Holiday-Inspired Inventing

By:Sean D. Detweiler
December 20, 2023

As we find ourselves in the midst of the holiday season, some may be taking a break from the stresses of daily life, disconnecting from your electronic devices, and maybe finding a comfy chair to relax in for a few minutes with only your thoughts and a cup of eggnog. It is often at these times, when you can quiet your mind, that inspiration hits – and then you have the idea for the world's next best (insert your invention here). These inspirations tend to happen a lot this time of year as routines are disrupted, and in December and January my inbox fills with inventors that "just have a few questions about patenting" their newly created invention. For those of you fortunate enough to experience these moments of inspiration, here is some basic information you may find useful.

Question 1 – What do I need? A patent, trademark, copyright, etc.?

First, a quick primer on intellectual property. The field of intellectual property includes patents, trademarks, copyrights, and trade secrets, which together form the four major areas of intellectual property protection. Before I continue with patents, which is the mechanism for protecting your invention, here is a quick summary of the other three areas that do not pertain to inventions. A trademark is a word, phrase, symbol, or design, as well as a sound, shape, color, scent or taste that is used in conjunction with, and to identify the source of, goods or services in the marketplace (e.g., brand names and logos, like Coca-Cola® or Uber®). A copyright is granted by law for original works of authorship fixed in a tangible medium of expression, whether officially published or not. Example works of authorship include (but are not limited to) literary, dramatic, musical, and artistic works, including books, poetry, movies, songs, computer software, architecture, and the like. Finally, trade secrets generally include formulas, patterns, devices, ideas, processes, lists, or other tangible or intangible information that provides the owner of that information with a competitive advantage in the marketplace and is treated in a confidential way that can reasonably be expected to prevent the public or competitors from learning about the trade secret, absent improper acquisition or theft.

A patent provides an inventor with the right to exclude others from making, using, offering for sale, or selling the invention for a predetermined time period. There are different types of patents. Non-provisional or utility patents (both phrases are interchangeable) are directed to new and useful processes, machines, articles of manufacture, compositions of matter, or any new, useful, and nonobvious improvement thereof. Provisional patent applications can be filed as a precursor to a regular non-provisional/utility patent application and are often less expensive because they have fewer formalities and requirements. Design patents are directed to new, original, and ornamental designs for an article of manufacture (e.g., a design for a hat or a sneaker). For patent applications filed now, the maximum term if granted as a patent is 20 years from the date of filing. A granted design patent has a total term of 15 years from the date of grant.

Examples of inventions protectable by a non-provisional/utility patent include kitchen gadgets, medical devices, tools, methods of making or using something, certain computer software,

pharmaceuticals, manmade materials, or the like, that are not naturally occurring. Examples of inventions protectable by a design patent include non-functional shapes of products, ornamental design features of products, or the like.

Question 2 – Why do I need a patent and what can I do once I get one?

Patents are useful in many ways. Once you filed a provisional or non-provisional patent application, you can put "Patent Pending" on your product, packaging, marketing materials, etc. Such notice can often scare off would-be competitors from copying your invention. Once you have a granted patent, you are protected from competitors copying the patented aspects of your goods or services because you can sue a competitor for patent infringement to prevent them from making, using, selling, or importing the infringing product. A patent is an asset. You can license patent rights to third parties (exclusive or non-exclusive patent licenses are possible). You can assign your patent to third parties (which would typically occur if you are selling your patent rights). You can list your patent(s) as assets owned by your company and there are various ways to assign value to your patents. Most often, value is more easily identified if the patent is licensed and there is a resulting royalty stream.

Question 3 – Is my (insert your invention here) patentable?

Inventors often want to know whether their idea is patentable, and most often the answer is not clear-cut. When you file a non-provisional patent application at the United States Patent Office, the patent examiner will review the application and search for other inventions that came before yours. This is called a prior art search, where the examiner looks mostly for prior art patents, or sometimes other evidence of products, that describe or embody your invention. If they find prior art that describes or embodies your invention, and you (and your patent attorney) can provide arguments to distinguish your invention and persuade the examiner it is novel and nonobvious in view of the prior art, then the examiner will allow the patent to grant.

One often highly informative step you can take before reaching out to a patent attorney and beginning the patenting process is to do some of your own research on patent prior art. A popular website for conducting these searches is https://patents.google.com/. On this site you can enter keywords relating to your invention and the results that come back will be various forms of patents and published patent applications, all of which could be considered as prior art. If you find your exact invention described in one of these other prior art references, then it is likely not patentable. However, if you find references that are close but do not teach or describe all the innovative aspects of your idea, then maybe you have something. You should then take your invention and the closest prior art references you've found to a patent attorney to discuss whether there is a path forward to obtaining a granted patent. It is often a gray area that may require expert analysis to know for sure, but an experienced patent attorney should have a good sense.

Question 4 – How long does it take and how much does it cost to get a patent?

The entire process can take 2 to 4 years on average but can be accelerated using a couple of different methods, some of which involve paying an additional fee to the USPTO to accelerate the timeline. The total cost of obtaining a patent can range from $25,000 to $40,000 in some instances, on average. The good news is that these costs are typically spread out over the 2 to 4-year period. The initial cost of preparing and filing patent applications is directly tied to how complicated the invention is, how much effort it takes to fully describe and depict it, and what field of technology it is in, but can range on average between $5,000 and $15,000. The additional costs that may occur relate to how much your patent attorney has to argue back and forth with the patent examiner to persuade the examiner that the invention as claimed in the patent application is patentable, and then payment of the issue fee to the USPTO once the application is deemed allowable.

Question 5 – Once I file a patent application, what should I do next?

The answer to this question is one of the more important takeaways here. Once you file your

patent application, the hard work begins. You should start implementing your business plan to take your idea from concept to reality as quickly as possible! If your plan is to manufacture and distribute a product incorporating your invention, then get to work on brainstorming ideas for a new brand for your product. Once you have a few ideas, complete a search to identify whether the trademark/brand is registrable. If it is, then that's the next application you should consider filing. If you plan to license or sell your invention to an existing company, then work your network to find contacts in companies that may be interested. Time is of the essence

Get ready for inspiration!

With the above questions answered, you are now in a better position to invent. Find yourself a contemplative or inspirational setting, quiet your mind, relax, and see what ideas spring up. If they seem worth pursuing, do some of the initial research to see if someone else has invented it before you. If it looks like your idea is novel, nonobvious, and not found in the prior art based on your research, then seek out a good patent attorney to help you through the patenting process. Most will be happy to provide you with a 30-minute consultation to discuss your invention, what you found in the prior art, and your patenting goals. If you have some ideas around a new trademark as well, mention that to the patent attorney. They might also practice trademark law, or they will know someone who does. If you do get yourself ready for inspiration to hit, but nothing comes to mind worth pursuing, at least you will have had some time to yourself to relax – so either way you come out ahead! Happy Holidays.

For more information about patenting, please contact Sean Detweiler.