

The Legal Landscape



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Patenting an Invention

Locating and mining oil and gas deposits, and processing the recovered substances is an industrial undertaking that relies on development of new technologies to overcome the many obstacles in today's environment. Finding solutions to these problems often leads to new discoveries, such as a modification or improvement to a tool, a machine, a product, or a piece of equipment; or, it may be a new, simpler or more accurate or efficient method for accomplishing a task or process.

Any of these "discoveries" may be a patentable invention. To be patentable, a useful invention must be novel, something that did not exist before your discovery of it. A second requirement is that the invention cannot be obvious to a person who is skilled in the field of the invention.

Another requirement is that an applicant for a patent is allowed one year to file an application for patent, beginning from the time the invention is first used, sold, offered for sale, or disclosed to another person. The right to file an application is lost at the expiration of the one-year period. Once a patent is granted, it may be enforced for a limited time of up to 20 years from the date the application is filed.

A reasonable question before deciding to seek a patent is: why should a patent be obtained? A patent gives the owner the right to exclude others from using the invention for a limited time in exchange for disclosing the invention to the public. A patent may be a valuable asset of a company, and may be strong evidence of a strong technical position of the company.

Thus, patents can provide a competitive advantage to the company in its business, and can enable a defensive position against the aggressions of a competitor through cross licensing. Patents can also provide royalty income through licensing of the patent rights. If an owner's patent is found to be infringed, damages for infringement can be substantial.

Obtaining a patent is a fairly straightforward process, beginning with a description of the invention and a patentability search for existing patents covering the same or similar inventions. If the search results indicate an invention has not been patented, then a patent application may be prepared and filed in the U. S. Patent and Trademark Office.

A patent application is similar to a technical paper about the invention. It contains a number of drawings that illustrate the essential features of the invention and a detailed written description of those features. The description may describe several embodiments – variations or alternatives – of the invention. The application concludes with a set of claims to the invention. The claims state in legal terms what the invention is. The claims are analogous to the metes and bounds of a deed.

After filing the patent application in the Patent Office it will be scheduled for examination by a trained examiner. The examiner will perform a thorough patent search and send a written report about the findings to the applicant. The applicant must then respond to this "Office Action" in writing. Very often it is necessary to rebut the position taken by the examiner and demonstrate with evidence why the invention is patentable. This activity of the examiner and the applicant is called the prosecution of the application. If the applicant succeeds, which happens more often than not, a patent will be granted, followed by issuing a printed and bound copy of the patent to the applicant.

When a patent is granted, it is the responsibility of the applicant, owner or licensee – whoever is using the claimed invention – to mark the product, or product made by the patented process, with the patent number or a legend such as "Patented." This marking notifies the public that the invention is protected by a patent. Such notice is required to obtain damages for infringement.

Applying for a patent is a complex procedural undertaking, which may involve substantial technical issues. Therefore, it is recommended that an applicant seek the services of a registered patent attorney or patent agent. Such a person must have an engineering or science education, be trained in the patent law and Patent Office procedures, and has demonstrated his or her competence by passing a rigorous examination to practice in the U. S. Patent and Trademark Office. ★

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