

SUMMARY OF UNITED STATES PATENT LAW AND PROCESS

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PATENTS

- a. A patent is a government-granted right to exclude others from making, using, selling, offering for sale or importing products that use the patented invention.
- b. **Patent application.**
 - i. **Provisional** – From July 8, 1995, the USPTO has offered inventors the opportunity to file a less-formal patent application. The provisional patent application is limited in its term to one year, at which time a non-provisional application must be filed to keep the patent application process in effect.

The principal advantage of a provisional patent application is obtaining a filing date at reduced cost. Also, the informality of the provisional shortens the time required for preparation of a patent application.
 - ii. **Non-provisional patent application.** This is the common patent application. It requires more formality than the provisional application in that it requires at least one claim defining the invention and it also requires compliance with patent office regulations.
- c. **Loss of Rights:** The patent applicant has a period of one year from certain events to file an application or else the applicant loses the right to obtain a patent. The events that trigger the running of the period include a sale or an offer for sale of a product using the invention and a publication of the invention.
- d. **Inventions that can be patented:**
 - i. machines
 - ii. processes
 - iii. articles of manufacture
 - iv. compositions of matter
- e. **Inventions that cannot be patented:**
 - i. abstract ideas
 - ii. laws of nature
 - iii. software per se
- f. **Types of patents:**

- i. utility
- ii. design
- iii. plant

g. **Term of patents:** 20 from the date of application and 15 for design patents

h. **Patent Application Process:**

- i. The process begins with the filing of the patent application with the U.S. Patent & Trademark Office (USPTO) which is assigned to a patent examiner.
- ii. After a period of time (presently about two or three years), the application is examined by the USPTO examiner. The examination requires a search of prior patents, published patent applications, and other publications.
- iii. The examiner prepares a written communication called an Office Action and sends it to the applicant. The office action generally rejects the application, usually based on the search results.
- iv. The letter gives the applicant a period of time to respond. The period is called a shortened statutory period. The statutory period is six months but the USPTO is authorized to shorten the statutory period on a case by case basis and it usually does to a one or three month period. Extensions for response may be obtained at certain specified fees.
- v. The first office action is generally a non-final office action. The applicant may amend the patent application after a non-final rejection.
- vi. The amendment is also considered by the examiner.
- vii. On a second or later office the examiner may issue a final office action. The final office action is not really “final” but does have some consequence. The applicant may not as of right amend the application further at this point unless a fee is paid for filing a request for continuing examination or a continuation.
- viii. Alternatively, the applicant may file a notice of appeal or abandon the application.
- ix. When the examiner is convinced that the application defines a novel and non-obvious invention, a Notice of Allowance is issued.
- x. If the applicant is still interested in getting a patent he or she pays the issue fee stated in the Notice of Allowance and a patent will issue in a few months.
- xi. The issued patent will have a term of 20 years from its filing date and will require maintenance fees to keep it in force. The maintenance fees are to be paid on 3.5 years after issuance, 7.5 years after issuance and 11.5 years after issuance.

