Five Things Inventors May Not Realize About the Patent Process

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PRACTICES Patent Litigation, Patent Office Trials, Patents, Intellectual Property

Whether you are a garage tinkerer or an engineer at a technology company, you probably have considered obtaining a patent to protect one of your ideas or innovations. There is an allure to a government issued document declaring that you are the inventor of a patent that grants you exclusive right to your innovation. However, the next time that light bulb goes off above your head, here are five things you should consider before calling your patent lawyer.

1. There Is A Long Line At The Patent Office

In 2015, a total of 411,728 new patent applications were filed at the United States Patent and Trademark Office (USPTO), and this number has increased every year for the past five years. Even though the USPTO has tens of thousands of patent examiners examining these patent applications, there simply are not enough examiners to keep up with such a large volume of patent applications resulting in a relatively long backlog of pending applications waiting for review and examination. Typically, after a new patent application is filed, it takes about one to two years for that application to finally be reviewed and examined by an examiner, and another year or two may pass while the patent application goes through several rounds of Office Actions and responses between the patent examiner and your patent lawyer. By the time the patent application is allowed and issued as a patent, three to four years (or longer) may have passed since it was initially filed. This lag time means that you may have already won a Nobel prize for your invention before the USPTO issues a patent for it.

The USPTO does provide a few options to speed up the patenting process by filing a petition to make special based on special circumstances, such as age or health. For example, an inventor who is 65 years old or older can file a petition to make special based on age, which would move his/her patent application to the front of the line. For those who do not have special circumstances but simply prefer not to wait in line, the USPTO provides several programs or options, such as the Track One Prioritized Examination, that allow applicants to pay a fee to have their applications move up to the front of the line at the USPTO. Based on your unique circumstance, an experienced patent lawyer can explore different options with your to speed up the patenting process.

2. You Don’t Usually End Up With A Patent For The Invention You Initially Started With

Whether you realize it or not, in many cases others may already have come up with ideas similar to your invention. When examining a patent application, the patent examiner at the USPTO will search through various databases and typically find prior art that describes concepts similar to your ideas and will reject your patent application for lack of novelty or for being obvious in view of the prior art. To help you obtain a patent, your patent lawyer will attempt to overcome these rejections by providing arguments and/or amending the patent application to distinguish your idea from the prior art.

Typically, your patent application will go through several rounds of rejections and amendments before the patent application is finally allowed (assuming the patent application survives the rejections). As such, what you initially claimed (or intended to claim) in your patent application may be different from what is eventually allowed. Some may be surprised to find that a patent application for a dream machine ends up with final claims for a bizarre widget.

To mitigate such surprises, you may wish for your patent lawyer to conduct a prior art search before filing a patent application. A prior art search can give you an idea on whether there are prior arts similar to your invention. Based on the result of the prior art search, an experienced patent lawyer can provide you with an analysis on how much protection you can realistically expect to obtain from filing a patent application. Typically, patent protection in a more crowded technology area tends to be narrower and is harder to obtain. In that case, you may wish to invest your patenting effort in another innovation instead.

3. Having A Patent Does Not Necessarily Protect You From Patent Lawsuits

A patent gives you **the right to exclude others** from making, using, or selling the patented technology. However, a patent does **not** necessarily give you the right to make, use, or sell the patented technology. For example, having a patent on a widget you have invented provides no assurance that you will not be sued by another person if that person believes your widget infringes on his/her patent. This may be a confusing concept to most people. It may be helpful to imagine that a patent is a sword, but not a shield. Thus, having a patent on your widget does not shield you from patent lawsuits, as someone else may already obtained patent(s) that arguably cover some aspects of your widget. What is a patent good for then? Again, a patent can be used as a sword to prevent others from making, using, or selling your patented technology. Further, in the event that you are named in a patent lawsuit, having a well-drafted patent will put you in a better negotiating position for cross licensing.

4. You have To Pay More Fees After Patent Grant To Keep The Patent In Force

After waiting several years and paying tens of thousands of dollars to the USPTO and your patent lawyer, you finally receive a patent and hope that the patent will stop costing more money. Unfortunately, to keep the patent in force, you have to pay maintenance fees at 3.5 years, 7.5 years, and 11.5 years after issuance of the patent. For example, for a large entity applicant, the maintenance fees are $1,600.00 due at 3.5 years, $3,600.00 due at 7.5 years, and $7,400.00 due at 11.5 years. Although there is a 50 percent or 75 percent discount for individual inventors or small organizations, these maintenance fees can still add up when you have to keep multiple patents in force. Thus, you or your patent lawyer should periodically review your patent portfolio and consider carefully whether some patents should be allowed to lapse to reduce the cost of maintenance fees. For example, based on business circumstances or market conditions, you may wish to allow certain patents that no longer provide value or protection to lapse.

5. After Your Patent Expires, Your Patent Right Is Automatically Given To The Public

The goal of the U.S. patent system is to promote the progress of innovation. As Isaac Newton once said “If I have seen further, it is by standing on the shoulders of giants.” To that end, the patent system encourages an inventor to share his/her invention with the general public through the filing of patent application. In return, the inventor is rewarded with monopoly over his/her invention for a limited period of time. A utility patent will generally expire approximately 20 years after filing, and following expiration the invention becomes public domain and anyone can make, use, or sell the invention. Thus, if you want to keep the exclusive right to your innovative idea for longer, you should

consider other means of protection. For example, trade secret protection is one option that allows an idea to be protected for as long as it is kept a secret from the public. Famous examples of trade secret include the formula for Coca, ingredients for KFC's fried chicken, and the formula for WD-40.

The patent system is one of the most powerful tools for protecting innovation. Technology companies have risen and fallen based on a little piece of paper called patent. However, there is no one-size-fits-all solution when it comes to protecting your intellectual property. Given the substantial costs and time associated with obtaining a patent, you should discuss and consider all options with an experienced patent lawyer on how to best protect your innovation.