

Filing a Patent Application: *What to Expect*

1. Patent Applications

A patent application is much more than simply filing a form to register your invention. A patent is a contract between the inventor and the US government in which the inventor describes an invention¹ in exchange for the government granting the inventor the right to exclude others from using the described and claimed invention for a period of time (currently 20 years from filing date). Therefore, a patent application requires a written **description** of the invention in sufficient detail that one "skilled in the art of the invention" can use and apply the invention. The description is severely circumscribed by rules and formal requirements provided in the patent laws and regulations.

What is protected – what you have the right to exclude other from doing – is only what is written in the **claims**. Claims are a written description of your invention, and must follow a rigid format – each claim must be exactly one sentence, and together must cover each and every element of the invention. Claim writing is complicated. More information on claim writing is provided on my web site (www.brazosvalleypatents.com) and at the United States Patent Office site (www.uspto.gov).

Therefore, while it is possible to write your own patent application, the process is time consuming and requires a prolonged learning experience. Moreover, you are likely to forgo substantial rights. There are several kinds of patent applications:

- 1) Utility applications for "... **any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof...**"
- 2) Design applications for designs
- 3) Plant applications for asexually reproduced plants.

Generally when people refer to patents, they are thinking of utility patents. For utility patent applications, there are provisional applications and non-provisional (or regular) applications. As the name implies, provisional applications are preliminary, less formal applications that are relatively easy to file. However, they give you NO substantive rights. A provisional application only provides a priority date from which you can claim that you filed for a patent. If you file a non-provisional application based on the provisional application within ONE year of the filing date of the provisional application, then you can claim that the application was filed on the filing

¹ The claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research.

The United States Supreme Court has repeatedly and consistently stated that there are only three categories of subject matter for which one may not obtain patent protection: (1) laws of nature; (2) natural phenomena; and (3) abstract ideas.

date of the provisional. The provisional application remains secret unless a non-provisional application is filed. This establishes your invention date and the beginning date of the 20 year exclusivity period, and allows you to mark your product as ‘patent applied for’ or ‘patent pending’ (but only for the year). It also gives you time to better perfect the invention and decide if you wish to go forward with a non-provisional application at much greater cost.

2. Filing the Application

To file an application, both a written description (called the specification) and claims are prepared. This may be 10 to 25 pages of material, but some applications can run to hundreds of pages. Many applications will also require drawings that must conform to specific rules. The format of the specification is prescribed – see www.uspto.gov and www.brazosvalleypatents.com. The specification, together with the proper forms, is available at www.uspto.gov, and filing fees are sent to the US Patent & Trademark Office (USPTO). This can be done electronically at the USPTO web site or by mail.

3. What Happens Next

The patent office will acknowledge receipt of the application within about two to four weeks, and notify you of any formal deficiencies. After correction of the deficiencies, if any, **you wait**.

In about **18 to 36 months** you will again hear from the Patent Office through an official Office Action. The Office Action will tell you that the application has been examined and that the claims have been allowed or rejected. Almost always the claims will be rejected – sometimes for failure to meet the required formalities, and always as unpatentable over ‘prior art’ cited by the Patent Examiner. The Office Action must be responded to within three months (although you can buy up to three additional months of extension). For a proper response you must read all the patents and literature cited, compare these with the reasons the Examiner gives for rejection, and formulate a way to overcome the Examiners arguments. Having done this, you usually will amend the claims to change them in a way that gets them outside the art and argument of the Examiner. This response is sent to the USPTO and **you wait**.

After another year or two you receive another – final – Office Action. Some or all of the claims may be allowed, or all again rejected. The same procedure as described above is followed. If the USPTO responds that the claims are still rejected, you can:

Take the claims that are allowed and, optionally, file a Continuation application for others;

Appeal the rejection to the Patent Office Board of Appeals; or

Quit.

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4. Costs

**Table 1. 2009 - Fees for Small Entities (less than 50 employees, etc.).
Double USPTO fees for large entities.**

Stage	Patent Office Fee	Attorney fees	Drawings
Initial Filing			
Provisional	\$110	\$1,750 -\$4,750	\$320 -\$600
Regular	\$545	\$4,750 -\$6,750 ²	\$320 -\$600
1st Office Action	0	\$875-\$1,500	0
2nd Office Action	0	\$875-\$1,500	0
Continuation	\$545.00	\$375-\$2,500	if needed
Issue Fee	\$755.00		

² Includes filing a provisional application.