

## Patent Primer for Inventors

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You think you have an invention... now what? A basic understanding of legal and business considerations can help inventors make critical decisions about protecting their invention. It can also facilitate a more productive discussion with a patent lawyer, who can be critical to understanding, identifying, and pursuing protection to your invention. As an inventor, you may have a number of questions about patents, including what they are, how to obtain one, how long it may take, and their potential benefits. This article addresses questions commonly asked by inventors.

### **“What is a patent?”**

A patent provides an inventor/owner exclusive rights to an invention for a limited period of time. Many people have the misconception that a patent gives the inventor rights to make, use, and sell the invention. Actually, it does not. A patent provides the right to exclude others from making, using, and selling the invention. This distinction is important.

A patent includes a written description of the invention. One or more drawings are typically provided to assist one’s understanding. Importantly, a patent includes one or more “claims” that define the scope of protection for the invention. In this regard, the claims define the boundaries of the property protected by the patent.

### **“Is my invention patentable?”**

You can patent any new and useful process, machine, manufacture or composition of matter, or any new and useful improvements. However, determining the patentability of an invention depends on the “state of the prior art,” which generally is everything that was publicly known or done beforehand. Therefore, any assessment of the patentability of an invention depends on what is known from the prior art. Although not required, some

preliminary searching of the prior art can be helpful.

In assessing patentability, one must inquire as to whether the invention is “new.” As long as the invention is different from each individual piece of prior art, it is new and potentially patentable. Another inquiry is whether the invention is “non-obvious.” This involves an assessment of whether the invention would have been “obvious” in view of the combined teachings of the entire prior art. At the United States Patent and Trademark Office (USPTO), most battles over patentability eventually involve the issue of obviousness.

### **“When should I file an application?”**

Ideally, a patent application should be filed before making any disclosures about your invention. In fact, most countries require that an application be filed before there has been any public disclosure or sale by the inventor. Therefore, an inventor would be wise to avoid disclosure and be careful when undertaking pre-filing activities, such as testing prototypes, meeting with potential customers, or building an inventory of products for sale.

If a sale or disclosure has occurred, some hope may still exist for obtaining a U.S. patent. Unlike most countries, the U.S. provides a one-year grace period within which an inventor can file for a U.S. patent following disclosure, public use, offer to sell or sale of the invention. This allows an inventor to test the waters and assess whether the invention may be viable or have commercial value before committing the time and money involved with filing for a U.S. patent.

### **“What happens after I file the application with the USPTO?”**

A patent application is assigned to a patent examiner working in the field of the

invention. The application will typically be taken up for examination after earlier-filed applications. In this regard, applications are generally examined in the order in which they are filed.

When an application is taken up for examination, the examiner performs an independent search of the prior art to uncover references relevant to the invention. In view of those findings, the examiner will assess the patentability of the claimed invention.

It is rare that an examiner will find an invention patentable after the initial review. The application will typically be rejected on the basis that the claimed invention is not directed to patentable subject matter, is not new and/or is considered obvious. An inventor or owner has the opportunity to respond to the examiner’s position by amending the claims to further distinguish over the prior art and/



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or by presenting arguments explaining why the claims are patentable over the prior art. One or more exchanges with the USPTO may be necessary before the claimed invention is considered patentable.

When it comes to the nut and bolts of preparing, filing, and pursuing a patent application, it is a minefield that is full of potential pitfalls. It may be tempting for an inventor to try it himself, but anyone who does not fully understand the law and rules of practice before the USPTO can run a significant risk of leaving some amount of protection to an invention on the table.

#### **“Should I patent my invention?”**

Strategic business decisions and understanding your industry can be critical to knowing when and what to do on the patent front. Certainly, an inventor does not need a patent to commercialize a product. However, bear in mind that someone else’s patent can pose an obstacle. The real question to ask yourself is whether obtaining a patent to your invention would provide you with a competitive advantage by excluding others from making, using or selling it.

Any number of factors may be important to you in assessing whether or not to pursue patent protection to an invention.

For example, the competitive landscape surrounding the invention, your R&D investment to develop the invention, the cost and/or timing to obtain a patent, the potential breadth of protection, and the ease of designing around the invention are but a few factors that may be important to consider in assessing patent protection.

In sum, there is no one right answer for each inventor. Knowing the industry and how decisions affect your business is as important as achieving the goals you have for your invention. An experienced patent lawyer can guide you through the process and help you avoid pitfalls.