Patents 101 - Everything You Need To Know In Plain English

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What are Patents?

Patents are official government documents granting the patent owner the exclusive right to make, use or sell an invention in that country. This exclusive right last for 20 years from the date the patent was applied for. After the 20 years have passed, the invention is in the "public domain" and anyone can make use or sell the invention.

During the 20 year life of a patent, anyone who makes, uses, sells or imports any product or thing that is protected by a patent can be sued for patent infringement. In many cases, lawsuits can be avoided altogether - indeed, simply having a lawyer send a cease and desist letter may be all that is required to enforce a patent owners rights.

Patents can be sold like any other property. It is also possible to license a patent in exchange for royalty payments.

Patents are only enforceable in the country they are granted.

What can be Patented?

Patents protect inventions. An invention can be any combination of the following:

- **Devices**: A device can be an invention. The device does not have to be complicated: even something as simple as a spoon can qualify as a patentable item. Possible examples include simple machines, complex machines, tools, utensils, engines, containers, computers, electronic equipment, medical devices, novelty items, toys, buildings, articles of clothing, and many other items.

- **Compositions of Matter**: A new composition of matter - such as a new metal alloy, can be an invention. Possible examples include chemical compounds, drugs, cleaners, soaps, building materials, food additives, new plastic compounds, a new type of fabric, coatings, paper, a new food product, and nutritional supplements, to name a few.

- **Methods**: A method of doing something useful may be an invention. Examples include methods of manufacturing, methods of processing information, methods of electronic communication, methods of water treatment, chemical processing, methods of cleaning, methods of testing and even methods of doing business.

A single invention is often a combination of several separate inventions. Each of the separate inventions may be covered by a separate patent. For example, a new chemical compound may be patented as both a plastic and an adhesive. The method of manufacturing that compound and the method of forming that compound into useful plastic items may be patented. It may even be possible to patent a new machine for

carrying out the processes necessary to manufacture the new compound.

Requirements for a Patent

For any invention to be patented it must be useful, it must be new (i.e. novel) and it cannot be obvious. Novelty and Obviousness are usually the most difficult tests for any invention to pass.

- **Novelty**: For an invention to be novel (i.e. new) it must not have been available to the public before the patent application was filed. Publicly disclosing the invention can therefore ruin the chances of obtaining a patent for that invention. Here are some common ways in which an invention can be publicly disclosed:

- putting the invention on sale,
- publishing details of the invention in a printed publication, scientific journal or web site,
- displaying your invention at a trade show or convention,
- releasing details of your invention at a conference or presentation.

If the inventor (or the owner) publicly disclosed the invention (either directly or indirectly), then he/she may still apply for a Canadian or United States patent for the invention provided the patent application is filed within ONE YEAR of the public disclosure.

A confidential disclosure of the invention may not be a public disclosure of the invention, provided that certain steps be followed to keep the invention secret.

- **Obviousness**: An invention must not be obvious from prior existing inventions. If the invention would be obvious to someone who is skilled in that area of technology, then no one can get a patent for the invention. For example, if the invention is an improvement over an existing machine, and if the improvement is obvious, then valid patent protection cannot be granted. If the invention is simply a substitution of one material for another (for example making an aluminum ladder rather than a wooden one), then the improvement would be considered obvious unless there was an unexpected benefit derived by substituting the materials. Deciding what is and is not obvious is not always clear to a lay person, and is best determined by an experienced patent lawyer.

Steps to getting a Patent

The first step in getting a patent is having a patent agent write up a patent application. The patent application is a legal document that contains information about what the invention is, how it is made, how it is used, how it works and what is new about the invention. The patent agent generally prepares the patent application with your guidance in order to ensure that all of the relevant features of your invention or

disclosed in the application. Depending on how complicated your invention is, the patent agent may take between a few days to several weeks to prepare a patent application. When the application is completed it is filed in the appropriate patent office.

A while after the patent application is filed, the patent office reviews the application to see if it complies with the appropriate forms. The patent office then conducts a search of its records to find any similar inventions. The patent office then compares your invention to the previous inventions and applies the tests of novelty and obviousness. If the patent office believes your invention passes the two tests, then they will grant a patent for your invention. However, if the patent office believes your invention is not new, or if they feel your invention is obvious, or if they feel your application is deficient in some way, then they issue a report. If you respond to the patent office's report in a timely fashion, and if your response either corrects the deficiency in the application or convinces the patent office that their analysis is wrong, then they will grant you a patent. Often times, the patent application has to be amended to correct deficiencies in the application or to overcome obviousness challenges by the patent office. This process of responding to patent office reports is referred to as prosecution. Generally, your patent agent is the person responsible for responding to patent office reports and amending the application.

What is a Patent Pending?
Depending on the type of invention you have, it can take two or three years to prosecute a patent application. Of course, as soon as your application is filed you can refer to your invention as having a "patent pending". While you cannot sue someone for patent infringement until you have a granted patent, you can have your lawyer send "Cease and Desist" letters to would be patent infringers telling them that you have applied for a patent for your invention and inform them that they will face a lawsuit unless they stop.

How Much Does it Cost?
The costs of filing for patent protection vary greatly depending on the complexity of your invention, the complexity of the patent prosecution process and the number of countries where patent applications are filed.

The first cost is the cost of a preliminary patent search (assuming you have a profession do one for you). The costs of a preliminary search can vary depending on how many references will have to be reviewed. At Borges & Rolle LLP, we generally charge a flat fee (plus applicable taxes) for conducting patent searches.

The costs of filing a patent application include the following:

- the government filing fee ($150.00 Cnd for Canada and $500 US for a United States application - as of January 1, 2005),
- the costs of preparing formal drawings, and

- the patent agents fee for preparing the application.

The patent agent's fee varies considerably depending on how much work is involved in properly describing and claiming the invention. Talk to your patent agent and ask if he/she would be willing to quote a flat fee for preparing the patent application. This should help you budget for the project.

The cost of prosecuting a patent application also varies depending on the complexity of the matter. Reporting out correspondence from the patent office, replying to office actions or official letters, finalizing drawings all require input from the patent agent. It is usually difficult to estimate the prosecution cost precisely; however, a good rule of thumb is to expect the prosecution cost to be as high (or higher) than the filing costs. Finally, there is the cost of providing the patent office with formal drawings. Drawings often cost between $100 and several hundred dollars per page; however, it is often possible to prepare simple drawings yourself which would be acceptable to the patent office.

Conclusion

Obtaining a patent is usually a complex enterprise which generally requires the assistance of a registered patent agent. While it is theoretically possible for an untrained individual to navigate the complicated web of patent rules and procedures, it is rarely advisable to do so. The key step in the process is filing a patent application. Depending on the novelty and inventiveness of the invention, a well-drafted patent application should proceed smoother through the patent maze.