Patent Law

The Q and A of Intellectual Property

Presented by:

AMERICA'S SBDC MONTANA

1 What Does Patent Law Protect?

With the exception of trade secrets, patent law is the only form of intellectual property protection that protects the underlying idea. Patent and trade secret law are sometimes considered two sides of the same coin. If your invention is easily reverse engineered, then you may want to consider patent protection. On the other hand, if it would not be easy for a competitor to figure out how your invention works, then you may also have the option of treating it as a trade secret.

2 What Kinds of Patents Are There?

There are three kinds of patents—utility patents, design patents, and plant patents. Plant patents protect new varieties of asexually reproducing plants. Design patents protect things that are ornamental or aesthetic (in this respect, the protection they afford is similar to copyright). Utility patents are what most people have in mind when they think of a patent. Utility patents protect the invention—which may be described as a system, an apparatus, a method or a composition—as encompassed by a set of written claims. These claims are based on the written description (specification) and drawings submitted as part of the application.

3 When and by Whom Must a Patent Application Be Filed?

The United States is now a first-inventor-to-file patent system. Although the persons filing the application must be the actual inventors, they also must be the first to file a patent application for the invention in the U.S. The date of invention is no longer relevant to determine who has the right to file, although these records may serve to prove that someone is an inventor. It is not legal to take someone else's idea and attempt to patent it (this is called "derivation"), nor is it legal to omit an inventor from a patent filing. Inventorship and ownership are not the same thing; for example, a patent application may list several inventors but only one applicant or owner. A patent application in the U.S. must be filed within one year of the date of first public disclosure. Most foreign countries, however, are absolutely novelty jurisdictions, which means that there is no one-year grace period. In these countries, the patent application must be filed prior to any public disclosure of the invention.

4 How Long Does a Patent Last?

A patent lasts for twenty (20) years after the date of filing, plus any additional days added to the patent term as a result of patent term adjustments. Patent term adjustments are calculated on the basis of delays on the part of the patent office during the patent examination process.

5 What Do I Do With My Patent Once I Have It?

You do not need a patent in order to sell a product; however, a patent allows you to prevent others from making and selling the patented product (or engaging in the patented process). Once you have a patent, you can make and sell the invention, license your patent rights to others, or sell the patent outright. The latter option is referred to as a patent "assignment." A license is when you give someone else the right to make and sell the invention, but you retain the ownership rights. A license typically includes royalty payments, which may be one-time or ongoing. Licenses may be restricted in terms of territory, market and/or time.

© 2022 Antoinette M. Tease, P.L.L.C. Used with permission.

MTSBDC@mt.gov Www.SBDC.MT.gov 406-841-2747

6 What Is Patent Infringement?

The scope of a utility patent is determined by the claims. The claims define in words what the invention is and what the inventors own. The scope of a utility patent is not defined by the abstract, the drawings, or even the written description. These parts of the application are consulted only if there is an ambiguity in the claims. In order to determine whether someone has infringed a utility patent, it must be proven that the accused infringer met all of the requirements (referred to as “elements” and “limitations”) of at least one claim in the patent. A patent typically has multiple claims. When the validity of a patent is challenged, the validity of the patent is assessed on a claim-by-claim basis.

7 Is It Possible To Protect my Invention Internationally?

Yes. The Patent Cooperation Treaty (PCT) is an international treaty applicable to utility patents. It provides a mechanism by which inventors may be “patent pending” in all PCT member countries before they have to enter the national stage. Alternately, an inventor may file a patent application directly in a foreign country without using the PCT system. Advantages of the PCT system are that (i) it affords inventors a period of time in which to evaluate their foreign markets to determine whether to invest in national stage filings and (ii) inventors will receive an International Search Report and Written Opinion, which is advisory and non-binding, but which provides an indication as to whether the invention is likely to be deemed patentable in the designated countries. Although various factors are taken into consideration in determining an appropriate filing strategy, one common strategy is to file a U.S. nonprovisional application first, file a PCT application one year later, and then enter the national stage in foreign countries eighteen months after the PCT filing date. Design patents are governed by the Hague System, which is an international registration system for designs. For further information on the Hague System, please visit: http://www.teaselaw.com/newsletter/2016_july.html.

© 2022 Antoinette M. Tease, P.L.L.C. Used with permission.

MTSBDC@mt.gov Www.SBDC.MT.gov 406-841-2747