

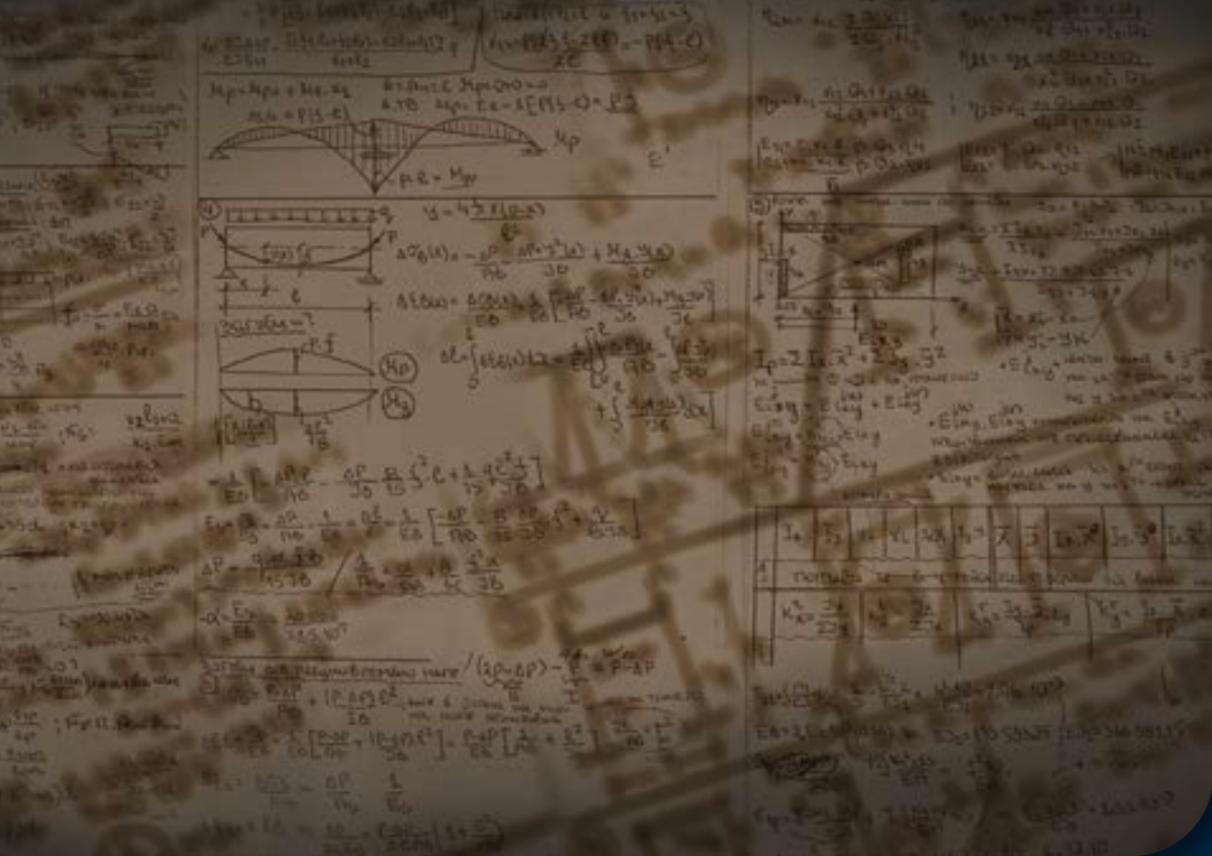


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IP ESSENTIALS

A Toolkit for Entrepreneurs,
Innovators, and Business Owners

PATENTS



PATENTS

A patent is an exclusive right granted for an invention. In other words, **a patent is an exclusive right to a product or a process** that generally provides a new way of doing something or offers a new technical solution to a problem. However, you can't patent laws of nature, physical phenomena, or abstract ideas.

Q *Does owning a patent give me the right to use/practice the invention?*

A A patent only gives you the right to exclude others from making, using, offering, and selling your invention protected by that patent within the United States, or importing the invention into the United States. Even owners of a patent may not have the right to actually “practice” their invention.

Q *Should I file a patent, or can I maintain my invention as a trade secret?*

A Maintaining your invention as a trade secret is a cost-effective alternative to patenting when the information is not easily reverse-engineered. However, you don't have any rights to exclude anyone from practicing your invention if you maintain it as a trade secret. Consider patenting an invention if it can provide a real business advantage, such as limiting or excluding competitors from the market, or generating revenue through licensing.

Q *What makes an invention patentable?*

A To be patentable, an invention must be novel, useful and non-obvious.

Novelty: The invention covered by the patent application must be substantially different from anything else that is known to the public. Public knowledge includes (1) anything that has been previously patented, (2) anything that has been written about in a publication, and/or (3) anything that has been sold in public.

Usefulness: The invention covered by the patent application must have some practical utility such as providing some identifiable benefit or provide a solution to a problem.

Non-obviousness: The invention protected by the patent must be sufficiently different from existing solutions such that a person having ordinary skills in the area related to subject of the patented invention would not find the invention as an obvious derivative of the existing art.

Q Are there different types of patents?

A Most patents are “utility” patents, protecting the functional aspects of inventions such as machines, manufactured articles, compositions of matter, and processes. You can also patent ornamental designs of something that has a practical utility. Finally, you can also patent certain new and distinct varieties of plants that can be asexually reproduced.

Q What are “patent claims”?

A The patent claims are particular to utility patents and they define the scope of the invention. The disclosure, including the written description and the figures do not define the patent right—the claims do!

Q I contributed to a portion of an invention, should I be included on the patent application as an inventor?

A You are an inventor if you contributed to the “conception” of the invention. That contribution requires more than routine engineering skill or supervision. An inventor needs to make a contribution to at least one claim of the patent.

Q What is a provisional patent application?

A A provisional patent application allows you to establish an early effective filing date (priority) for a later filed application. Provisional patent applications cannot “mature” into a patent. Provisional applications are not publicly available and are automatically abandoned one year after filing.

To preserve your rights to the provisional application filing date, you must file a non-provisional application within one year and claim priority to the provisional application. It is important to make sure that the disclosure of a provisional application can support the claims of any later-filed non-provisional applications.

Q I’ve been selling my product for more than a year, is it too late to file for a patent?

A In the United States, a patent application must be filed within the one-year grace period after your invention was first disclosed to the public, publicly used, sold, or offered for sale in the United States. The rest of the world does not offer a grace period.

Q *What does it mean if an invention has “absolute novelty”?*

A Most countries require “absolute novelty” of an invention before filing a patent application. Patent rights in these jurisdictions may be jeopardized if there is any disclosure or sale of the invention prior to filing a patent application.

Q *How can I market-test my product without triggering the “on-sale” bar?*

A Certain prior public uses may not trigger the one-year “on-sale” bar if it qualifies as an allowable experimental use. If, for example, a public use is performed solely for the purpose of perfecting the invention and remains confidential and under the control of the inventor.

Q *How long does a patent last?*

A As a general rule, utility patents filed now, have a life of twenty years from the date of filing of the earliest non-provisional application to which it claims priority. You may also get some additional time as patent term extension if the grant of the patent is delayed by the patent office’s examination process. Design patents filed now, generally have a term of fifteen years from issuance.

Q *Does my U.S. patent protect me in foreign countries?*

A Your U.S. patent does not protect you in any foreign countries. In order to be protected in foreign countries you will have to file a separate patent application in each of the countries that you want patent protection in.

Q *If two people invent the same thing, who is awarded the patent and is keeping a record of my invention important?*

A In the United States, patents are awarded to the first inventor to file a patent application. Nevertheless, it is important to maintain accurate records of invention disclosures, such as lab notebooks or an equivalent record keeping, which may be important evidence for future patent disputes.

Q *How can I tell if my invention is patentable or is already patented?*

A You can perform a preliminary patent search online. The best way to determine if your invention is patent eligible or is already patented would be to consult a patent attorney.

This IP Essentials Topic is one of a series:

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