

 BLSpeer & Associates


 ATTORNEYS AT LAW

US Patent Law An Overview

bspeer@uccs.edu

© 2005-2019 Brenda L. Speer

719.381.1708 | fax: 719.466.8098 | Brenda@BLSpeer.com | www.BLSpeer.com
 104 SOUTH CASCADE AVENUE, SUITE 200 C, COLORADO SPRINGS, CO 80903-5102




 BLSpeer & Associates

 ATTORNEYS AT LAW

Utility Patent

Any *new, useful* and *nonobvious*

- *Process* (making an aluminum can)
- *Machine* (aluminum can making machine)
- *Manufacture* (aluminum can)
- *Composition of Matter* (alloy - steel)
- *Improvement thereof* (pop-top can)




 BLSpeer & Associates

 ATTORNEYS AT LAW

Patents...

- **Who is an *Inventor*?**
 - Contributor to an element in a *Claim*
- **Who is an *Owner*?**
 - Inventor, or
 - Assignee
- **Who is an *Applicant*?**
 - Inventor, or
 - Assignee




 BLSpeer & Associates

 ATTORNEYS AT LAW

Patents...

- **US Application Process?**
 - Patent right belongs to *Inventor*
 - Prior Art Bar Period
 - 12 months to file after public disclosure, or
 - Deemed dedicated to public
 - *Prior Art Search*




 BLSpeer & Associates

 ATTORNEYS AT LAW

Patents...

- **Applications?**
 - Foreign Filing Considerations:
 - Disclosure can be **Absolute Bar**
 - Filing Date = *Priority Date*



 BLSpeer & Associates

 ATTORNEYS AT LAW

Patents...

- **Applications?**
 - Types:
 - *Provisional* (only utility)
 - **Non-provisional**
 - Patent Cooperation Treaty

BL Speer & Associates
ATTORNEYS AT LAW

Patents...

- Applications?
 - Provisional
 - Minimal disclosure - no claim
 - 12 months duration
 - No examination
 - No grant
 - Priority date placeholder

BL Speer & Associates
ATTORNEYS AT LAW

Patents...

- Applications?
 - Non-provisional
 - Complete disclosure with claims
 - Examination
 - May mature into a Grant

BL Speer & Associates
ATTORNEYS AT LAW

Patents...

- Applications?
 - Patent Cooperation Treaty
 - Foundation for foreign filings
 - Disclosure/Examination/Grant
 - Initial filing, or
 - Based upon US filing

BL Speer & Associates
ATTORNEYS AT LAW

Patents...

- Applications?
 - Pendency
 - First-come, first-served
 - First action average = 18 months
 - Examination average = 3 years

BL Speer & Associates
ATTORNEYS AT LAW

Patents...

- Applications?
 - CO\$T\$
 - Legal Fees - *prepare application*
 - Filing Fees - *file application*
 - Issuance Fees - *grant patent*
 - Maintenance Fees - *keep patent*

BL Speer & Associates
ATTORNEYS AT LAW

Patents...

- Intangible property right
 - Exploit for self (own)
 - Permit another to exploit (license)
 - Sell to another (dispose)

BL Speer & Associates
ATTORNEYS AT LAW

Patents...

- **Licensing?**
 - **Permission** to use per terms
 - Any or all rights to *make, use* and *sell*
 - *Time*
 - *Territory*
 - *Payment*
 - *Quantity*
 - *Etc.*

BL Speer & Associates
ATTORNEYS AT LAW

Patents...

- **Infringement?**
 - **ALL Elements of Claim** are met
 - Literal
 - Doctrine of Equivalents
- **What is okay?**
 - **Express permission**
 - **Public domain**

BL Speer & Associates
ATTORNEYS AT LAW

Patents...Practice Pointers

- **Disclosure** can be **fatal**
 - Prior Art Bar (1 year look-back period)
 - First to File per America Invents Act (16 March 2013)
- **Provisional Patent**
 - Priority date placeholder
 - No rights

BL Speer & Associates
ATTORNEYS AT LAW

Patents...

- **US Application Parts** (Nonprovisional)
 - See uspto.gov (37 CFR §§ 1.51-1.54, 1.56)
 - **Specification** (37 CFR §§ 1.72-1.75)
 - Abstract
 - **Drawings** (37 CFR §§ 1.81-1.84)
 - **Claims**

BL Speer & Associates
ATTORNEYS AT LAW


Patents...

- **US Application Parts**
 - **Ancillary Documentation** (37 CFR § 1.77)
 - Declaration of **Inventor** (37 CFR §§ 1.63)
 - *Assignment to Owner/Applicant*
 - *Information Disclosure Statement* (37 CFR § 1.97)
 - Application Transmittal Documents

BL Speer & Associates
ATTORNEYS AT LAW


Patents...

- **US Application Parts** (Nonprovisional)
 - **Specification**
 - Title
 - Background of Invention
 - » Field of Invention
 - » Description of Related Art
 - Summary of Invention
 - Brief Description of Drawings
 - » Figures
 - » Reference Numerals
 - Detailed Description of Invention
 - Claims (≤ 3 Independent and ≤ 20 Total)
 - Abstract
 - Drawings


BL Spear & Associates
ATTORNEYS AT LAW

Patents...

- **US Application Parts**
(Nonprovisional)
 - **Drawings**
 - Black and White
 - Line Drawings
 - Figure Number
 - Element Numbers
 - Arrows


BL Spear & Associates
ATTORNEYS AT LAW

Patents...

- **US Application Parts**
(Nonprovisional)
 - **Claims**
 - Independent (stands alone) (MUST have at least 1)
 - Dependent (pends from and incorporates an Independent claim)
 - *Multiple Dependent (pends from and incorporates 2 or more claims)*