



MDG MICHAUD-DUFFY GROUP LLP

INTELLECTUAL PROPERTY LAW

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Introduction: Filing and Prosecuting a Patent Application

You have asked the Michaud-Duffy Group LLP to prepare a patent application on your behalf for filing in the U. S. Patent and Trademark Office (PTO). We want to take this opportunity to explain what you can expect during the filing and prosecution of your patent application. There are processes and barriers that an applicant must consider for the use of the invention. These steps are in the areas of:

- Utility Patent Protection
- Confidentiality
- Publication
- Pre-filing Patent Search
- Depth of Representation
- Patent Terms and Patent Rights
- Foreign Patent Protection

Hopefully, this information helps you understand the actions that are needed for a patent to be implemented. The Michaud-Duffy Group greatly appreciates your business and looks forward to working with you. If you have any questions whatsoever about these or any other issues involving your representation, please do not hesitate to contact us.



Rick Michaud

Utility Patent Protection

In order to secure utility patent protection, it is necessary to file an application that meets certain requirements.

§ The applicant for a patent must be the original inventor:

An inventor must conceive of the invention in sufficient detail, or contribute to the conception of the invention with another as a means of accomplishing the desired result. Producing a working prototype is helpful but not necessary.

§ The invention must not have been sold, offered for sale, publicly or commercially used in the U.S., or described in a publication anywhere more than one year prior to filing.

A patent will only be granted for the non-obvious differences between one's

invention and the prior art, which consists of all publications, publicly known information and professional or business activities of others. One's own professional or business activities or publications that occur more than one year before filing one's patent application are also part of the prior art.

§ The invention must be useful, novel and unobvious.

Nearly every invention meets the test of usefulness. The invention is novel if it is not already in the prior art. The requirement of non-obviousness is often a bit more difficult for applicants to understand. To be patentable, the differences between one's device and the prior art must not be obvious to a person skilled in the field of the invention.



Provisional Patent Applications

A provisional patent application affords the applicant with patent pending status for one year upon submission. This type of application may be somewhat less detailed than the standard patent application. In fact, the provisional patent application need only describe the invention in sufficient detail to enable someone, after reading the application, to make or use the invention without undue experimentation.

As a result, the expense associated with drafting a provisional application is considerably less than drafting a non-provisional patent application.

A provisional patent application must be replaced within one year by a standard application if patent protection is to be obtained.

Since the late 1990s, provisional patent applications have provided a streamlined and valuable patent application process that has solved a number of perplexing and expensive challenges facing new and established inventors.

Confidentiality: Fundamental in Protecting One's Invention

An invention is a valuable commodity. Therefore, one should not disclose the invention to anyone without binding that person by contract to keep the information confidential. Even then, it is preferable to postpone disclosures until after a patent application is filed. There are a number of reasons why one should protect an invention in this way.

§ A person who introduces an invention to the public before the inventor files a patent application may defeat the inventor's chances for obtaining a patent.

§ Foreign patent rights may be lost before the filing of a patent application by public use or display or public disclosures or even, in some cases, by private disclosures of an invention that occur before one's patent application is filed.

§ A U.S. patent application must be filed on time - which means being placed on file within the one-year grace period from the initial public disclosure, use or display of the invention, or within one year from the initial offer to sell, license, or otherwise commercialize the invention, even if the offer, license, etc. is made confidential. Any such activity will start the one-year grace period running.

Please advise a Michaud-Duffy attorney of the earliest of any such disclosures, offers, publications or displays of the invention as soon as possible.



Further Steps in the Application Process

The PTO examines all nonprovisional patent applications very closely, and during this process many applications are initially rejected. Applicants are then permitted to reply to these objections in various ways in an effort to gain approval of their applications.

Of course, we cannot guarantee that a patent will be granted on any particular application.

A nonprovisional utility patent application includes one or more claims which must clearly and unambiguously define that which the applicant believes to be the patentable invention. Each claim is a single sentence and the objective is to make the language of the claims as broad as possible, in order to provide the maximum attainable degree of protection. However, a valid patent can only be obtained if the claims differ sufficiently from the prior art. Even if a broad patent is granted, a claim can be challenged in court or in the PTO as being invalid if the claim language is broad enough to encroach upon the prior art.

A utility patent application, whether provisional or nonprovisional, must provide

a full disclosure of the invention, including the best method known to the inventor for making the invention. The disclosure must be sufficiently detailed to permit one of ordinary skill in the art to make the invention. In addition, for a non-provisional application, all pertinent prior art known to the applicant and/or his attorney must be disclosed to the PTO.

An application for a U.S. patent may be filed as either a provisional or nonprovisional application with the PTO. Both kinds of applications establish a filing date and "patent pending" status for the application.



Publication of Applications

Nonprovisional patent applications are normally published 18 months after their filing or the filing of the related provisional application. Publication generally occurs before the PTO decides whether or not to approve the application, so one's invention may be made public without patent protection being granted. It pays to consider, before a patent application is even filed, whether to seek a patent or maintain the invention as a trade secret.

A trade secret involves information such as a formula, pattern, compilation, program, device, method, technique or process that derives independent value—actual or potential—from not being generally known and not being widely ascertainable. Reasonable efforts must be made to maintain the secrecy of the information.



Pre-Filing Patentability Search and Opinion

To help assess the likelihood of obtaining a patent and to assist in the preparation of a patent, we recommend performing a prior art search before preparing the application. The "prior art" against which the invention will be evaluated for patentability includes all known prior work and information which is material to patentability of your invention. The prior art includes, for example, all literature published before one files a patent application or makes a prototype of the invention. However, the most prevalent items of prior art are previously granted patents and published patent applications. To keep the effort and cost of a search within reasonable bounds, the firm normally limits a search of the prior art to published patent documents. Please consult with a Michaud-Duffy attorney to discuss the fees for performing a patentability search and assessing the results. These fees are additional to the cost for preparing the patent application.

Additional Concepts: The Patent Right

The owner of a patent has the right to exclude others from making, using or selling the invention defined in the claims of the patent throughout the country that has granted the patent. The full term of any new utility patent in the U.S. and most other countries is 20 years from the earliest filing date, provided that maintenance fees are paid in the interim.

Avoiding the Patent Rights of Others

Regardless of whether an invention qualifies for a patent, it may infringe on a patent already owned by another. This risk can be assessed by performing a "clearance" search for enforceable patents that might pose an obstacle to the commercialization of the invention. A clearance search is different and more involved than a prior art search.

Other Aspects

If no search is provided, the cost of obtaining a patent begins with the expense for preparing and filing a patent application. About 18 to 24 months after a U.S. nonprovisional application is filed, a written "office action" is issued by the PTO. This presents an official review of the patent application. Claims are routinely rejected for one or more reasons, and it then becomes necessary to "prosecute" the application in writing to overcome the rejections. Prosecution may include amending the claims and preparing arguments to overcome the objections. An applicant should expect an additional cost for preparing and filing a response to an office action. When a patent application is "allowed," additional expenses are also associated with obtaining the patent. These include the payment of a publication fee, an issue fee and a fee for attending to the final tasks associated with issuing the application.



Foreign Patent Protection

A U.S. patent is effective only in the United States and its territories. To secure patent protection in other countries, one must file patent applications abroad - before making the invention public in any way. Each foreign application has attendant expenses in addition to those of the U.S. application. Each application undergoes an examination process, which may or may not result with the patent being granted. If foreign patent applications are filed within one year of the filing date of one's U.S. patent application, the foreign applications may enjoy the earlier filing date of the U.S. application. Most foreign countries also assess annual maintenance fees that escalate during the life of the patent. The Michaud-Duffy Group works with an experienced, worldwide network of patent specialists to assist with the foreign filings of clients.

