

U.S. Patent Application Basics



DOWELL & DOWELL, P.C.

As a potential applicant for a U.S. patent, we would like to point out a few important details of U.S. patent protection, including your duties as an applicant.

The Rights Associated with a U.S. Patent

A U.S. patent gives an applicant the right to exclude others from making, using, selling, or offering for sale the patented invention in the United States. A U.S. patent does not give an applicant the right to use or practice the invention.

Patent Term

The right to exclude others from using the patented invention referenced in the preceding section lasts for a limited period of time known as a patent term. The patent term for a utility patent is typically 20 years from the filing date of the application, and the patent term for a design patent will soon be 15 years from the issue date of the patent. A patent term is generally not extendable, but the patent term of a utility patent could be subject to patent term adjustment, which adds time to the patent term to offset Official delays during the prosecution of the application. Further, a patent term may be truncated by a terminal disclaimer made during the prosecution of an application for patent.

3 Types of Patents and Patent Applications

There are three types of patents, namely utility patents, design patents, and plant patents. Consequently, there are three corresponding types of patent applications: utility patent applications, design patent applications, and plant patent applications. Utility patents and utility patent applications involve structural and functional inventions and represent the majority of U.S. patent applications. For example, the patents for the light bulb, windshield wipers, Velcro®, Claritin®, were all utility patent applications. Design patents and design patent applications are limited to the design of an invention. Design patents protect the overall appearance of an invention, not the structural and functional characteristics. Lastly, plant patents and plant patent applications involve new species of plants.

2 Types of Utility Patent Applications: Non-Provisional and Provisional

There are also two types of utility patent applications: provisional applications and non-provisional. A non-provisional application is examined and has the potential to issue as a U.S. patent. A provisional application allows an applicant to obtain an early filing date with fewer formalities and a lower cost than a non-provisional application. A provisional application is not examined and cannot issue as a U.S. patent. Further, a provisional application expires after 12 months from the filing date, so any non-provisional application based on the provisional application must be filed within 12 months of the filing date of the provisional application. Thus, in a sense, a provisional application serves as a placeholder that allows an inventor to further develop the inventions for an extra year.

Inventor(s) and Applicant(s) for Patent

Generally, each inventor of an invention set forth in a patent application is the owner of the patent application, unless that inventor assigned the application or is under an obligation to assign the application, for example pursuant to an employment agreement. Each inventor has an independent 100% ownership interest in the patent application such that each inventor can assign, license, and bring an infringement action without notice or consent of any joint inventor.

Since each inventor is an owner of the application, a patent application must name each and every inventor. An inventor is anyone who contributed to the conception of the invention. In other words, an inventor must have contributed to the conception of the invention, not just its reduction to practice. Naming someone as an inventor who is not an actual inventor or failing to include someone who is an inventor may result in a patent being unenforceable or invalid.

While a patent application must list each and every inventor, an applicant for a patent does not necessarily have to be an inventor. Any inventor, assignee, obligated assignee, or person with sufficient proprietary interest in the invention can apply for a U.S. patent.

Reduction in Official Fees for Small and Micro Entities

The U.S. Patent and Trademark Office provides financial assistance to applicants who are small entities or micro entities. Specifically, there is a 50% reduction in most government fees for small entities and a 75% reduction in most government fees for micro entities.

A small entity is generally defined as an individual, non-profit organization, or small business concern having 500 or less full or part-time employees that has not assigned, granted, licensed, or otherwise conveyed and is under no obligation to assign, grant, license, or otherwise convey any rights in the invention to an organization that is not a small business concern or non-profit organization. A micro entity is generally a small entity that either: (1) must transfer ownership of the application to an institute of higher education or (2) has not filed more than four U.S. non-provisional patent applications and meets certain income requirements.

Duty to Disclose Pertinent Information

An applicant, as well as anyone who participates in the preparation, filing, and prosecution of an application for patent, has a duty to inform the U.S. Patent and Trademark Office of any relevant information of which they have knowledge. This information includes prior art, such as patents, brochures, catalogs, trade journals, and other publications, prior sales or offers for sale, copending related U.S. and foreign patent applications, and public disclosures.

This duty to disclose prior art is a continuing obligation. Accordingly, relevant materials should be submitted: (1) within three months of the filing date of an application; (2) within three months of citation in a corresponding application filed elsewhere; or (3) within three months of learning of the existence of such materials.

Grace Period for Filing a U.S. Patent Application

An application for a U.S. patent may be filed within one year after the invention has been disclosed to the public in any way, such as by publication, sale, offer for sale, or the like. However, with regard to foreign patent protection, a public disclosure of the invention in the U.S. or elsewhere prior to filing a patent application may constitute a bar to obtaining a foreign patent.

Foreign Filing License

For an invention originating in the United States, an applicant must first obtain a foreign filing license for the invention before filing a foreign patent application for the invention. If an applicant first files a U.S. patent application for the invention, a foreign filing license is usually provided on the Official Filing Receipt for the U.S. application. If an applicant wants to file a foreign patent application as the first invention, the applicant must first obtain a foreign filing license.

Need to Keep Contact Information Up to Date

There are many important due dates associated with prosecuting a U.S. patent application and maintaining a U.S. patent once it issues. Failure to take action by a due date can result in a patent application or patent going abandoned. Dowell and Dowell, P.C. and the U.S. Patent and Trademark Office are not responsible for such abandonment if the contact information you provided is not accurate. Accordingly, please provide your updated contact information to assure you receive any and all pertinent information.

Disclaimer

The materials and information set forth herein are intended to provide general information, not legal advice. You should not act upon this information without consulting with legal counsel. Further, the transmission and receipt of this information does not create an attorney-client relationship with Dowell & Dowell, P.C.