



# **U.S. PATENTS:** **Protecting Innovation**

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The following information is intended to provide general information on U.S. patents, obtaining a U.S. patent, and the rights accompanying a U.S. patent.

## **WHAT IS A U.S. PATENT?**

A U.S. patent is a grant of a property right by the United States Government to an inventor for a limited term. The right conferred by the patent grant is the right to exclude others from making, using, offering for sale, or selling the invention in the United States or importing the invention into the United States. This patent grant is only effective in the United States, U.S. territories, and U.S. possessions.

In exchange for this property right grant, the inventor is required to provide the public a complete description of the invention to help advance the progress of science in that technology.

There are three types of patents in the U.S.:

**Utility** patents for inventions or discoveries of any new and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereof;

**Design** patents for inventions of new, original, and ornamental designs for articles of manufacture; and

**Plant** patents for inventions or discoveries of any distinct and new, asexually reproduced variety of plants.

In addition to these types of patents, a **provisional patent application** can also be filed in the U.S. Although a provisional patent application cannot result directly in a patent, it can nonetheless provide benefits to an inventor.

### **UTILITY PATENT**

Utility patents are the primary type of patent obtained. In general, the term of a utility patent is 20 years from the date on which the application is filed in the United States or, in special cases, from the date an earlier related application was filed, subject to the payment of periodic maintenance fees required to keep the patent in force over the entire 20 year term. In certain circumstances, patent term extensions or adjustments may be available.

### **DESIGN PATENT**

In general, a design patent protects the way an article of manufacture looks, including its shape or configuration, surface ornamentation applied to the article, or both. In some cases, both a design and a utility patent can be obtained on an article. The term of a design patent is 14 years measured from the date of grant. No maintenance fees are required to keep a design patent in force over the entire 14 year term.

### **PLANT PATENT**

Plant patents protect asexually propagated plants that are reproduced by means other than from seeds. The term of a plant patent is similar to that of a utility patent. No maintenance fees are required for plant patents.

### **PROVISIONAL PATENT APPLICATION**

A provisional patent application is a type of patent application that is not examined, is not made public, and does not lead directly to a granted patent. Nonetheless, when filed, the invention is “patent pending”. One year after filing, the provisional application expires unless a utility patent application that claims the benefit of the provisional patent application is filed.

## **OBTAINING A U.S. PATENT**

The U.S. operates under a “first-to-invent” system meaning that between two conflicting inventions, the first to invent has priority. Therefore, it is a good idea to keep detailed, dated records of inventive activity in the event it becomes necessary to prove a date of invention.

An inventor has one year from the date of describing an invention in a printed publication, using an invention publicly, or selling or offering to sell an invention, in which to file a U.S. patent application. After this one year period, the inventor is barred from filing a patent application on that invention.

If patent protection is desired in a country other than the U.S., it is necessary to file a separate patent application in each country in which protection is desired. Most countries of the world operate under a “first-to-file” system meaning that the first to file a patent application is considered the first inventor. However, in many instances, an earlier filed U.S. application can act as a basis of priority for a later filed non-U.S. application. In addition, most non-U.S. countries require that a patent application be filed prior to any written publication or commercialization of an invention.

Accordingly, it is generally a good idea to file a patent application prior to any disclosure or commercialization of an invention.

In the U.S., the inventor is considered the applicant and owns the rights in a patent application, absent an agreement or the effect of law to the contrary. Although not required, to reflect a change in ownership from the inventor to another party, an assignment document can be executed by the inventor assigning some or all of the rights in a patent application to the other party.

The process of obtaining a patent typically begins with filing a patent application. It can be useful, but is not required, to conduct a prior art search before filing the patent application. The patent application contains a detailed written description of the invention along with any drawings of the invention that may be necessary to properly understand the invention. The application also contains one or more claims which serve to define what the invention is, as well as define the scope of legal protection afforded by the patent.

Most applications will publish 18 months after the effective filing date of the application. The application will also undergo examination to determine whether or not a patent should be granted.

## **PATENT USE**

The right granted by a patent is a right to exclude others. That means that you can choose to assert your patent against others (i.e. used offensively), or not assert your patent against others (i.e. used defensively). A product covered by a patent should be marked as patented using a patent marking that includes the patent number.

A patent can help provide exclusivity in the marketplace by deterring others from marketing something similar or identical. A patent can also help in marketing a product by promoting the product as “patented” or “patent pending” in the case of a pending patent application.

A patent is also a property right that is similar to any tangible asset in that it can be bought, sold, and licensed like any piece of property. Since it is a tangible piece of property, a patent is an asset that can increase the value of a company.

## **FREQUENTLY ASKED QUESTIONS**

**Q1.** Is obtaining a patent the only way to protect my invention?

**A1.** No, but it can be an effective tool to protect an invention. Other forms of protection may include maintaining an invention as a trade secret, obtaining a trademark and in some instances even obtaining a copyright.

**Q2.** What does the term “patent pending” mean?

**A2.** The term “patent pending” is used as a means to inform the world that a patent application on an invention has been filed.

**Q3.** How long does it take to obtain a U.S. patent?

**A3.** The time to obtain a U.S. patent varies depending upon a number of factors including the technology involved, U.S. Patent Office processing time, and examination delays.

**Q4.** How much does it cost to obtain a U.S. patent?

**A4.** Costs vary depending upon a large number of factors including the type of patent, the technology involved, and the amount of prosecution with the U.S. Patent Office.

**Q5.** Does my U.S. patent provide protection in other countries?

**A5.** No!! A U.S. patent provides protection only in the U.S. If patent protection is desired in non-U.S. countries, separate applications must be filed in those countries.

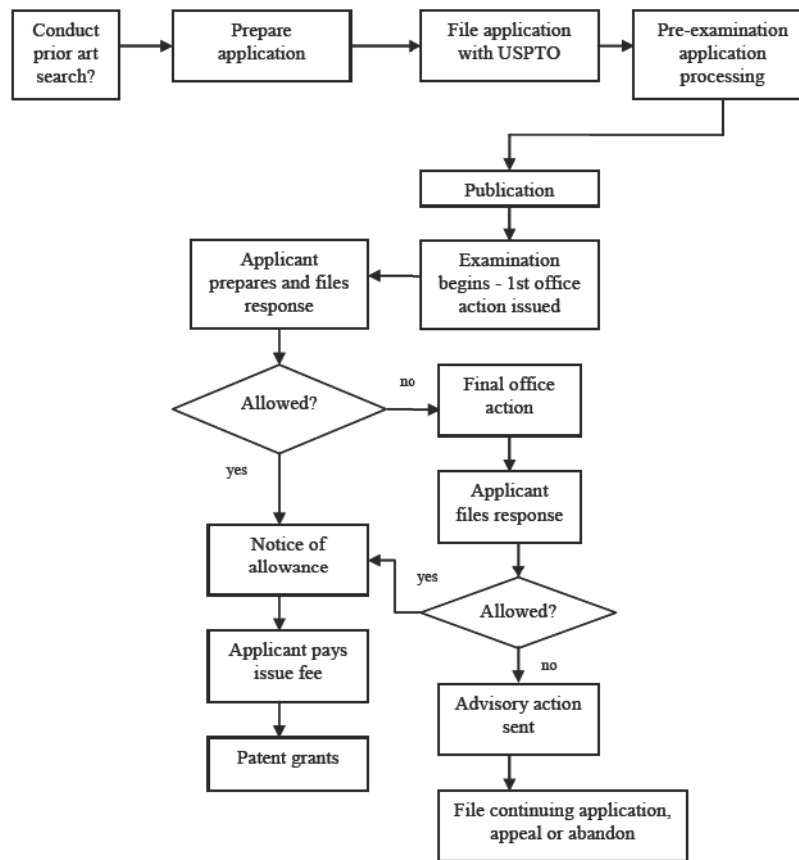
**Q6.** Is it possible to obtain more than one patent on my invention?

**A6.** Yes. A single invention may have more than one patentable feature. Further, continuation application practice permits an applicant to pursue more than one patent.

**Q7.** What is patentable?

**A7.** The U.S. patent system is very liberal as to what can be patented. However, laws of nature, natural phenomenon, and abstract ideas are not patentable.

## U.S. PATENT APPLICATION PROCESS



- United States Patent & Trademark Office (USPTO) examines the patent application.
- To be granted a patent, the claimed invention must satisfy three general criteria: it must be 1) useful; 2) novel; and 3) nonobvious.
- Prior art search is optional before filing the patent application.