

## Frequently Asked **PATENT** Questions

### Q: What does a patent protect?

A: An issued patent provides an inventor “the right to exclude others from making, using, offering for sale, or selling” the patented invention in the United States or “importing” the invention into the United States. The patent owner is not necessarily granted the right to make, use, offer for sale, sell or import the invention, as other rights may be required to undertake those activities.

### Q: How many types of patents are there?

- A: In the United States, there are three types of patents:
- Utility patents are for inventions or discoveries of any new and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement.
  - Design patents are for a new, original, and ornamental design of an article of manufacture.
  - Plant patents are for inventions or discoveries of a distinct and new variety of plant that is capable of asexual reproduction, such as by grafting.

### Q: What is a provisional patent application?

A: A provisional patent application is an application that only exists for 12 months, at which time it expires. It is not examined by the USPTO, and will not directly develop into an issued patent. A regular utility application filed on or before the anniversary date of the provisional filing will be examined by the USPTO, and will otherwise be treated as if it had the filing date of the earlier provisional application.

### Q: Why file a provisional patent application?

A: A provisional application can be a less expensive way to secure a filing date for your invention, while providing you a year to explore its commercial potential before filing a utility application. The attorney costs in filing the subsequent utility application may be lower (unless important new information requiring the reworking of the application has been developed in the intervening year).

### Q: What are the basic requirements for patenting an invention?

A: Under the patent laws of the United States, the basic requirements for obtaining a patent are that the invention be novel, useful, and non-obvious (when considered in light of the prior art). Other provisions in the law address certain “bars” to patenting, i.e., events or activities that could prevent an otherwise

worthy inventor from patenting his invention. Many of these bars involve public or commercial activities that occur before the filing of an application (or in some cases more than one year prior to the filing of an application). See the reference below to the one year on-sale bar.

### Q: What is the one year “on-sale bar”?

A: The term “on-sale bar” refers to one of the provisions of the U.S. patent law that can be used to invalidate a patent based on prior use or knowledge of the invention. The on-sale bar generally comes into play from commercial actions of the invention owner that occur prior to the filing of the patent application. For purposes of the United States, the rule bans the grant of a patent for an invention if there was any definite sale, or offer to sell, the completed invention that occurs more than one year prior to the date the patent application was filed. Most foreign countries have a similar bar, only without the one-year grace period.

### Q: When should I contact a patent professional?

A: Because of the risk of losing rights to your patent by prior disclosure, you should always consult with a patent attorney BEFORE you attempt to market your invention, i.e., before sending out letters contacting manufacturers, conducting test marketing or surveying potential customers. These activities should only be done under strict, formal and written terms of confidentiality with the third party, and even then, revealing only as much information about the invention as is strictly necessary.

### Q: How long does a patent last?

A: The term of a patent is the maximum period during which it can be maintained in force. The term of a utility or plant patent for applications filed on or after June 8, 1995, is 20 years from the earliest claimed filing date. A design patent has a term of 14 years from the date of issuance.

### Q: Can the ownership of a patent be assigned or transferred from one person to another?

A: Yes. A patent is assignable. Transfer and assignment documents may be recorded with the assignment branch of the U.S. Patent and Trademark Office.

### Q: What is “patent infringement”?

A: “Patent infringement” is the term used to describe the unauthorized making, using, offering for sale or selling of a patented invention. A United States

## Frequently Asked Patent Questions (Continued)

patent can only be enforced in the United States, though importation into the United States of any patented invention during the term of the patent can also be an infringement. To determine if a patent is infringed, the patent's "claims" are carefully examined and compared to the allegedly infringing practice. Patent claims are found in a separate section at the end of a patent, and provide the legal definition of the patent's scope of protection. Each element, or limitation, of each claim must be compared with the limitations of the accused infringer's device or method. You will need to consult an attorney to obtain a legal opinion of whether your patent is infringed by another's device or method.

### **Q: How do you enforce a patent?**

A: When patent infringement occurs, the patent owner may sue for relief in an appropriate federal court. The court may issue an injunction to prevent the continuation of the patent infringement, and the patentee typically requests an award of damages from the infringer.

### **Q: What happens in a patent infringement case?**

A: First, a judge will determine the scope of the claims of the patent, then either a judge or a jury will decide if there is infringement of the patent claims, and also resolve any issues relating to the patent's validity or enforceability. If the limitations of a valid patent claim are found to match the elements of the device or method (called "reading on" the device or method), an infringement has occurred. If all of the determinations of validity, enforceability, scope and infringement are found in the patent owner's favor, judgment against the infringer will be ordered by the judge.

### **Q: What should I do if I think my patent is being infringed?**

A: You should immediately consult an attorney with experience in patent litigation. It is important that you find an attorney that will help you understand the legal issues. It is also important that your attorney understands, or can be easily brought to understand, your invention. Your attorney should provide you an opinion regarding your patent and the alleged infringement, particularly as to the issues that will be tried in court, and generally as to your case and the chances of your prevailing.

### **Q: What is a PCT or Patent Cooperation Treaty patent?**

A: The Patent Cooperation Treaty (PCT) is a treaty that provides an international platform for processing patent applications. PCT applications may be filed up to 12 months following the original filing date in a national patent office, and will be given that earlier filing date, the priority date, for purposes of examination in all following proceedings. The PCT application allows a single filing to be processed by the International Bureau, and then transmitted to a chosen number of signatory national patent offices. The process allows the delay of entry into those selected countries up to 30 or 31 months from the original filing date.

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