

Tools for Entrepreneurs: How to Get a U.S. Patent

By Devin S. Morgan

The Situation:

You have a new product in the works. You have analyzed the market and are confident that your product addresses a real need and there is a business model for making and selling it. You may have even filed a provisional patent application while you worked on your proof of concept. You have a budget for investing in patent protection. Now how do you actually go about getting a U.S. patent?

Preparing to File for a U.S. Patent

Examination System

U.S. patents are issued by the U.S. Patent & Trademark Office (www.uspto.gov). They are reviewed by a Patent Examiner through a bureaucratic examination process. The Examiner evaluates whether the invention is new, useful, and compliant with the formal requirements of the patent system. Examiners vary in their diligence, cooperativeness, and disposition toward granting or denying particular applications. **Preparation, experience, and patience are necessary to effectively navigate the patent examination system.**

Attorney, Agent, or Alone

Should you hire a patent attorney or patent agent to help, or should you just do it yourself? If a patent is worth pursuing, it is worth paying a professional to prepare. Your patent application is part of a business plan that justifies substantial investment (or you shouldn't do it at all). However, if it is not possible to afford professional help

due to the early stage of your business, there are resources to help you do it yourself, such as Nolo's Patent It Yourself. Agent versus attorney is really a question of individual compatibility and whether you think you might need other legal services agents can't offer. **The most important part is to select and manage your attorney or agent for maximum value, see my [How to Select and Work with an Attorney](#).**

To Search or Not

Searching patents and other sources for concepts similar to your invention should be part of building your market awareness and business plan. Adding an expert search to your own research increases your likelihood of finding the closest prior technology. The value of your patent will be based on the technical merit of your invention, its actual market impact, and how well you define and claim it relative to prior inventions. **Investing in a patent application without searching is foolish.**



Disclaimer: This article is provided for informational purposes only. It is not legal advice and should not replace consultation with an attorney.

Author Bio

I have an engineering degree from Dartmouth College and JD and Master of Intellectual Property degrees from Franklin Pierce Law Center. I practiced in large law firms in Washington, DC, where I focused on patent prosecution, IP analysis, and litigation for both technology startups and Fortune 500 companies. I later formed my own consulting business to help companies with IP analysis, strategy, and process. I left consulting to be in-house counsel for Maxtor Corporation and Seagate Technology. In 2008, I started my own firm to provide intellectual property, contract, and business legal services to startup and growth companies. More articles available at:

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Preparing a Patent Application

Make a Record of Invention

The patent laws require that you correctly identify who invented an invention and file your patent application in a timely manner. Much of your initial meeting with a patent attorney will be about the who, when, why, and how of coming up with your invention and what you have done since then to publicize, prototype, or sell your invention. Write down the dates when you first thought of the invention, wrote it down, shared it with someone else, made a prototype, and/or tried to use or sell it. Gather and save any records or other evidence of your inventive process.

Describe Your Invention

Describing your invention is as much art as science. The drawings and written description serve several purposes:

- a **technical document** meant to enable others to understand and use your invention
- a **legal document** that will be used by courts and others to interpret your claims and give

legal scope to your patent

- a **marketing document** to help sell the Examiner and others on the novelty and usefulness of your invention

These purposes need to be balanced. The patent application should be clear, concise, and focused on what is new. Detail should be reserved for the operative and novel aspects of the invention, including alternative approaches (or embodiments). The description must support the language and details of the claims.

Claim Your Invention

The claims are the most important part of your application. Developing and understanding your claim strategy (what to claim, what not to claim, and how to claim it) should be your top priority. Claims drive the need for a good search and the assistance of an experienced patent attorney. Each claim should be short and deal with a new, distinct, and valuable feature of the invention. The number of claims is highly dependent on your strategy.

Anatomy of a Patent Application

1. **Title:** Short and specific name for referring to the invention
2. **Drawings:** Several simple line drawings or diagrams with reference numbers are used to illustrate the invention and organize the written specification
3. **Specification:** Written description of the background of your invention and the details of how it works (described in reference to the drawings)
4. **Claims:** Legal definition of the scope of the patent – the claims are compared against other people’s products or services to determine whether the patent is infringed and can be used to stop their activities
5. **Abstract:** Brief description of the invention for the front page of the patent
6. **Filing Documents:** The patent application will be accompanied by a Declaration and other required forms

Filing and Examination Process

Step 1: Application Filed	Step 2: Publication	Step 3: Examination	Step 4: Issuance or Appeal
Application and filing documents submitted to the Patent Office	The application will be published after about 18 months	After 2-3 years an Examiner will search, review, and comment on the invention. A series of Office Actions and Responses will be used to negotiate the scope of the patent	The patent will generally issue after 3-5 years, unless an appeal is required

Will you get a patent? If your invention is a substantial improvement over what has been done before, a patent attorney will almost certainly be able to get you a patent. The bigger question is whether the resulting patent provides actual leverage for your business and whether you have a plan realize that value.

