General Information Concerning Patents

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Functions of the United States Patent and Trademark Office

The United States Patent and Trademark Office (USPTO or Office) is an agency of the U.S. Department of Commerce. The role of the USPTO is to grant patents for the protection of inventions and to register trademarks. It serves the interest of inventors and businesses with respect to their inventions and corporate products, and service identifications. It also advises and assists the President of the United States, the Secretary of Commerce, the bureaus and offices of the Department of Commerce and other agencies of the government in matters involving all domestic and global aspects of "intellectual property." Through the preservation, classification, and dissemination of patent information, the Office promotes the industrial and technological progress of the nation and strengthens the economy.

In discharging its patent related duties, the USPTO examines applications and grants patents on inventions when applicants are entitled to them; it publishes and disseminates patent information, records assignments of patents, maintains search files of U.S. and foreign patents, and maintains a search room for public use in examining issued patents and records. The Office supplies copies of patents and official records to the public. It provides training to practitioners and their applicants as to requirements of the patent statutes and regulations, and it publishes the Manual of Patent Examining Procedure to elucidate these. Similar functions are performed relating to trademarks. By protecting intellectual endeavors and encouraging technological progress, USPTO seeks to preserve the United States' technological edge, which is key to our current and future competitiveness. The USPTO also disseminates patent and trademark information that promotes an understanding of intellectual property protection and facilitates the development and sharing of new technologies worldwide.

What Are Patents, Trademarks, Servicemarks, and Copyrights?

Some people confuse patents, copyrights, and trademarks. Although there may be some similarities among these kinds of intellectual property protection, they are different and serve different purposes.

What Is a Patent?

A patent for an invention is the grant of a property right to the inventor, issued by the United States Patent and Trademark Office. Generally, the term of a new patent is 20 years from the date on which the application for the patent was filed in the United States or, in special cases, from the date an earlier related application was filed, subject to the payment of maintenance fees. U.S. patent grants are effective only within the United States, U.S. territories, and U.S. possessions. Under certain circumstances, patent term extensions or adjustments may be available.

The right conferred by the patent grant is, in the language of the statute and of the grant itself, "the right to exclude others from making, using, offering for sale, or selling" the invention in the United States or "importing" the invention into the United States. What is granted is not the right to make, use, offer for sale, sell or import, but the right

useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent," subject to the conditions and requirements of the law. The word "process" is defined by law as a process, act or method, and primarily includes industrial or technical processes. The term "machine" used in the statute needs no explanation. The term "manufacture" refers to articles that are made, and includes all manufactured articles. The term "composition of matter" relates to chemical compositions and may include mixtures of ingredients as well as new chemical compounds. These classes of subject matter taken together include practically everything that is made by man and the processes for making the products.

The Atomic Energy Act of 1954 excludes the patenting of inventions useful solely in the utilization of special nuclear material or atomic energy for atomic weapons.

The patent law specifies that the subject matter must be "useful." The term "useful" in this connection refers to the condition that the subject matter has a useful purpose and also includes operativeness, that is, a machine which will not operate to perform the intended purpose would not be called useful, and therefore would not be granted a patent.

Interpretations of the statute by the courts have defined the limits of the field of subject matter that can be patented, thus it has been held that the laws of nature, physical phenomena, and abstract ideas are not patentable subject matter.

A patent cannot be obtained upon a mere idea or suggestion. The patent is granted upon the new machine, manufacture, etc., as has been said, and not upon the idea or suggestion of the new machine. A complete description of the actual machine or other subject matter for which a patent is sought is required.

Novelty And Non-Obviousness, Conditions For Obtaining A Patent

In order for an invention to be patentable it must be new as defined in the patent law, which provides that an invention cannot be patented if: "(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent," or "(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country more than one year prior to the application for patent in the United States . . ."

If the invention has been described in a printed publication anywhere in the world, or if it has been in public use or on sale in this country before the date that the applicant made his/her invention, a patent cannot be obtained. If the invention has been described in a printed publication anywhere, or has been in public use or on sale in this country more than one year before the date on which an application for patent is filed in this country, a patent cannot be obtained. In this connection it is immaterial when the invention was made, or whether the printed publication or public use was by the inventor himself/herself or by someone else. If the inventor describes the invention in a printed publication or uses the invention publicly, or places it on sale, he/she must apply for a patent before one year has gone by, otherwise any right to a patent will be lost. The inventor must file on the date of public use or disclosure, however, in order to preserve patent rights in many foreign countries.

Even if the subject matter sought to be patented is not exactly shown by the prior art, and involves one or more differences over the most nearly similar thing already known, a patent may still be refused if the differences would be obvious. The subject matter

referred to as "patent agents." Both patent attorneys and patent agents are permitted to prepare an application for a patent and conduct the prosecution in the USPTO. Patent agents, however, cannot conduct patent litigation in the courts or perform various services which the local jurisdiction considers as practicing law. For example, a patent agent could not draw up a contract relating to a patent, such as an assignment or a license, if the state in which he/she resides considers drafting contracts as practicing law.

Who May Apply For A Patent

According to the law, only the inventor may apply for a patent, with certain exceptions. If a person who is not the inventor should apply for a patent, the patent, if it were obtained, would be invalid. The person applying in such a case who falsely states that he/she is the inventor would also be subject to criminal penalties. If the inventor is dead, the application may be made by legal representatives, that is, the administrator or executor of the estate. If the inventor is insane, the application for patent may be made by a guardian. If an inventor refuses to apply for a patent or cannot be found, a joint inventor or, if there is no joint inventor available, a person having a proprietary interest in the invention may apply on behalf of the non-signing inventor.

If two or more persons make an invention jointly, they apply for a patent as joint inventors. A person who makes only a financial contribution is not a joint inventor and cannot be joined in the application as an inventor. It is possible to correct an innocent mistake in erroneously omitting an inventor or in erroneously naming a person as an inventor.

Officers and employees of the United States Patent and Trademark Office are prohibited by law from applying for a patent or acquiring, directly or indirectly, except by inheritance or bequest, any patent or any right or interest in any patent.

Frequently-Asked Questions about Patents

1. What do the terms "patent pending" and "patent applied for" mean?

A. They are used by a manufacturer or seller of an article to inform the public that an application for patent on that article is on file in the United States Patent and Trademark Office. The law imposes a fine on those who use these terms falsely to deceive the public.

2. Is there any danger that the USPTO will give others information contained in my application while it is pending?

A. Most patent applications filed on or after November 29, 2000, will be published 18 months after the filing date of the application, or any earlier filing date relied upon under Title 35, United States Code. Otherwise, all patent applications are maintained in the strictest confidence until the patent is issued or the application is published. After the application has been published, however, a member of the public may request a copy of the application file. After the patent is issued, the Office file containing the application and all correspondence leading up to issuance of the patent is made available in the Files Information Unit for inspection by anyone, and copies of these files may be

clients.

9. Will the USPTO advise me as to whether a certain patent promotion organization is reliable and trustworthy?

A. No. The Office has no control over such organizations. The Office will publish complaints regarding invention promoters and replies from the invention promoters. The Office will not undertake any investigation of the invention promoters. Questions or complaints should be directed to the Mail Stop 24; Director of the U.S. Patent and Trademark Office; P.O. Box 1450; Alexandria, VA 22313-1450 or call at (703) 306-5568.

10. Are there any organizations in my area which can tell me how and where I may be able to obtain assistance in developing and marketing my invention?

A. Yes. In your own or neighboring communities you may inquire of such organizations as chambers of commerce and banks. Many communities have locally financed industrial development organizations, that can help you locate manufacturers and individuals who might be interested in promoting your idea.

11. Are there any state government agencies that can help me in developing and marketing of my invention?

A. Yes. In nearly all states there are state planning and development agencies or departments of commerce and industry which seek new product and new process ideas to assist manufacturers and communities in the state. If you do not know the names or addresses of your state organizations you can obtain this information by writing to the governor of your state.

12. Can the USPTO assist me in the developing and marketing of my patent?

A. No. The Office cannot act or advise concerning the business transactions or arrangements that are involved in the development and marketing of an invention. The Office, however, will publish for a fee, at the request of a patent owner, a notice in the Official Gazette that the patent is available for licensing or sale. In addition, the Office of Independent Inventor Programs (OIIP) was established in March 1999 in order to meet the special needs of independent inventors. The OIIP establishes new mechanisms to better disseminate information about the patent and trademark processes and to foster regular communication between the USPTO and independent inventors.