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A Guide to Patenting Your Invention

Choosing the right patent to protect your idea

- ***Why Patent Your Invention?***
- ***Types of Patents***
- ***Your Rights as a Patent Owner***
- ***Conducting a Prior Art Search***
- ***Tackling the Patent Application Process***

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Founder of LegalZoom

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AN INTRODUCTION TO PATENTS

So you've just created the next big thing. Congratulations! But before you make another move, you need to consider how you're going to protect your winning idea. Filing for a patent is one of best ways to secure the rights to your invention. And LegalZoom can help you do it quickly, easily, and for a fraction of what it would cost to hire an attorney.

LegalZoom's *Guide to Patenting Your Invention* offers a quick and easy overview of the patent process, including the different types of patents and their requirements. After you've had a chance to review your complimentary guide, be sure to visit www.legalzoom.com to get started with your **Provisional Application for Patent** or your **Design Patent Application**. Simply answer a few straightforward questions and LegalZoom's specialists will take care of the rest—including filing your completed application with the US Patent and Trademark Office. We can even conduct an existing patent search and assist with your technical drawings.

To get started, go to www.legalzoom.com. Our simple 3–step process is fast, affordable—and most importantly—**secure**.

Still have questions? Feel free to speak to one of our friendly and knowledgeable patent specialists at **(888) 791-0227** Monday through Friday 8:00am to 5:00 pm (PST).

PATENT, COPYRIGHT OR TRADEMARK— HOW TO CHOOSE?

LegalZoom has provided the following intellectual property chart as a helpful resource. In some cases, only one type of intellectual property protection is possible. In other cases, multiple types may be appropriate.

Your Idea	Provisional Application for Patent[1]	Utility Patent	Design Patent	Copyright Registration	Trademark Registration
An invention with a function *(such as a machine, manufactured item, a process, or a chemical composition)*	✓	✓			
A work you authored *(such as a play, novel, song, sculpture, photograph, choreography, or architectural plan.)*				✓	
An ornamental design for a manufactured item, that doesn't affect its function *(such as a watch face plate)*			✓		
A way to identify goods or services in the form of an image or words(s) *(such as a logo or a brand name)*					✓

[1] A Provisional Application for Patent is an optional "first step" for a Utility Patent. Provisional Applications offer the applicant a year of "patent pending status." Also, a Provisional Application allows you to immediately secure your filing date while preparing your full Utility Patent Application. Filing for a Provisional Application with LegalZoom.com makes the process fast and easy.

AT–A–GLANCE COMPARISON CHART

Patents, Copyrights and Trademarks offer different levels of protection and are managed by different federal agencies. To better understand these differences, see our quick reference chart below.

Feature	Provisional Application for Patent	Utility Patent	Design Patent	Copyright Registration	Trademark Registration
Which federal office issues this protection?	U.S. Patent & Trademark Office	U.S. Patent & Trademark Office	U.S. Patent & Trademark Office	U.S. Copyright Office	U.S. Patent & Trademark Office
How long does the benefit/ protection last?	1 year	20 years	14 years	Life of author plus 70 years[2]	10 years[3]
Where is this protection valid and enforceable?	Within the U.S.	Within the U.S.	Within the U.S.	Within the U.S.	Within the U.S.
Are maintenance fees required?	No	Yes	No	No	No[4]
Can I renew?	No	No[5]	No	No	Yes
If I don't file an application, do I still have ownership rights?	No	No	No	Yes	Yes
What type of application is required?	Provisional Application	Non–provisional Application	Design Patent Application	Copyright Registration Application	Trademark Application
Who may apply?	Inventor(s)	Inventor(s)	Inventor(s)	Author(s)	Owner(s)[6]

[2] Term may differ for works made for hire or works published before 1978.
[3] Registrations granted prior to Nov. 16, 1989 have an initial 20–year term which can be renewed in 10–year periods.
[4] No maintenance fees are required for trademarks. However, renewals require a fee.
[5] Extension of term may exist for certain products and methods that require federal regulatory review.
[6] Generally, the person who uses or controls the use of the mark, and controls the nature and quality of the mark's associated goods or services is considered the owner.

WHY PATENT YOUR INVENTION

A Hard Lesson from History

On February 14, 1876, Alexander Graham Bell applied for a patent on an apparatus that could transmit speech electrically, beating out his rival, Elisha Gray, by just two hours. Never mind that Gray's design worked better. Timing was all that mattered. When Gray later filed a lawsuit, the courts awarded the patent to Bell, who went down in history as the official inventor of the telephone.

So what's the moral of the story? If you have bright idea—even one without immediate commercial value—don't wait for someone else to figure it out and cash in first. By failing to secure the rights to your idea, you run the risk of having your invention slip into the "public domain." And once that happens, there is very little you can do to prevent others from manufacturing, selling and otherwise capitalizing on your innovation. Take a lesson from history and protect your idea as soon as possible.

"If you have bright idea—even one without immediate commercial value—don't wait for someone else to figure it out and cash in first."

What exactly are a patent owner's rights?

As a patent owner, you can control the way your invention is both used and made. For example, if you patent a new type of radio technology, you could prevent others from using or selling any radio prototypes that you've built. You could also prevent others from manufacturing radios that incorporate your patented technology (without your permission, of course). You can even prevent others from importing your patented item into the country without your permission. In essence, you have *complete control* over the technology, design, or plant claimed in your patent. Because patents provide a temporary monopoly on a particular technology, the US Patent and Trademark Office (USPTO) reviews patent applications with a high level of scrutiny.

What can an inventor do with a patent once it has been granted?

Patents are considered a form of personal property. Just like other kinds of property, patent rights can be co–owned, assigned, sold, licensed (exclusively or non–exclusively), or inherited. Most importantly, patents can be used as the legal basis for stopping others from infringing on your intellectual property rights. This can be accomplished either by formal request or by suing in federal court.

Types of Patents

There are several types of patents recognized under United States law, each of which grants you a specific type of benefit or protection. These are:

- **Provisional Application for Patent:** an optional first step to a Utility Patent, Provisional Applications grant an immediate priority filing date and "patent pending" status for 12 full months before an inventor files a full patent application.
- **Utility patents:** may be granted on any new or improved, useful and non–obvious machine, manufactured article, process or composition of matter
- **Design patents:** may be granted on any new, original and ornamental design for a manufactured article
- **Plant patents:** may be granted on any new and distinct variety of plant that can be asexually reproduced

Although it's possible to qualify for more than one type of patent, most inventions only qualify for one. LegalZoom offers Provisional Applications for Patent, and Design Patents.

PROVISIONAL APPLICATION FOR PATENT

A Provisional Application for Patent is a quick and affordable solution for inventors who plan to file a Utility Patent (see more on Utility Patents below). Often described as an optional "first step" in the patent process, a Provisional Application for Patent allows you to claim an immediate filing date for your invention. Once filed, your Provisional Application is good for **12 full months.**

Securing a priority filing date is critical because as far as the government is concerned, ownership rights go to the person who can *prove* he or she came up with the idea first. Your priority filing date serves as official evidence against anyone who attempts to stake a claim to your invention during your 12–month provisional period.

Many inventors use this time to assess their idea's commercial value, secure funding, or continue the patent process by filing a Non–Provisional Patent Application. The low cost and speed of a Provisional Application make it an ideal solution for inventors who still want to evaluate their idea's market potential before spending years and thousands of dollars on the patent process. A Provisional Application also legally entitles inventors to the label "patent pending," which can be helpful in warding off would–be imitators.

So why else should you consider this optional step? Apart from speed and cost, the main benefit of a Provisional Application is that it's much easier to file. While a Non–Provisional Patent Application undergoes a rigorous approval process, a Provisional Application is automatically accepted. That's because its primary function is simply to record that you've laid *claim* to your idea by a certain filing date. Think of it as a legal placeholder in the patent process. If you ultimately decide it's not worth the trouble and expense to patent your invention, you can simply choose to let your Provisional Application expire.

"Filing a provisional application for patent is fast, easy and affordable."

Key Features of the Provisional Application for Patent

- **Official Priority Filing Date:** A filing date can be used as evidence in the event of an ownership dispute (the earlier filing date, the better)
- **Immediate "Patent Pending" Status:** Because the Provisional Application for Patent is a type of patent application, your invention can be marketed as "patent pending" while the application is in effect.
- **Earlier Priority Filing:** If you file a Non–Provisional Patent Application before your Provisional Application expires, your application (and any eventual patent) will retain the earlier Provisional Application priority filing date.
- **Less Expensive Filing Fees:** A Provisional Application costs significantly less to file.
- **Fewer Application Requirements:** The Provisional Application has fewer required sections than a Non–Provisional Application. Most notably, a Provisional Application does not require a Claims section or a prior art search.
- **Patent Term Extension:** If your Non–Provisional Application references an earlier Provisional Application filing date, your patent term could potentially be extended up to 12 additional months.
- **No Lengthy Review:** The Patent Office will accept a Provisional Application as long as it contains all the required sections and fees. You do not have to wait for an acceptance or rejection decision at this stage. Your invention becomes "patent pending" immediately. A formal review process only begins when you file a corresponding Non–Provisional Application.
- **Privacy:** Unlike Non–Provisional Applications, a Provisional Application for Patent is not subject to an 18 month publication rule. You can keep the details of your Provisional Application confidential.

Scope of the Provisional Application for Patent

If you eventually decide to complete the patent process and want to take advantage of your earlier Provisional Application filing date, the subject matter in your Non–Provisional Application must be adequately supported by your Provisional Application. In other words, it must be clear to the USPTO that both applications are referencing the same invention. Should there be a significant disparity between the two descriptions, the USPTO may decide that your provisional and non–provisional applications describe two *different* inventions. If this happens, you may lose your claim to the earlier filing date.

Note: While a Non–Provisional Application must detail the background of the field of invention, how the field is improved by your invention, and the similarities and differences between your invention and other patented or published technology (prior art), a Provisional Application need only describe what your invention is and how it is made and used.

"A Provisional Application need only describe what your invention is and how it is made and used."

Tackling the Provisional Application for Patent

A Provisional Application for Patent requires the following information:

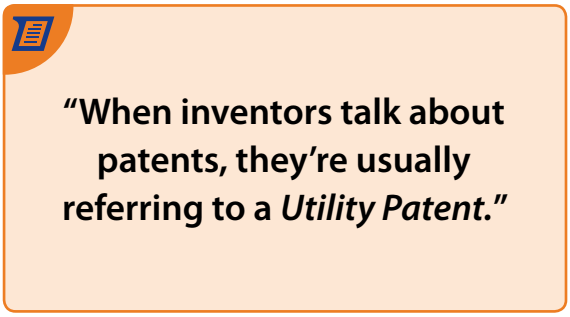
- Invention Title
- Description
- Abstract
- Drawings (any drawings necessary for understanding how to make or use the invention)

Filing a Provisional Application for Patent through LegalZoom is easy and inexpensive. We can also conduct a Comprehensive Patent Search (a custom report that details all relevant prior art in your field of invention) and even assist you with your technical drawings. Learn about our simple, 3-step Provisional Application process at www.LegalZoom.com.

UTILITY PATENTS

Is Your Creation Eligible?

When inventors talk about patents, they're usually referring to a *Utility Patent*. This is because utility patents cover the most common categories of innovation – (1) machines, (2) manufactured articles, (3) processes or methods and (4) compositions of matter. As the name suggests, utility patents are awarded to inventions that produce some sort of result (as opposed to design patents, which protect purely artistic or ornamental designs).



Does your Invention Quality for a Utility Patent?

For your invention to qualify for utility patent protection, it must fall into one of the following categories of *subject matter*:

- Machines, which are generally composed of moving parts (like a clock or an engine)
- Articles of Manufacture, which generally resemble objects (such as hand tools)
- Processes, which are stepwise methods (including software and methods of doing business)
- Compositions of Matter, which include compounds and mixtures (such as man–made proteins and pharmaceuticals)

In addition to appropriate subject matter, an invention must have:

- Novelty (it cannot have been invented by someone else prior to your application filing date)
- Utility (it must accomplish some useful result)
- Non–obviousness (by "obvious," the US Patent & Trademark Office means "obvious to one skilled in the art." In other words, if your invention can easily be assembled by someone with experience in the field by combining any known components, your application may be denied.)

A Word About Prior Art

Most new inventions are developed using some measure of preexisting technology or information. Properly referencing this information is critical to the application process. In the patent world, "prior art" is the term used to describe any information that exists in the public domain *prior* to the date of invention or more than one year before your patent application date. It includes previously issued patents, publications, models that have been built and tested, and general knowledge within the field of invention. Prior art plays a key role in determining whether or not your invention is ultimately patentable.

LegalZoom's Comprehensive Patent Search includes a custom report that details all relevant prior art in your field of invention. For more information or to order your Comprehensive Patent Search, please speak to one of LegalZoom's patent specialists at (888) 791-0227.

Tackling the Utility Patent Application

The USPTO requires that your application be written in "full, clear, concise and exact terms" so that it may be understood by someone *with a background in the field of your invention*. This typically means you must prepare the necessary documents with a certain degree of technical specificity and, if needed, attach accompanying illustrations. For this reason, first–time inventors or inventors without strong composition and drafting skills will often refer this work to a patent attorney. Yet apart from the Claims section (in which particular words and phrasings hold specific meaning within patent law), common language is perfectly acceptable when preparing your application. As long as you have adequate knowledge of the field of your invention and reasonable research and writing skills, you may be able to draft your own patent application.

The utility patent application, also known as a "Non–Provisional Application" (NPA), contains several required sections:

- **Specification, contains subsections to include:**
  - Title of the invention (in 500 characters or less)
  - Sequence Listing (biotech or computer programs)
  - Background or Field of the Invention
    - Explanation of problems that the invention solves
    - List of the invention's benefits
  - Drawings
    - Description, including reference numerals if any
  - Detailed Description of the Invention
    - Description of the best mode or preferred embodiment of the invention, as well as alternative ones, and the invention's scope
- **Claim(s):** The specific phrasing that states what the invention is and the extent of its scope. This section must be carefully drafted because it serves as a source of reference for conducting a prior art search and/or filing an infringement suit.

- **Abstract:** A short summary of the Specification.
- **Information Disclosure Statement (a separate document submitted with the application):** A list of what the applicant considers to be the "prior art" of the invention (see section on prior art above). These references are instrumental in helping the USPTO determine whether your invention meets the most challenging requirement for a utility patent—non–obviousness. Note: The USPTO will conduct its own prior art search and check it against yours.

The Review Process

It typically takes 1 to 3 years for the US Patent and Trademark Office to fully review a utility patent application. This includes the USPTO's prior art search and all correspondence between the USPTO examiner and either you or your attorney regarding any necessary revisions to the application. As mentioned earlier, this level of scrutiny is required to ensure that the government does not award a monopoly to a non–innovation. While your application is being reviewed, you are free to market your invention as "patent pending." If your application is eventually approved, the USPTO will send a Notice of Allowance and Fee(s) Due, which must be paid within 3 months.

Utility Patent Term and Maintenance

On newly filed applications, the patent term typically lasts 20 years from the application filing date. However, if you previously filed a Provisional Application for Patent (see Provisional Application for Patent section below), you could potentially increase this term up to one year. To keep your patent in force, fees are due 3.5, 7.5 and 11.5 years after the patent grant date. Once the patent term expires, your invention becomes part of the public domain.

Going it Alone

Preparing your own Non–Provisional Patent application is no easy task. But the USPTO does allow it, and many inventors do so each year. In fact, the market is crowded with "patent–it–yourself" resources for those inventors willing to put in the requisite time and effort. But before you head off to the bookstore, bear in mind that the USPTO has created the Provisional Application for Patent as an easy and inexpensive option for inventors who'd like more time to make minor refinements, test, or even market their invention *before* filing a Non–Provisional Application. It's called a Provisional Application for Patent (see section on **Provisional Application for Patent** above). LegalZoom can help you prepare and file a Provisional Application for Patent in 3 easy steps.

"Preparing your own Non-Provisional Patent application is no easy task. But the USPTO does allow it, and many inventors do so each year."

Click here ***to visit LegalZoom.com or call 888-791-0227 to speak with a live representative***

DESIGN PATENTS

Design patents protect new and non–obvious ornamental design for manufactured articles. Unlike utility patents, design patents protect only the appearance of an article rather than its structural or functional characteristics. This means they have a much narrower scope of protection than utility patents. The innovation recognized and protected in this type of patent relates specifically to surface design or artwork, as opposed to utilitarian technology. Ineligible design patent subject matter includes unoriginal design (e.g. design modeled on naturally–occurring or well–known objects or people) and material considered offensive to any race, ethnicity, religion or nationality.

Design Patents vs. Copyrights

Design patents are used to protect the design of a manufactured article, such as the ornamental configuration of a music box. Copyrights are used to protect most types of visual, literary, performing and auditory works. These include books, sculptures, photographs, films, sound recordings, paintings and architectural plans. The key difference is that the artistry protected by a design patent typically accompanies a manufactured item, whereas the artistic expression protected by a copyright typically stands alone as a creative work. In rare cases, the ornamental design of a manufactured article will contain enough originality to qualify for both design patent and copyright protection.

Deciding between Utility and Design Patent Protection

Utility patents protect the way an article is made and used. Design patents protect how the article appears. A manufactured article that contains both utility and ornamental design could conceivably apply for both forms of patent protection. Generally, if the design of the article is informed primarily by its function—that is, the invention cannot work the same way if it features a different design—then it will most likely qualify for a utility patent rather than a design patent (assuming all utility patent qualifications are met).

For example, a design patent application would claim a chair's particular aesthetic appearance, while a utility application would typically claim the technology of the chair itself (e.g. all devices built with up to 4 legs, a seat of varying size, with or without a chair back, to be used for the purpose of support).

Tackling the Design Patent Application

The design patent's relatively limited scope results in a much simpler application process. It also rules out a Provisional Application as an option. You simply have to apply (non–provisionally) with a Design Patent Application from the start. Your completed application must contain clear drawings with a sufficient number of views to demonstrate the appearance of your claimed design. If relevant, you should also disclose any prior art references used in the design.

LegalZoom makes it easy and affordable to obtain a full Design Patent. Simply answer a few questions online, provide us with sketches or photos, and we'll take care of the rest. LegalZoom also offers Professional Illustration Services for inventors to fulfill the "drawings" requirement of Design Patent Application. Illustration customers receive up to 7 professionally rendered technical drawings detailing their invention.

Need help searching for prior art? Ask us to conduct a Comprehensive Patent Search. This Search can help you determine whether or not your invention is truly new, and also provide the required prior art references for your Design Patent Application. Customized results include all relevant prior art in your field of invention. Visit LegalZoom's Patent section for more information, www.LegalZoom.com.

Key Features of the Design Patent

- **Preamble:** includes the title and intended use of the design
- **A Single Claim:** composed in standard sentence format
- **Drawings:** (without reference numbers) or photographs
- **Short Specification:** includes a description of the drawing figure(s) and features
- **14–Year Patent Term:** begins on the patent grant date
- **Unlimited Renewal:** with an option to keep the patent in force indefinitely

PLANT PATENTS

Plant patents are far less common than either utility or design patents. They are designed specifically to protect newly discovered or invented varieties of plants that can be asexually reproduced.

Key Features of the Plant Patent

- **A Two–Part Definition:** (1) discovery or selection step and (2) asexual reproduction step
- **Plurality of Inventors:** An inventor can be any person (including staff members) who contributed to either step of the two–part definition (see above)
- **20–Year Patent Term:** begins on the date of the grant

- **Exclusive Propagation Rights:** You have the right to prevent others from asexually reproducing, selling or using your patented plant.
- **Single Plant, Single Patent:** A plant patent is limited to one plant or genome. A sport or mutant of a claimed plant can be separately patented.

Tackling the Plant Patent Application

A Plant Patent Application includes many of the same requirements as a Non–Provisional Utility Patent Application. The general sections include:

- Title of the invention
- Latin name of the genus and species of the claimed plant
- Variety denomination
- Background of the invention, including the field and relevant prior art
- Summary of the invention
- Brief description of the drawing
- Detailed and reasonably complete botanical description of the plant
- A single claim
- Abstract

Generally speaking, few inventors attempt to file a Plant Patent on their own. If you're interested in patenting a new variety of plant, it's best to seek the assistance of an attorney who specializes in this area of patent law.

QUESTIONS?

Call us toll free at (888)791-0227.

Great ideas happen every day. But an idea is only as good as your ability to protect it.

Securing the rights to your original idea doesn't have to be complicated or costly. LegalZoom's complete patent services make protecting your invention easy and affordable. Our specialists can help you perform a prior art search, prepare and file your application with the US Patent and Trademark Office—even assist you with your technical drawings. Just give us the details. We'll take care of the rest.

To get started, visit www.legalzoom.com or simply call us at **(888) 791-0227**. Our customer service professionals are available to help you Monday through Friday 8:00 am to 5:00 pm (PST).

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