



# Best Idea Ever

*A guide to securing a patent (part one).*

BY STEPHEN S. MOSHER © 2014

A patent is a grant by the U.S. Patent and Trademark Office for a limited time right to allow only the inventor or owner of the patent to practice an invention. The grant is provided to an inventor who discloses details of the invention to the USPTO in a written application that survives an examination when compared against any preexisting, relevant public information called prior art.

Subject matter that is eligible for a “utility patent” includes “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.”<sup>1</sup> A “design patent” can also be granted for “a new, original, and ornamental design for an article of manufacture.”<sup>2</sup> Also, a “distinct and new variety of plant” that is invented, discovered, or asexually reproduced may be eligible for a “plant patent.”<sup>3</sup>

Some subject matter cannot be patented, including laws of nature,

physical phenomena, or abstract ideas such as purely mental processes or algorithms, which are either naturally occurring concepts or something that in-and-of-itself provides “no useful, concrete, and tangible result.”<sup>4</sup>

When a patent application is pending with the USPTO, the applicant should include the words “patent pending” on the item. Once the patent is granted, the applicant should mark the item with the patent number or the words “patented” or

“U.S. patent” to notify the public that the article is patented.

## WHAT ARE THE BENEFITS OF A PATENT?

The basic rights embodied in a patent are limited to a term of usually 20 years from the date that the patent application was filed. Patents are a valuable asset for a company whose products are covered by its own patents or patents licensed from others. A patent or a portfolio of patents is evidence of a strong technological position in a market or

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industry. Patents also can provide a source of revenue through licensing the patented technology to others.

### WHEN IS AN IDEA PATENTABLE?

Inventions often occur as the result of confronting some problem for which no apparent solution is known to exist, or when the solution that exists cannot be used because of cost or certain disadvantages. Thus, solutions that are *new and original* and are *not obvious* may be patented. Such ideas are the result of insight into a problem. These ideas are a creative act to envision a new way to assemble several components, to arrange the steps of a process, or to eliminate or replace something that is unnecessary.

When this “aha moment” happens, it is time to write down a description of the problem and the solution and the date that the idea came into being. When shared with others, this record is called a disclosure of invention. However, the inventor should consult a patent attorney to evaluate what should be done with the idea before discussing it with others.

### WHAT'S INVOLVED IN GETTING A PATENT?

Patent attorneys are registered by the USPTO to represent patent applicants. They typically have an educational background in engineering or science and have demonstrated competence in the complex procedural aspects of obtaining a patent. These qualifications are required to properly prepare and file the patent application and to respond to its examination.

A patent attorney is also experienced in advising an inventor about the patent process and assessing whether the invention is ready for patenting. A patent search is recommended to learn whether the same invention has already been patented.

This is also useful for determining the potential scope of the invention.

A patent application includes a set of drawings, a detailed written description of the invention, and a set of claims that define the invention in legal language. The application, which is similar to a technical paper, is often written by the patent attorney.

When the application is filed with the USPTO, it is assigned a serial number and an examiner and placed in the queue of applications. Usually, the wait is one and a half to three years. All applications remain confidential until published by the patent office.

When examination begins, the examiner will perform a patentability search and prepare a written recommendation for “office action” about the patentability of the invention. If the examiner suggests that the patent application be rejected, the applicant or his or her attorney must respond to the office action in a timely manner, typically within six months. The response should contain carefully thought-out arguments to counter the evidence of prior art used by the examiner to justify the rejection. Sometimes it is necessary to amend the language of the claims. Once allowed, the patent will be granted when the applicant pays a required issue fee. The patent is then printed, bound, affixed with an official seal, and issued to the applicant.

Applicants should keep careful records of the development of the invention, as well as documents associated with disclosures and efforts to obtain a patent, including confidentiality and consulting agreements with persons hired to assist in the development, preparation, and filing of a patent application; assignments of rights in the invention; documents regarding offers for sale or licensing of the invention; and documents evidencing the sales of the invention or

products or processes that embody the invention.

The patent application process is procedurally heavy in nature, which is why inventors seeking this gold seal should consult with a licensed patent attorney. **TBJ**

### NOTES

1. 35 U.S.C. §101.
2. 35 U.S.C. §171.
3. 35 U.S.C. §161.
4. *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373-74 (Fed. Cir. 1998).



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