

SO YOU THINK YOU HAVE A PATENTABLE IDEA – NOW WHAT?

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An idea for a new and useful product has been looming in your thoughts for quite some time. Perhaps you have doodled some drawings showing how the product works. Perhaps you have even built a working model. Better still, you have perfected your working model and have given thought as to how you are going to manufacture the product, market it, and build a successful business based upon that product. If you haven't already, now is probably a good time to consult with a professional or two. Perhaps it is time to give serious thought to patentability and possible patent protection of that idea to stave off potential competitors.

The First Test of Patentability: Is Your Idea New?

You first need to determine whether or not your idea is really and truly a new, or “novel,” one. This “novelty” test is one of three tests by which patentability is determined for any idea or product, the other two being “usefulness” and “obviousness” (more on those later).

You can actually conduct your own “novelty” search by accessing databases that are available to the general public on the internet and that are user friendly. The most popular of these is the official website of the United States Patent and Trademark Office (the “Patent Office”) at www.uspto.gov. If you are fortunate enough to live in or near a city which is one of your state's repositories for records of the Patent Office, you may also look to your local library. A friendly librarian in the technical references section of that local library will be very willing to assist you in conducting a “quick and dirty” patent search.

If you are not satisfied with the results of your searching, if you do not have the time or inclination to begin with, or if you are just not comfortable doing any of this yourself, you can contact a patent attorney (also known as an “intellectual property” or “IP” attorney). He or she will be able to assist you in determining whether or not your search should be expanded and, based upon the results of that expanded search, whether or not your idea is worth pursuing further.

The Second Test: Is Your Idea Useful?

Assuming that you have gotten past the issue of whether or not the idea is new, you then face the question of whether or not the product is useful. I have yet to see a product which was not in some form or other useful. Virtually every product and every idea has some use for it by someone. After all, that is probably why you came up with your idea in the first place. You saw a need for a better way to do something and you came up with the product to accomplish that.

The Third Test: Is Your Idea Obvious?

The real gray area comes with the third patentability test, obviousness. Whether or not it would have been obvious to someone skilled in the art to come up with your idea is a very difficult concept for most people to understand. This is another area where the skill and knowledge of the patent attorney comes into play. While the patent attorney may not have a “crystal ball” view of the matter, he or she should be able to provide you with some very helpful, and much needed, guidance as to this test. It is this “obviousness” test upon which the patentability of most new ideas or products hinge. It is also the test that the Patent Office applies most regularly in rejecting the patentability of an idea or product which is disclosed in a patent application.

Bringing Your Idea to Market

You have determined that your idea is new, useful, and not obvious. Now you need to decide whether or not you have the financial wherewithal to produce the product and market it on your own, or whether you simply want to sell the idea to a company so that it can take over your idea from this point forward. Very few entrepreneurs have the financial wherewithal to make and sell a product. It takes substantial resources and determination to accomplish that. If you are not already a manufacturer which has a product line and a distribution network in place, this may be an extremely difficult and time-consuming task for you. It may also test your mettle to see how far you can get in the process on your own. Having put this much time and effort into your project, you will want to seriously consider patenting the idea or product so that no other person or entity can make, use or sell it in this or some other country.

If you do not want to pursue the substantial investment in time and effort that it takes to bring the idea or product to market, you may simply want to apply for patent protection so that you have some credibility when you solicit a company to buy your idea from you. In my experience, most companies worth talking to probably won't talk to you or even consider your idea unless you are able to convince them that you have “patent pending”

status with respect to your idea. This status eliminates all doubt from the viewpoint of the company as to what exactly it is that you have come up with.

Another option has become available to inventors in recent years is any number of invention “incubators” that have popped up across the country. Your patent attorney should be able to put you in touch with a reputable organization in that regard. Quite typically, the incubator will assist the inventor with financial as well as technical issues, including putting a team together for bringing the product to market.

Which Form of Patent Application Should You Consider?

There are two principal types of patent applications that can be filed with respect to your idea – a full blown utility application or a provisional application. What are the differences between the two?

- ***A full blown “utility” patent application***
The patent attorney prepares a specification, which is a detailed description of your idea, and claims, which define the legal scope of protection afforded by the patent application. I always tell my clients that owning a patent is very much like owning real estate and the patent claims are the equivalent of the legal description of the real estate. Ownership of that real estate gives you the right to use and enjoy the real estate as you see fit. More importantly, it gives you, the owner, the right to keep others off of it. So, too, with a patent.
- ***A “provisional” patent application.***
This is a fairly new concept to the Patent Office, but one that is very practical in the right situation. The provisional application includes the specification portion of the utility application, but does not require the filing of any claims. The provisional application is not examined by the Patent Office and, if not converted to a full-blown utility application before then, lapses one year after filing. During that one year period, however, you can use the notation “patent pending” with your product.

The real advantage of the provisional application is that it allows you to test the market without spending as much as you would have had you prepared and filed a utility application at the outset. The disadvantage is that you must convert the provisional application to a utility application prior to the end of the one year period in order to keep the application alive.

What an IP Attorney Can Do For You:

- Arrange to have a patent search conducted.
- Render an opinion as to the “novelty” of your idea.
- Prepare and file a patent application.
- Prosecute the patent application before the United States Patent and Trademark Office.

While this is a much simplified overview of the patent process as it relates to a new product, keeping these concepts in mind can get you off to a great start.

Now What?

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