

# Proving, Protecting and Policing The Patented Invention

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## OVERVIEW

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- Genesis of Invention
- Invention Records
- Patent Acquisition & Enforcement Timeline
- The Patent Application & Patenting Process (Patent Pendency)
- Common Myths

# GENESIS OF INVENTION

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- Recognize The Problem
- Conceive A Solution
- Try Alternative Approaches
- Document Them
- Protect, Enforce, License

# INVENTION RECORDS

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- In Writing
- Signed & Dated
- Corroborated
- By A Non-Inventor
- Who Understood
- Bound Notebook (Preferred)
- Computer-Based, but Beware

## WHY BOTHER?

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- Who's The Inventor(s)?
- Proof Of Invention
- Priority Awarded To First To Invent
- May Seem Unimportant At The Time
- \$\$\$ At Stake If Commercially Significant

## PATENT TIMELINES (APPROX)

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- 0 -- Invention Disclosed to Patent Attorney
- 3 wks -- Patent Search Results Reported To Inventor
- 4 wks -- Inventor Supplements Invention Disclosure
- 6 wks -- Patent Application Filed -- Begins PATENT PENDING
- 6-8 mos -- 1st Office Action Mailed By Examiner
- 8-10 mos -- 1st Amendment Mailed by Patent Attorney

## **PATENT TIMELINES (CONT'D)**

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- 10-11 mos -- 2D Office Action Mailed
- 11-13 mos -- Final Office Action
- 13-15 mos -- Response To Final
- 15 mos -- Notice Of Allowance or Rejections Maintained
- 17-19 mos -- Patent Issuance Or Abandonment
- 3 yrs -- Infringement Suit, Appeal, \$\$\$

## **PARTS OF A PATENT APPLICATION**

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- Title; Field Of Invention & Background Art; Abstract
- Summary Of Invention
- Brief Description Of Best Mode(s)
- Claims
- Oath & Duty of Candor

## **CLAIM DRAFTING & STRATEGY**

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- Claim Types: Product; Machine; Process; Chemical Composition; Improvements
- Examples: Independent, Dependent; “Means For. . .”
- Varying Scope -- Broad To Narrow (Picture Claim)

## **HOW TO WOO & WIN THE EXAMINER**

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- Where’s He Coming From?
  - ▶ Novelty, Utility, Non-obviousness
  - Written Description Requirement
  - Insufficient Detail To Make & Use; Clear & Concise, Exact Terms; Best Mode
  - Support In The Specification
  - Distinctly Claim
- Interview Him/Her
  - ▶ Telephone, Videoconference, In Person, Demonstrate Non-obviousness
- Written Argument & Amendment

# COMMON MISCONCEPTIONS (MYTHS)

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- A Self-Addressed Letter Is Going To Win The Day
- Notarization Lends Authenticity & Credibility
- A Provisional Application Is All I Need
- My Patent Attorney Is Smart Enough To Understand Without My Telling Him All. . . (Not)

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