

# 7 Core Concepts: Patent Fundamentals

## Introduction

The patent process takes years to complete. With each decision along the way, there are different pitfalls and options. Each route has its pros and cons. Since 2003, I've been helping inventors and businesses navigate the patent process. The first step in being a successful inventor is to develop a cost effective plan of action that makes sense. We do this through an initial consultation.

The initial consultation is designed to provide a framework within which you can work to protect your intellectual property. We cover seven (7) core concepts to develop a recommended course of action that is both understandable and within budget.

### **CORE CONCEPTS (see below)**

1. [Define the invention](#)
2. [Review of the prior art](#)
3. [Explore different ways of protecting your intellectual property](#)  
(i.e., patent, trademark, copyright and trade secret)
4. [Foreign protection](#)
5. [Ownership](#)
6. [Bars to patentability and the America Invents Act](#)
7. [Patent Process](#)

[Questions and answers](#)

[Recommended next step\(s\) and estimated fees](#)

The initial consultation lasts about 1 ½ hours to complete. I invite you to contact me at [james@ocpatentlawyer.com](mailto:james@ocpatentlawyer.com) or (949) 433-0900 to schedule the initial consultation.

There is no substitute for advice from a patent attorney. Hence, don't rely on the information provided but contact me to schedule your initial consultation.

## **Overview of the 7 Core Concepts**

### **Core concept #1: Define the invention**

What is the invention? This is the million dollar question. An invention can be defined in many different ways. During the consultation, we discuss your invention and try to distill it down to its fundamental components. We broaden up your invention. We also find different applications for your invention to increase market potential for your invention. This often helps to interest potential investors.

### **Core concept #2: Review of the prior art**

Prior art is defined as existing technology, devices and methods. Please bring any reference that you believe is prior art to your invention. I will briefly review the reference to determine its applicability to your invention.

### **Core concept #3: Explore different ways of protecting your intellectual property**

There are four main forms of intellectual property protection. They include patents, trademarks, copyrights and trade secrets. Each form protects the invention or idea in a different way. Some are similar to each other. We will explore these other forms of intellectual property and consider how they might be employed to your advantage.

### **Core concept #4: Foreign protection**

For inventors seeking potential licensees and investors, foreign patent protection may be crucial to closing the deal. We cover why you must file a patent application before any type of public disclosure or potential sale to preserve your right to seek foreign patent protection. We also review the timing and cost requirements of filing a Patent Cooperation Treaty (PCT) application to preserve your right to file in foreign countries.

### **Core concept #5: Ownership**

Ownership issues arise in numerous situations. It would be fruitless to spend money and time if you do not own the invention. We review your situation to ensure that you have the proper rights and contracts in place before filing the patent application.

Ownership issue oftentimes arise in the following situations: (1) co-inventorship, (2) inventor and investors, (3) employer/employee and (4) independent contractor situations. These issues should be resolved early. Otherwise, it may be costly and impossible to resolve later.

### **Core concept #6: Bars to patentability and the America Invents Act**

For patent applications filed prior to March 16, 2013, you have one year from the first public use, offer for sale or distribution of a printed publication to file a patent application in the United States. Beginning March 16, 2013, the United States will transition to a first inventor to file system under the America Invents Act. This means that the patent is awarded, not to the first to invent, but to the inventor who files a patent application with the patent office first. We cover these concepts and their exceptions.

**Core concept #7: Patent process**

We cover the major steps and timing of the patent process such as a patent search, filing of a patent application, first office action, issuance and maintenance fees.

**Questions and answers**

The patent process can be overwhelming. We reserve a portion of our time to answer your questions about the topics discussed. We also answer any questions regarding the patent process to clarify and help you understand the process.

**Recommendation and estimated fees**

At the end of the consultation, we provide a recommended course of action and refined estimates of fees based on our discussion.

## **Define the invention**

### **Core concept #1: Define the invention**

#### **Details versus broad concept**

This core concept relates to defining the invention. Oftentimes, in defining the invention, the details divert our attention away from seeing the broadest embodiment of the invention. We remain intently focused on the trees, and forget to see the forest. It is important to get to the details but, the overall picture of the invention, its functionality, its fundamental components are missed in an effort to include all of the details.

#### **Focus on the fundamentals**

Focusing on the fundamental benefits and components first sets the tone for the patent search, the patent application, the claims and all of the work during prosecution of the patent application before the Patent Office. From the general concepts of the invention, we can move on to the details and nuances of the invention.

#### **Uncover the most basic components**

To figure out the fundamental components of the invention, we review the various components of the invention and ask whether any component can be dispense with yet still achieve the stated function of the invention. Could the invention still work with different materials, a different number of parts, or a different arrangement of parts? It is these types of questions that help to ferret out the broadest concept of the invention. We do this through the initial consultation.

#### **Benefits**

By discussing the invention during the initial consultation, we:

1. Expand applicability of the invention to other industries;
2. Develop a strategy for the format of the patent application;
3. Develop a plan to block competitors from designing around your patent, should one issue;
4. Increase the probability that the Patent Office will grant a patent on your invention; and
5. Facilitate smoother prosecution of the patent application.

As an advocate, my goal is to assist you in exploiting your invention to the fullest. I invite you to contact me to schedule an initial consultation at (949) 433-0900 or [james@ocpatentlawyer.com](mailto:james@ocpatentlawyer.com).

## **Reviewing the prior art**

We will explore the importance of a patent search and how it is used in the patent process.

### **Prior art defined**

Prior art refers to the current state of the art. What devices and methods do people currently use to solve the problem that your invention resolves? The Patent Office will not grant a patent on an idea that is already known or obvious in light of the prior art.

### **Conduct your own informal search**

Inventors typically spend a few minutes of their own time to conduct an informal prior art search on the internet. For example, I recommend searching for your invention at [www.google.com](http://www.google.com) or at [www.google.com/patents](http://www.google.com/patents). If you find a reference that is identical to your invention, then you can move on to the next project or bring the reference to the initial consultation where I can review the reference and provide my opinion as to whether the reference will prevent you from obtaining a patent on your invention.

### **Should you file a patent application**

The patent search is optional but an important step in the patent process. The results of the patent search help inventors decide whether to apply for a patent on their invention.

Moreover, the results of the patent search is also used along with business and marketing information to decide whether to invest further time and money into building prototypes, seeking investors, and many of the other activities related to licensing or starting a business.

I am here to guide you through the patent process. During the initial consultation, we discuss and explore various issues to determine the right course of action for you in your situation.

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### Exploring other forms of IP

By now, you have had an opportunity to think about your invention and may have already completed your own preliminary patent search at [google.com/patents](https://google.com/patents). In this email, we discuss the other forms of intellectual property that could be used to protect your idea. One type of intellectual property protection might be the primary way that you protect your idea, but it is still a good idea to understand how the other areas of intellectual property law can be used to protect your idea and as you build out your product.

#### **Core concept #3: Explore different ways of protecting your intellectual property**

There are four main types of intellectual property that can be utilized to protect your idea, invention, information, or work of art (i.e., intellectual property). Each type of protection provides coverage in a slightly different way. During the initial consultation, we determine which type of intellectual property might best protect your idea.

Here is a simplified way of remembering each type of protection and what it protects.

Patents (utility and design)	... protect ...	Inventions
Trademarks	... protect ...	Brands
Copyrights	... protect ...	Creativity
Trade Secrets	... protect ...	Information

Here is a chart of each type of protection and the major differences.

Type of protection	Subject matter	Duration of protection	Registration process
Utility patent	Useful inventions	20 years	Yes
Design patent	Ornamental features	14 years	Yes
Trademark	Brands	Indefinite	Yes/No
Copyright	Works of authorship	~100 years	Yes/No
Trade secret	Valuable business information	Indefinite	No

Most products can be protected in one way or another by each of these four types of intellectual property rights. For example, a can of Coca-cola is protected by all four types of intellectual property. Coca-cola is a trademark. The formula is a trade secret. The packaging is protected by copyright. The shape of the coca-cola bottle can be protected by both (1) a design patent and (2) a trademark (i.e., trade dress).

During the initial consultation, as we discuss the invention, we are also exploring each of the other types of intellectual property. If it is possible to protect the idea with other forms of intellectual property, we discuss your other options and the pros and cons with each option.

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## **Foreign protection**

Many start ups might think that seeking foreign patent protection is expensive. While this may be true at the later stages of the patent process, it is free to preserve your right to seek patent protection in other countries. All you need to do is file the patent application before any type of disclosure such as an offer for sale, distribution of a printed publication or public use.

### **Core concept #4: Foreign protection**

For start ups, the option to file seek patent protection in foreign countries is often crucial. Start ups may not be able to close the deal with investors and potential licensees if the invention cannot be protected in foreign markets. During the initial consultation, we explore these issues and discuss whether foreign patent protection for your invention would be important to achieve your goals.

The typical route in seeking foreign patent protection is to first file a patent application in the United States. Twelve months after the filing of the U.S. application, a corresponding patent application in your select foreign countries must be filed or the right to claim priority back to the U.S. application is forever waived. Oftentimes, filing directly in all of the desired countries is expensive. Also, businesses may still be unsure about market reception of the product in the foreign country. As such, many businesses take advantage of the Patent Cooperation Treaty, which we discuss during the initial consultation.



## **Ownership**

The issue here is simple. If you don't own the invention, then it would be a waste of money to seek patent protection on the invention. See how ownership issues arise below.

### **Core concept #5: Ownership**

Ownership issues arise between co-inventors, in inventor - investor relationships, employer - employee relationships and independent contractor relationships. If you do not own the invention, then it would be a waste of time and money to file the patent application. During the initial consultation, we explore any potential issues with ownership.

Under U.S. patent laws, each of the co-inventors can exploit the technology to their own benefit without accounting for profits to the other co-inventor. Between inventor and investors, the inventor can abscond with the patent application without repayment to the investor. Employees unless they are under a contract to assign an invention to the employer, may own the invention to the surprise of the employer. The same is true for independent contractor relationships.

Ownership issues are generally easier and less expensive to resolve early on during the patent process. Later on, ownership issues are generally expensive and may not be resolved due to the conflicting interests of the parties. During the initial consultation, we explore these relationships and develop a course of action that will avoid these pitfalls.

## **America Invents Act and the bars to patentability**

### **Core concept #6: America Invents Act and the bars to patentability**

Under current U.S. laws, there are three different “bars to patentability”, namely, offer for sale, public use and printed publication bars. If more than one year has elapsed after any one of these events, then a patent will not be granted on the invention.

Each of these events or “bars to patentability” have a specific legal meanings developed through years of case law to determine whether an invention was offered for sale, in public use and distributed through a printed publication. Moreover, through case law, the experimental use exception has been developed. If you believe that any one of these have been triggered, it is imperative to seek proper legal counsel immediately to determine whether you can seek patent protection on your invention.

On March 16, 2013, under the America Invents Act, the United States will transition from a first to invent system to a first inventor to file system. Under the first to invent system, the first person to invent is granted a patent on the invention. Under the first inventor to file system, the first person to file a patent application regardless of who was the first to invent is granted the patent on the invention. We discuss these issues during the initial consultation.

## **Patent Process**

During the initial consultation, we discuss the overall patent process which is also briefly discussed below. We discuss the types of profitable activities during various stages of the patent process.

### **Core concept #7: Patent process**

#### **1. Conduct patent search**

The first step in seeking patent protection is to conduct a patent search. The patent searching step is optional but is often helpful to inventors in deciding whether to file a patent application. If the patent search comes out positive, then this means that the Patent Office is likely to grant you a patent on your invention.

#### **2. Prepare and file patent application**

The next step is to file a patent application. The process of preparing and filing a patent takes about 4 - 6 weeks.

#### **3. Market your idea**

After the patent application is filed, then you wait for the Patent Office to examine your patent application. You will wait about 2-3 years upon filing a utility patent application and about 9 months if you are seeking protection through a design patent application. Although the waiting period may be long, this period of time should be constructively utilized to determine marketability of the invention, seek potential licensees and investors of the patent pending invention.

#### **4. Respond to office action**

Upon examination, the Patent Office will render an official stance on whether to grant you a patent on your invention. The official stance will be documented through an Office Action which will provide a detailed explanation of the grant or denial. Most patent applications are initially rejected by the Patent Office. It is crucial to obtain competent legal representation from a patent attorney who will be able to represent your interests before the Patent Office. We will respond to the Office Action.

#### **5. Issue, appeal or abandon**

After filing the response, the Patent Office may maintain the rejection or allow the case to go to issuance. You can always opt to abandon the patent application should you feel that it is not a sound business decision to continue moving forward with the patent application.

#### **6. Schedule an Initial consultation**

For new inventors, the initial consultation is the first step in protecting your invention. It is the most important step in the process of patenting your invention since we cover all of the core

concepts. I invite you to contact me at [james@ocpatentlawyer.com](mailto:james@ocpatentlawyer.com) or (949) 433-0900 to schedule your initial consultation.

## Q and A

### Recommendation and fee estimates

As you can see, we cover a lot of ground during the initial consultation.

#### Steps #8 and #9: Q and A, Recommendations and Estimated Fees

During the initial consultation, we cover seven (7) core concepts crucial to protecting one's intellectual property.

1. [Invention](#) - distilling the invention
2. [Prior art](#) - review existing technology
3. [Other forms of IP](#) - different ways of protecting your idea
4. [Foreign protection](#) - process of filing foreign patent applications;
5. [Ownership](#) - spot check ownership issues;
6. [Bars to patentability and the America Invents Act](#); and
7. [Patent Process](#) - timing

Q and A

Recommendation and fee estimates

At the end of the consultation, we leave some time for other questions that you might have. We also summarize our recommendations and estimate of fees which was developed during the initial consultation.

These core concepts provide you with the foundational concepts in protecting your ideas with one or more intellectual property rights. The initial consultation is designed to educate you on how to exploit your invention to its fullest potential.

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