



What You Should Know About Patents

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Introduction

Patents are vital to the protection of your intellectual property. We at Varnum believe that the more you understand patents and the patenting process, the better we will be able to serve you. We are pleased, therefore, to provide you with an outline of some basic information and fundamental considerations about patents and the patenting process. The "Life Of A Typical Patent Application" will guide you step by step through the patenting process. We hope you enjoy this introduction to patents and the patenting process. We look forward to answering any questions you may have and to discussing your intellectual property protection needs with you.

Basic Information and Fundamental Considerations about Patents

1. A patent gives you the right to prevent others from manufacturing, using, offering for sale or selling your invention for 20 years from date of filing, except that patents filed before June 8, 1995 enjoy a term of 17 years from date of grant or 20 years from date of filing, whichever is longer. (20 years from filing is now the patent term in most if not all foreign countries.) Ornamental design patents (see (2) and (2E) below) have a term of 14 years from date of issue in the United States.
 - a United States patent protects you in the United States;
 - to be protected in foreign countries, you must file patent applications which cover those foreign countries.
2. There are a number of important reasons for obtaining patents:
 - patents afford road blocks to competitors;
 - patents provide conclusive evidence of three of the four key factors necessary for a company to obtain Research and Development Tax Credits:
 - the development "uses technology;"
 - the development "creates or improves" a product or process;
 - the development involves "technical uncertainty;"
 - patents help defensively protect your right to practice the patented technology, even if you do not wish to use them to offensively exclude others from practicing the technology;
 - patents are an important asset in establishing the value of a company.
3. Any new product, process, machine, or composition of matter which would not have been obvious to one of ordinary skill in the art at the time the invention was made is patentable. Computer software for controlling processes and equipment may be patentable. Unique and unobvious ornamental designs for products are also patentable. Examples of patentable inventions include:
 - new uses for old products or machinery may be patentable
 - a new combination of old steps or items may be patentable

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- food recipes, drug formulations, chemicals, cosmetic formulations, processes and the like may be patentable
 - genetically engineered life forms and processes may be patentable.
 - ornamental designs for products, so-called “design patents.”
4. Inventors, you have the ultimate responsibility to make certain that your patent application:
- is written with sufficient clarity and thoroughness that it (1) enables one of ordinary skill in the art to practice your invention, and (2) demonstrates that you “had possession” of the invention.
 - discloses the best mode contemplated by the inventor(s) for practicing the invention.
 - accurately claims the subject matter which you regard as your invention.
5. The scope of protection afforded to your patent is determined by the patent claims.

A patent claim must particularly point out and distinctly claim the subject matter which the applicant regards as his invention. “Distinctly” means that the claim must have a clear and definite meaning when construed in light of the complete patent document. The “distinctly claiming” requirement guards against the creation of unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their respective rights.

A claim cannot be drafted or interpreted in such a way as to cover a function or desired result. While a claim can be expressed as a means for performing a specified function, such a claim must be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. (35 U.S.C. § 112, par. 6.)

In order to infringe a patent, one must infringe at least one claim of the patent. Patents typically have independent claims, each of which stands alone, and one or more dependent claims which refer back to prior claims and therefore incorporate all of the limitations from any prior claim referred to. Thus, independent claims are the broadest claims, and dependent claims are narrower in scope than the claims to which they refer and incorporate, because they add limitations.

In order to infringe a claim, every limitation set forth in the claim, or an equivalent thereof, must be found in the accused product or method. Something is equivalent to something else if it is not substantially different. The test of whether differences are substantial or insubstantial rests on objective evidence demonstrating that the substitution represents a change that an ordinary artisan would have considered insubstantial at the time of infringement.

IT IS EXTREMELY IMPORTANT FOR THE INVENTOR TO UNDERSTAND THAT THE WAY THE PATENT APPLICATION IS WRITTEN AND PROSECUTED BEFORE THE PATENT OFFICE MAY SIGNIFICANTLY LIMIT THE ABILITY TO LATER CLAIM THAT SOMETHING IS AN EQUIVALENT TO A CLAIM ELEMENT.

The extent to which a claim limitation can be expanded by application of the doctrine of equivalents is strictly limited by any one or any combination of the following:

- admissions, concessions and arguments made during the prosecution history to comply with requirements of the patent law, generally referred to as prosecution history estoppel;
- statements in the patent itself as to the critical importance of a limitation;
- the scope and content of the prior art, in that the claims cannot be read so broadly as to cover devices in the public domain;

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- subject matter disclosed, but not claimed in a patent application, which is dedicated to the public, and cannot be found to be an equivalent; and
- subject matter which the inventor could have reasonably foreseen to be equivalent, but which the inventor and attorney did not take care to cover in the claims, may be held to be dedicated to the public and not subject to coverage under the doctrine of equivalents.

The inventor can be of tremendous assistance to the attorney in thinking about alternative ways of doing the same thing, and making sure the claims are drafted broadly enough to cover such alternatives. In addition, care should be taken to claim all disclosed subject matter which should be protected, lest it be deemed dedicated to the public.

6. You must make certain that patent counsel properly schedules preparation and filing of your application to meet the filing date deadlines set forth below:
 - If you want to reserve the right to file patents in countries foreign to the United States, you should make certain that your United States or international patent application is filed before the invention is made public in any way.
 - your national/foreign applications must then be filed within 12 months of your first application filing date (only six months in the case of design patents).
 - there are some foreign countries where your foreign patent application should be filed at the same time your United States application is filed -BEFORE THE INVENTION IS MADE PUBLIC IN ANY WAY.
 - Even if you only wish to file in the United States, you must make certain that your application is filed in the United States Patent and Trademark Office less than one year after:
 - your invention is described in a printed publication (articles, product literature, newsletters, etc.);
 - your invention is used publicly (experimental use being excluded); and
 - your invention is first offered for sale. An offer for sale may have occurred even though no sale has been consummated. An offer for sale may have occurred even though you only have a prototype, or perhaps only drawings, of your invention. Any activity which might remotely be construed as an offer for sale should be reported to counsel promptly.
7. One way to preserve an early filing date without starting your 20-year patent term is to file a “provisional patent application.” A provisional patent application is a disclosure of your invention, without appended claims. If you then file a complete application, including claims, within one year of your provisional application filing date, you can claim the benefit of your provisional application filing date, to the extent that your provisional application provides an enabling disclosure of your claimed invention. If the provisional does not provide an enabling disclosure, it is a meaningless document and you do not receive the benefit of its filing date. For that reason, one should be careful about viewing a “provisional patent application” as a less expensive entrée into the patent process (though the filing fee is substantially less than that for a non-provisional application.) If you do not file a complete application within one year of the provisional filing date, your provisional application goes abandoned.

One can file more than one provisional application to reflect changes in your invention created during the development process. The fact that development may be ongoing is a reason to begin the patenting process with a provisional application.

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8. Be sure that you disclose to patent counsel all prior art of which you are aware which is pertinent to your invention. The duty to do so is specifically imposed upon you by the United States Patent and Trademark Office and the patent laws. Prior art may include any of the following, depending on certain key dates which should be discussed with patent counsel:
 - competitive products
 - your own prior products and inventions
 - prior inventions by others
 - prior patents and publications, including your own
 - your own activities occurring more than one year prior to your prospective patent application filing date which may be construed as an offer for sale, publication or public use of your invention or an invention which is a pertinent forerunner of your present invention.
9. Employers, be certain that your employment contracts require employees to assign to your company inventions which relate to your business.

Life of a Typical Patent Application

- **The Search:**

Conducting a patentability search is not a requirement for filing a patent application. However when conducted, they typically require about six to eight weeks. If the search indicates that the invention is patentable, a patent application is then filed.
- **Patent Application Preparation:**

A patent application is prepared based on information received from the client. A draft is submitted to the client to review. Once the client is satisfied with the draft, the patent application is filed in the United States Patent and Trademark Office.
- **Routine Notices:**

The client is notified when the Patent Office acknowledges receipt of the patent application, and assigns a serial number and filing date. Similarly, the client receives notification at the time the Office confirms recordation of any assignment which has been submitted to the Patent Office in connection with the application.
- **Publication:**

Eighteen months from the priority filing date, the patent application will be published, unless the applicant has indicated that there will be no foreign counterparts filed, and has requested that the application not be published.
- **Substantive Action:**

Typically from about eight to about 16 months after an application is filed, we receive an Office Action, in which the Examiner either indicates the allowability of the patent application, or more typically issues some type of rejection or requirement. The client is notified of any such action, along with an indication of the probable course of action recommended.
- **Response:**

A response must then be filed to the Official Action, dealing with the substance of any rejection or requirement issued by the Examiner. Usually, we are given three months within which to respond to an Official Action, though the deadline is extendable by payment of fees for up to six months.

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- **Notice of Allowance:**
If the substantive issues raised by the Patent Examiner in one or more Office Actions are satisfied, the Examiner will eventually issue a notice of allowance. At that point, we carefully review the patent application to make sure that everything is in good order.
- **Payment of The Final Fee:**
Within three months of receipt of the notice of allowance, the final government fee will be due in the case.
- **Notice of Issuance:**
At some point, we receive from the Patent Office a notice that the patent has issued. This is then reported to the client. At this time, we also docket the case for payment of maintenance fees.
- **Maintenance Fees:**
At 3-½, 7-½, and 11-½ years, maintenance fees must be paid to the United States Government in order to maintain a patent in effect. If the fees are not paid, the patent goes abandoned.