

## TOOLS

### **Learning tools such as Informational Handouts are available on topics including:**

- Intellectual Property Overview
- The Patenting Process (Nonprovisional Patent Applications)
- Provisional Patent Applications (see excerpt below)
- Patent Searching (see excerpt below)
- Inventor Notebooks (see excerpt below)
- Patentability v. Infringement

These handouts go beyond the basics and give real advice that you can use. Several handouts have pricing and timing information. For more basic information, please visit the following websites:

#### Patent Basics:

- [www.uspto.gov/web/offices/pac/doc/general/index.html](http://www.uspto.gov/web/offices/pac/doc/general/index.html)
- [topics.law.cornell.edu/wex/Patent](http://topics.law.cornell.edu/wex/Patent)
- [www.uspto.gov/](http://www.uspto.gov/) - The Patent and Trademark Office (PTO) home page.

#### Searching links:

- [patft.uspto.gov/](http://patft.uspto.gov/) - PTO limited database.
- [www.getthepatent.com/](http://www.getthepatent.com/) - Although some features are fee based, this website offers access to several foreign countries and allows downloading of documents in a convenient format.
- [www.pat2pdf.org/](http://www.pat2pdf.org/) - .pdf patents and published applications.
- [www.google.com/?tbn=pts](http://www.google.com/?tbn=pts) - Google's patent search engine.

### **Provisional Patent Applications**

This is an excerpt from an informational handout. Please contact [info@oregonpatent.com](mailto:info@oregonpatent.com) for the complete version or access to other informational handouts.

Q: What is a provisional patent application?

A: A provisional patent application ("provisional") is a place-holder application that is filed with the United States Patent and Trademark Office (USPTO). The filing of a provisional allows the applicant to mark his goods as "patent pending." A provisional, however, lasts only one year at which time it expires. To take advantage of the provisional's filing date (the "priority date"), the provisional must be converted to a nonprovisional patent application ("traditional application") within one year of the provisional's filing. Information absent from the provisional will not receive the benefit of the provisional's filing date.

Q: Why should I file a provisional patent application?

A: There are lots of advantages (see Advantages) to filing a provisional under certain circumstances. The best candidates overlap the one year period an applicant has to (1) file a traditional application from the first public use or offer to sell and (2) file a traditional application to claim priority to the provisional.

Under current patent laws, except under very limited circumstances, a provisional application may be a very risky option. It may be many years before we know exactly how risky or safe the filing of a provisional application is after the AIA.

## **ADVANTAGES:**

Provisionals can be an attractive option if filed before the first public use or offer to sell because:

**Cost:** Because a provisional has fewer formalities than a nonprovisional application, it costs less to prepare.

**Patent Pending:** The filing of a provisional allows the applicant to mark his goods as "patent pending."

**Recapture:** Pre-March 16, 2013, in the United States, an applicant had one year to file a patent application (either provisional or traditional) after the first public use or offer to sell. Because of this unique provision, elements omitted in the provisional could be "recaptured" in a traditional application as long as there was no disclosure of the element more than one year prior to the filing of the traditional application. In a sense, there were two one year periods that are running concurrently: (a) the one year period between the filing of a provisional and a traditional application and (b) the one year period between the first public use or offer to sell and the filing of the traditional application. For applications filed after March 16, 2013, it is highly advisable not to rely on this.

**Time:** Filing a provisional allows an applicant to take a year to attempt to assess the invention's commercial potential, market, and/or to develop his product without significant legal expenditures.

**Research:** During the one year delay, additional information may be found. For example, if a provisional is filed and before the traditional application is filed, during the interim period a search may be conducted in which additional references (e.g. patents, published applications, and other literature) may be found because they were published or otherwise became accessible during the interim period.

**Term Extension:** If a patent will be most valuable at the end of its term, filing a provisional can help extend the life of the patent because the patent's term is calculated on the filing of the traditional application. This is why many drug companies file provisional applications.

**Proof of Conception and Reduction to Practice:** A provisional is excellent legal proof that an invention has been conceived by its filing date and can constitute reduction to practice. Multiple provisionals may be filed as an idea is developed.

**Foreign Filing Rights:** If a provisional is filed prior to the first nonconfidential disclosure of the idea, rights are preserved to file a foreign patent application within one year of the filing of the provisional for the subject matter included in the provisional. If all disclosures after the provisional's filing date are confidential (e.g. an offer to sell is made to a party that has signed a confidentiality agreement), additional subject matter may be added, but it will not have the benefit of the provisional's filing date. Foreign filing and publication due dates would be calculated based on the filing date of the provisional application (the priority date). Used in conjunction with confidentiality agreements (or nondisclosure agreements), provisionals can be very powerful tools for protecting foreign rights. But see the potential disadvantages below.

## **DISADVANTAGES:**

Provisionals should be used with caution because:

**Cost:** The cost of preparation of a provisional is generally not recoupable.

**Delay:** Provisionals are not examined on their merits. The time between the filing of the provisional and the traditional applications will generally delay the issuance of the patent.

**Priority:** The priority date is only available for subject matter included in the provisional. In order to obtain the benefit of the filing date of a provisional, the claimed subject matter in the later-filed traditional application must have support in the provisional.

**Prior Disclosures:** As mentioned, any information not specifically set forth in the provisional will not receive the benefit of the provisional's filing date. If there is a first public use or offer to sell that is prior to the provisional's filing date and the omitted information proves significant (e.g. it is the distinguishing feature), the applicant will not be able to recapture the omitted information. This may result in a patent of narrower scope (the broader the scope of the patent claims, the more valuable the patent protection) or no patent at all.

**Expiration:** A provisional application has a pendency lasting 12 months from the date the provisional application is filed. The 12-month pendency period cannot be extended. Therefore, an applicant who files a provisional application must file a corresponding traditional application during the 12-month pendency period of the provisional application in order to benefit from the earlier filing of the provisional application.

**Foreign filing:** To claim priority to a provisional, the foreign filing must be done within one year of the filing of the provisional. If the subject matter is not adequately set forth in the provisional, foreign applications may not be able to claim priority to the provisional. In a worst-case scenario, if a "quick" or "rough" (without sufficient information about the invention) provisional application is filed and the invention is then non-confidentially disclosed, all foreign rights may be lost.

**Inventorship:** The inventor(s) named in the provisional must have made a contribution to the invention as described. If multiple inventors are named, each inventor named must have made a contribution individually or jointly to the subject matter included in the application. The traditional application must have one inventor in common with the inventor(s) named in the provisional to claim benefit of the provisional's filing date.

## **Patent Searching**

This is an excerpt from an informational handout. Please contact [info@oregonpatent.com](mailto:info@oregonpatent.com) for the complete version or access to other informational handouts.

The United States Patent and Trademark Office (USPTO) website, [www.uspto.gov](http://www.uspto.gov), provides a search engine ([www.uspto.gov/patft/index.html](http://www.uspto.gov/patft/index.html)) for finding issued patents (patents that have issued) and published applications since 2001 (published applications have not necessarily issued and at this time not all pending applications are published). The issued patents are on the left and the published applications are on the right. You may search using quick, advanced, and patent number search engines. Help on searching may be found at [www.uspto.gov/patft/help/helpbool.htm](http://www.uspto.gov/patft/help/helpbool.htm) or [www.uspto.gov/patft/help/helpadv.htm](http://www.uspto.gov/patft/help/helpadv.htm).

Full text searches may be done on patents that issued since 1976 and on applications published since 2001. Patents issued between 1790 and 1975 may only be accessed using the patent number and the current U.S. patent classification, but the full-page images of these patents are available.

### **Searching tips:**

**Databases:** Issued patents and published applications are held in separate databases and must be searched separately.

**Searching "up and down":** Once you have found a "relevant reference," search for additional references that have been cited by the relevant reference AND for additional references that refer to (are "referenced by") the relevant reference. When you access recent patents online, the "references cited" are listed and linked directly thereto. There is also a "referenced by" link.

**Classification:** Search by Current U.S. Classification Class/Subclass (you can access older issued patents). You can find the Class and Subclass by finding a similar relevant patent reference or by using the Manual of Classification ([www.uspto.gov/web/patents/classification/](http://www.uspto.gov/web/patents/classification/)).

**Further Searching:** For particularly relevant references, search for other patents/publications by the same inventor, assigned to the same assignee, or having the same title. You can also check the continuity data of issued patents at [portal.uspto.gov/external/portal/pair](http://portal.uspto.gov/external/portal/pair).

**Patentability v. Infringement:** Remember that there is a distinction between patentability (at least one patent or non-patent reference has all of the elements of the invention you hope to patent) and infringement (your product or process has all the elements of at least one independent claim of an enforceable issued patent). As a simplistic rule of thumb, a patent is not enforceable if it is more than 20 years old, if maintenance fees have not been paid (check the status at [portal.uspto.gov/external/portal/pair](http://portal.uspto.gov/external/portal/pair)), if there has been inequitable conduct in obtaining the patent, and/or if there is prior art that would invalidate the patent.

**Alternative Places to Search:** Fee based search engines (e.g. [www.getthepatent.com/](http://www.getthepatent.com/)) may also be used to obtain patents/publications and/or foreign references. Patents and publications may be obtained in .pdf format at [www.pat2pdf.org](http://www.pat2pdf.org). Some foreign references may be obtained from [www.uspto.gov/web/menu/other.html](http://www.uspto.gov/web/menu/other.html) and [www.epo.org/searching/free/espacenet.html](http://www.epo.org/searching/free/espacenet.html).

## **Inventor Notebook**

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Every inventor should keep good records of concepts, test results, and other information related to the invention process. The following list details what should be included in these records, how to maintain them, and why they are important.

**The Notebook:** Inventor notebooks should be bound and, preferably, pre-paginated. (A black and white composition notebook is one option.) The probative value is not nearly as great if a loose-leaf notebook is used in which pages are easily inserted or removed. It is also important to line through any blank portion of pages of the bound notebook.

*Reason:* Information in a bound notebook is useful proof of when an invention was conceived, who are the actual inventors, and whether the inventors were diligent in reducing the invention to practice.

**Inventor Information:** All persons involved in the work, and their specific role, should be identified in the notebook entries.

*Reason:* Unless participants are identified, it is often difficult to establish, long after the fact, those involved in particular activities. This type of information is also necessary to identify those who will be named in the patent application.

**Notebook Entries:** The value of a notebook entry is directly proportional to: (i) the specificity of the entry, (ii) the care taken to date and sign each entry, and (iii) whether each entry was read, signed, and dated by a witness. Every entry should be signed, dated, and labeled to indicate the particular project with which the entry is associated, and, if possible, signed and dated by a witness. It is often advantageous to include a header on each notebook entry that includes the Date, Project No., Subject or Title, Signature, and Witness(es).

*Reason:* A good notebook entry can be helpful in proving that an invention is not obvious and was developed independently, without copying a competitor's product or patent.

Entries may include one or more of the following sections: header and signatures; conception details; purpose of the invention, modification, or test; description of the invention, modification, or test; ramifications of the invention, modification, or test; possible novel features; advantages; description of test results; sketches; known prior art; lists of parts; names, addresses, and phone numbers of people participating in the invention process; and people or businesses contacted for building, testing, or possible sale (remember that offers for sale being a one year statutory bar for filing a patent application in the United States), the dates of such contacts, and whether each contact was confidential (preferably evidenced by a signed and dated confidential disclosure agreement).

All computations, sketches, diagrams, test results, etc., should be contemporaneously entered into the notebook. Notebook entries should describe all testing performed (not just some of the testing), the particular type of equipment used, and the results of the testing, both good and bad. Errors should not be erased or removed. Instead, errors should be crossed out, signed, dated, and a notation made as to why the entry was incorrect.

**Loose Evidence:** It is important that all loose papers, such as drawings, test results, photographs of models, etc., be signed and dated, cross-referenced to a particular notebook entry, and preferably, mounted (taped or stapled) in the body of the appropriate notebook entry. Similarly, physical embodiments used to carry out various tests, such as samples, models, prototypes and the like, should be carefully labeled with a date, cross-referenced to notebook entries, and retained.

**Late Entries:** If an entry is signed significantly after it has been entered, a brief, honest explanation should be written, signed, and dated. If the invention was invented, made, or built significantly before a notebook was kept, a brief, honest explanation should be written, signed, and dated.