they generally think of the Utility Patent.

Why would I want a patent?

The ability of a patent to exclude competition gives rise to the *possibility* that a patent owner can make windfall profits.

Why would I decline applying for a patent?

Without patents, the way to keep competitors from taking advantage of an invention is to keep it secret. Patents can bait inventors into revealing trade secrets. However, patents expire while

trade secrets can last forever. Moreover, getting a patent is expensive and uncertain with a decent chance that the patent will not make any money.

How do I get a patent, and is it easy?

Obtaining a patent can be complicated. First, you must invent something new

and not obvious that fits into one of the different patent categories. This is surprisingly difficult and made more challenging by recent court decisions. Next, you must file a patent application with the Patent Office. Writing a patent application requires an understanding

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BEFORE YOU APPLY FOR A PATENT

✓ **Keep the invention a secret.** To avoid forfeiting the trade secret status of your invention:

- Do not tell the public about the invention via a presentation or a publication
- Do not tell someone such as a designer, manufacturer, customer or vendor about the invention without a non-disclosure agreement (NDA)
- Do not sell the invention
- Do not offer to sell the invention
- Do not use the invention in public

If you disclose your invention in any of these ways, the U.S. Government allows a one-year grace period from the date of disclosure to file an application. Most foreign governments will not allow a patent at all if you disclose your invention in any of these ways. Therefore, be careful about promoting your invention at a trade show or discussing it with a colleague.

✓ **Make a reasonable attempt to determine whether the invention is useful, novel (never been seen before) and not obvious.**

✓ **Make a reasonable attempt to determine the correct inventors and owners.** For example, if you merely identify a problem that was solved by your employee, the employee is the inventor – not you. But, as the employer you may be the owner.

✓ **Keep track of industry events, such as launch of a similar product by a competitor, that may impact your ability to get a patent.**

✓ **Keep records of your invention from conception to your latest efforts to develop and commercialize the invention.**

PATENT TALK FOR THE NEW INVENTOR *(continued)*

of patent law and an investment of time to properly transform technology into legal information. Failure to comply with all of the requirements of describing and claiming the invention can result in weak claims that provide inadequate protection, an invalid or unenforceable patent, or a denied application.

Are there different types of patent applications?

Yes. Design and Plant Patents each require specialized applications. There are three applications for Utility Patents: the regular utility application, the provisional application, and the PCT application that provides for foreign rights. Inventors will need to decide which patent application best fits their needs.

How much will a patent cost?

Cost depends on many factors that are specific to each invention, inventor and circumstance. If a small business or single inventor applies, many fees are reduced. The time and attorney fees necessary to draft the application can vary greatly. An exact estimate is difficult to give without further discussion and examination of each particular invention. Patents are expensive, and the application process can be lengthy. Therefore, inventors should be prepared and committed to the process.

Why should I hire a patent lawyer or agent?

The patent process is so complex that most inventors do not have the expertise to jump through all of the hoops needed to get a patent. A patent attorney can help you determine the proper application and obtain the most protection possible for your invention.

Can I patent the name of my company, a book that I wrote, or a computer program that I created?

The name of your company is protected by trademark law. Creative expressions such as books are protected by copyright law. Software is a special category that is generally covered by copyright law, but may also be the subject of patents.

Should you apply for a patent? Would trade secret, copyright, or trademark law better serve your needs? If you need help navigating through the complex maze that comprises Intellectual Property Law, call on the Intellectual Property attorneys at Murphy Desmond S.C.

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