



Every inventor ought to have the basic information about the patent process before spending any significant amount of money toward securing a patent. They will be better served if they can understand what to expect should they decide to embark on the patent process. Clients who understand the reasons behind the recommended steps are better able to follow the advice of counsel. The Seven Core Concepts was developed with the help of all the inventors I have counseled. Each inventor posed a different set of questions, but some common themes consistently arose. The Seven Core Concepts is a collection of those common themes and helps inventors systematically understand the important topics. It forms the starting point of the discussion with inventors and allows the discussion with counsel to develop from there.

The full scope of what an inventor ought to know cannot be covered here but the following concepts will help you and inventors identify the main issues.

Core Concept 1: Defining the Invention

The invention is often described in terms of the problem-solution approach. Patent attorneys are taught that if you identify the solutions to your problems, each of those solutions can form the basis for a patent. The problem with this approach is that many problems are encountered and solved during the process of launching a product. Thus, in the beginning of this process, inventors and attorneys have a difficult time deciphering what will become important.

Another approach to identifying the invention may be the benefit-structure approach. Start by identifying the benefits that customers are will-

ing to buy, and work backwards to the structure necessary to achieve those benefits. Thereafter, determine whether the benefits and corresponding structures are new for patentability purposes.

For example, a hat that I recently considered purchasing touted its benefits as:

1. Staying on during windy days;
2. Staying cool; and
3. Providing SPF 50 sun protection.

Based on these benefits, one can work backwards to the corresponding structure. The structure associated with the benefit of staying on during windy days was the chin strap. The structure associated with staying cool was an open mesh material around its perimeter, allowing wind to flow through the hat. It was unclear how the hat achieved an SPF of 50, but that would be an area of needed conversation with the inventor.

The identification of the structure that achieves the desired benefit or the solution to the problems solved are used throughout the patent process. For example, the structure associated with the benefit is searched for during a novelty search. The preparation and prosecution of the patent application should remain focused on the structure associated with the benefit.

Core Concept 2: Resolving Ownership Issues

Without exception, the invention must be owned by a single entity. The entity can be the inventor or a company to which the invention is assigned by the inventor.

Ownership problems arise because inventors must work with others to launch a product. They generally work with independent contractors such as manufacturers and engineers. In working with these people, suggestions are made on

how to improve the invention. Under U.S. patent laws, a person owns their inventive contribution until it is assigned to the inventor or the entity that will hold ownership to the invention.

To ensure that the inventor owns all of the invention rights, the solution is not to file a patent application on the invention. That would only secure the inventor's current ideas, but not the ideas of others. Rather, the way to solve this problem is to have everyone who worked on an invention execute an invention assignment agreement. In this manner, if an independent contractor came up with an inventive improvement to the basic invention, the inventor will own the idea for the improvement or, at the very least, be able to use their ideas.

Core Concept 3: Conducting a Novelty Search

An informal novelty search is recommended for every case. By informal, a simple keyword search can be conducted using the database at www.freepatentsonline.com, or a professional search firm can be hired. Clarivate (<https://clarivate.com/products/patent-search-services/>) and WashPat (www.washpat.com) both offer a novelty search service.

Inventors can also conduct their own class-subclass search using the same steps suggested by the United States Patent and Trademark Office (USPTO). To find the USPTO guide to patent searching, simply conduct an internet search for "7 Step Patent Search Strategy." Use those steps along with the free patent online database to conduct the actual search.

A formal paid search by a patent attorney can also be conducted. They will spend time to identify the invention and review the search results to come up with an opinion as to patentability.

Regardless of how the search is conducted, it is important to understand the limitations of what the novelty search can do for the inventor. First, the novelty search is not a guarantee that the inventor will receive a patent. Second, even if a formal paid search is conducted, there is always a possibility that the examiners at the USPTO will uncover a more relevant reference to reject the application for patent. And third, the opinion merely informs the inventor of the likelihood of receiving a patent based on the information found.

Core Concept 4: Exploring Different Ways to Protect Your Idea

There are four main areas of Intellectual Property (IP) law that are useful for protecting ideas and inventions: trade secrets, trademarks, copyrights, and patents. Each type protects ideas or inventions in a different way, and provides a different remedy for infringement.

It is important to secure the proper type of IP right for the invention. Usually, the language that the inventor uses to describe the idea indicates the type of IP right that should be secured. For example, if words describing aesthetics or ornamentation (e.g., looks good, clean lines, etc.) are used, then it is most likely a design patent that should be secured. If words of function (e.g., faster, simpler, cheaper, stronger, etc.) are used, then it is most likely a utility patent that should be secured.

A simple way to determine which type of IP right can properly protect the idea is to remember that:

1. Design patents protect aesthetics (i.e., ornamentation).
2. Utility patents protect functional features.
3. Copyrights protect creative works of authorship.
4. Trademarks protect brands.
5. Trade secrets protect valuable information.

Core Concept 5: Bars to Patentability and the Impact of the First-to-File Regime

The bars to patentability are the ways that inventors and businesses typically market their inventions. Once any one bar to patentability occurs, then the inventor has one year to file a corresponding patent application. Otherwise, the inventor's own activities will be used to reject any application for patent that the inventor might file later. This is known as the one-year grace period.

The bars to patentability are:

1. Public demonstration (e.g., disclosures without a nondisclosure agreement);
2. Offer for sale (i.e., even if the sale is not made); and

3. Printed publication (e.g., indexed website).

In 2013, the United States transitioned from a first-to-invent (FTI) regime to a first-inventor-to-file (FITF) regime. It is the first inventor to file a patent application or the one that was faster at filing a patent application who will be awarded the patent. The first to invent is no longer awarded the patent. This transition changed how startups and solo inventors needed to think about protecting their ideas and inventions with patents.

The change in patent laws did not change the one-year grace period that previously allowed inventors to commercialize or test-market their invention for up to one year before spending money to secure patent pendency. However, although the one-year grace period was retained, the FITF made it riskier

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to commercialize or test market an invention without first securing patent pendency. Not securing the patent pendency can lead to harsh, negative results for the inventor.

Core Concept 6: Preserving Foreign Patent Protection

Seeking foreign patent protection can be expensive. Its value varies and depends on the strength of existing business relationships as well as the goals of the inventor. However, preserving your ability to seek foreign protection does not necessarily require a significant expenditure, and may be recommended.

To preserve the ability to seek patent protection in foreign countries, the inventor needs to follow one rule: Secure patent pendency first before conducting any marketing activities.

Once a patent application is filed, the right to file a patent application in many for-

eign countries is preserved for up to twelve months, even if the inventor markets the invention after filing. The inventor can also file a Patent Cooperation Treaty (PCT) application within the twelve-month period that preserves the inventor's right to file a patent application in most foreign countries for eighteen more months. These steps allow the inventor to seek patent protection in many foreign countries for up to thirty months, calculated from the filing date of the first filed patent application. If foreign patent protection becomes important to the inventor during that period of time, the inventor can then spend the money to national phase file patent applications in the desired foreign countries.

Core Concept 7: Reviewing the Overall Patent Process

The overall patent process is typically very long and expensive. It starts with the novelty search, which is an optional step. However, while inventors do not have a duty to search for prior art before seeking a patent, they do have a duty to disclose the results of the search if one is conducted. Thereafter, a patent application is filed and an office action from the USPTO is rendered, indicating whether a patent will be awarded. Even if the patent application is rejected, a response can be filed arguing for patentability. If that is unsuccessful, then further communications with the examiner can be continued with a fee, an appeal to the Patent and Trademark Appeal Board can be made, or you can abandon the patent application. The goal of patent prosecution is to come out of the USPTO with an issued patent, and the possibility to develop a portfolio of patents.



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