

Patent Basics

What is a patent?

A “patent” is a property right for an invention. The United States Patent and Trademark Office (“USPTO”) reviews applications and grants patents. A patent is only enforceable in the United States. Typically, a new patent is granted for a 20-year term for Utility Patents or 15-year term for Design Patents, but this term can sometimes be extended or adjusted. A patent allows the patent owner the right to stop others from “making, using, offering for sale, or selling” the invention, or importing the same invention into the United States from abroad. The patent owner is responsible for enforcing their patent rights.

What can I patent?

There are several kinds of patents, but only two that most businesses need to know:

- (1) **Utility patents** – For any new and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement of those things (20-year term)
- 2) **Design patents** – For a new, original, and ornamental design for an article of manufacture (15-year term)

To be patentable, the invention must be “new,” which means that it was not already patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the filing date of the claimed “new” invention. If another inventor already filed a patent for the same invention, then the subsequently filed application will be denied. This is why it is very important to conduct a “prior arts” search to determine whether your invention is actually new.

For Example:

Coca-Cola has a unique recipe for its soda, and a unique shape for its bottle. A recipe for a soda is not patentable, because even though it is unique to Coca-Cola, the USPTO does not consider most recipes “non-obvious.” Instead of patent protection, Coca-Cola has famously employed Trade Secrets protections for its recipe.* The shape of the bottle however, *is* patentable under a Design Patent, and Coca-Cola did hold a patent on the “Contour” or “Hobble skirt” bottle for many years. Even though their patent has now expired, Coca-Cola retains certain Trademark protections that prevent competitors from using a bottle shape too similar to their own.†

Utility Patent vs Design Patent

Generally, a Utility Patent protects the way an invention is used and works, while a Design Patent protects the way an invention looks. If you invented a brand new musical instrument, you would obtain a Utility Patent, as it is a new and useful machine or item. However, if you simply designed a unique version of an existing instrument, you might be able to get a Design Patent for your version. For example, the musical artist Prince owned a Design Patent for an instrument of his own design. The

* In almost all cases where an idea can be patented, it is a better choice to do that instead of relying on Trade Secret protections. Please see the “Trade Secrets Basics” handout, and consult a lawyer about which method might be best for you.

† For more on Trademark protections, please see the “Trademark Basics” handout.

instrument was a “keytar” (a combination keyboard and guitar) in a shape similar to Prince’s famous logo. Prince did not invent the keytar instrument, so he did not have a Utility Patent for keytars. Rather, he invented an original ornamental design for keytars, and was granted a Design Patent so that other manufacturers could not use his specific design.

Even if your invention is different from existing similar inventions, an application may be rejected if the unique aspects of your invention are considered “obvious.” A version of Prince’s keytar in green instead of purple is not unique enough to warrant a new patent. A slightly more powerful hand drill is also likely not patentable, because adding more power to a drill is an obvious advancement. However, if you achieved the additional power with a unique battery design, the battery itself may be patentable. A patent attorney can help you by determining whether your invention is unique.

How do I get a patent?

Before going through the time and expense of applying for a patent, you **must** determine whether your invention can be patented. Consider carefully whether your invention is the subject matter appropriate for a patent, as opposed to a Trademark, Copyright, or Trade Secret.

Step One: Determine whether your invention is new.

If you are sure that your item is the sort of item that *can* be patented, the next step is making sure that your invention is actually new. The USPTO reviews applications strictly, and rejects any invention that is not new. The USPTO will compare your invention to existing patents, but also to items described in publications, or for sale already in America or in a foreign country.

Please contact Patent and Trademark Librarian Marian Armour-Gemmen at the WVU LaunchLab on the Evansdale campus for help conducting a “prior arts” search. You may contact her by phone at 304-293-9391 or by email at marian.armour-gemmen@mail.wvu.edu. For more about the WVU LaunchLab please visit <http://launch.wvu.edu/>

Step Two: Filing an application with the USPTO

After conducting a thorough search for your item, the next step is to file an application for a patent with the USPTO. This application is extremely complex, but has three basic components: (1) a written description and oath of declaration, (2) a drawing of your invention, and (3) payment of various fees. The fees for application change every year and are posted on the USPTO’s web site.

There are two kinds of patent applications: Provisional, and Non-Provisional. The long, expensive, complex application that leads to a patent for your invention is the Non-Provisional application.

However, in many cases, you may have only the idea and a rough version of what your invention will become. The Provisional application allows you to start the process with just that rough version, and take one year to perfect it before going through the time and expense of the full non-provisional application. The Provisional application serves as a placeholder for your invention, and it will not ever result in a patent for your invention on its own. It also establishes the date at which you first filed your application, possibly preventing others from claiming patent on the same invention. You will eventually need to file the full Non-Provisional application to get actual patent protection for your invention, but that application must be for the final, perfected form of your invention.

Do I need a lawyer?

Yes. The patent application process is time-consuming and complex. You don't want to have to apply more than once on account of a small mistake that a lawyer could have helped you identify early in the process. A lawyer can also help you:

- Perform a search for “prior art” or other public information that might cause your application to be rejected. The USPTO will be conducting the same search, and a good lawyer can help find things that the USPTO may identify as reasons to reject your application.
- Prepare an application and choose the best strategy for ensuring that your application is granted.
- In situations where your idea cannot be patented, your lawyer can help you figure out other steps to protect your invention or idea, and help you implement those steps.

Please contact the Entrepreneurship and Innovation Law Clinic at the WVU College of Law for any questions, or for help applying for a patent or preparing to apply for a patent.

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