

## **How to Obtain A Patent?**

The first thing an inventor should do when he or she has conceived an invention is to make a record of it, describing what it is, and how it works, with sketches, drawings, or photographs. These items should be dated and signed by the inventor and then the invention should be explained to some trustworthy person who is capable of understanding the invention. This person should sign and date each page of the written description or sketches or photographs indicating that they have been “witnessed and understood” by him. This person should be someone who can be located in the future, because it may be important to prove some years later exactly when and to whom the invention was first disclosed.

The next step is to determine whether the invention is patentable. Those who specialize in obtaining and enforcing patents for inventors are more likely to render a reliable opinion on this question than persons who are not experienced in such work. Patent lawyers are often able to indicate very quickly that what an inventor wishes to patent cannot be adequately protected. More frequently, they will think it best to have a search made in the Patent and Trademark Office, to see what inventions have already been patented the same field. The result of such a search does not guarantee that such a patent will be granted, but it will often save much time and money by revealing that some other inventor thought of the same thing first.

If the search fails to turn up any earlier patents or publications which would prevent the issuance of a patent on the invention, the next thing which should be done is to have a patent application prepared. A patent application is a legal document which must define the invention in precise legal terms and it is therefore extremely difficult for those unskilled in the area of patents to draft a good application. Of course, the ability of the resulting patent to adequately protect the invention depends to a great extent on the manner in which the application is directed and it is therefore good business judgement to retain the services of a specialist such as a patent attorney. The attorney should be told everything which the inventor knows about the invention: what problems it solves, what difficulties were encountered and had to be overcome in order to make it work, how prior devices work and what problems they had, and so on. The profession integrity of a member of the bar assures that whatever is disclosed to him will be maintained in confidence.

As soon as the patent application has been completed, the lawyer will ask that the inventor study it to make sure that it is complete and accurate. The application consists of four main parts:

- (1) The specification which describes not only what has been invented but also how the invention is related to what is already known.
- (2) The Drawings which are referenced to the Specification by numbers or reference characters.
- (3) The Claims which define in precise language the scope of the invention and of the exclusionary rights conferred by the patent.
- (4) The fourth part of the application is the Power of Attorney and the Oath or Declaration. When the application is complete and correct in every detail, the inventor signs the Oath or Declaration swearing that he believes the invention is his and that patentability is not barred by public use, sale, publication or foreign patenting.

The completed application with a check to cover the government filing fee is then sent to the Patent and Trademark Office where it is given a filing date and serial number. It is then referred to an examining group in the Patent and Trademark Office especially trained to understand inventions in the field to which the application pertains. It will be examined in its proper order and the examiner will write a letter, possibly questioning points about the specification, drawing, claims and also calling attention to prior patents and publications found in the Patent and Trademark Office files which relate to the same field of invention. The Patent and Trademark Office examination normally results in one or more requirements for a revision of the claims and to each such requirement a reply must be filed, usually making some changes and arguing that others are not necessary. Here, the skill of a specialist is especially needed, lest the patent be issued with claims not broad enough to protect the real invention.

The negotiations between the Patent and Trademark Office examiner and the inventor or his lawyer are referred to as the “prosecution” of the application. The prosecution may go on for several years but the term of a patent does not begin to run until the patent is issued. Until then, the application is kept secret, in the sense that only Government personnel and person authorized to do so by the inventor are permitted to examine the file. The fact that the application was filed affords some measure of assurance that a later inventor, working on the same invention, will not secure a patent on it while an earlier case is pending.

After the patent is issued, printed copies of it are available to anyone. The fact that the invention is thus made public, however, does not adversely affect the patentee, because anyone who sees the patent will know that the invention claimed in it is the exclusive property of the patentee.

The mere filing of an application for a patent does not immediately create any enforceable rights. Marking a device “Patent Pending” or “Patent Applied For” has no legal effect, since a patent cannot be infringed in this country until it has been issued, and no damages can be collected for use of an invention prior to the time at which the patent was actually issued. Nevertheless, a warning notice of this sort may discourage potential copyists since it tells them that they may have to stop production once the patent is issued. It should be noted, however, that it is unlawful to use such a notice unless an application for patent on the invention is actually pending in the U.S. Patent and Trademark Office.