



OVERVIEW OF THE PATENT PROCESS

Requirements, Timing and Cost Estimates

The following is a brief, general overview of the patenting process. Each step precedes the next and we always consult with the inventor before proceeding to the next step.

I. Evaluation

We initially will evaluate whether the invention may qualify for patent protection. The following are what may be patentable: compositions, (e.g., drugs, molecules, formulations, etc.), articles of manufacture (e.g., devices, apparatus, computers, machines, toys, etc.), methods (software, processes for making things, methods of doing business, etc.) and nonfunctional designs.

Certain types of things are normally not able to be patented, such as, food recipes, nonfunctional clothing, naturally occurring substances, pure abstract ideas, etc. There are exceptions to this.

In the United States one can obtain a patent if the invention is: (1) *new* (meaning, not done before), and (2) *useful*, and (3) *nonobvious* (meaning, different enough from what has been done before). In the United States, we can file a patent application unless, more than one year prior to filing: (1) the invention has been publicly disclosed, or (2) offered for sale, or (3) in commercial use, or (4) the subject of a printed publication. Outside of the United States, many countries disallow patenting any invention for which any of the above four events occurring any time prior to filing (i.e., you do not get a year grace period).

We will make an initial assessment, based on the facts you provide us, whether the invention might qualify for protection. If the initial evaluation is favorable, the next step is the patentability search.

II. The Patentability Search

The purpose of the patentability search is to determine the likelihood of an invention being allowed in the United States Patent Office. A patent may not be obtained for an invention that is disclosed by existing patents or other documents. A search is not required, but is usually recommended. As part of this process, we will:

- have a patentability search performed based on the description you provide to us to identify existing patents that may have disclosed your invention or an invention that is sufficiently close as to prevent your obtaining protection,
- analyze the results of the search, and
- provide our evaluation on the likelihood of being able to obtain a patent.

The cost of a search for a basic mechanical invention is usually in the range of about \$1,300-1,700, depending on the complexity of the invention and the patents found from the search. The search for more complex mechanical inventions is in the range of about \$1,700-3,000. Chemical, software and electrical invention searches may be in the range of about \$1,800-3,500. The search takes about four weeks to complete.

III. The Patent Application

The purpose of preparing and submitting a patent application is to obtain the right to exclude others from making, using and selling and offering for sale your invention for the time period beginning with the issuance of the patent and ending 20 years from the date of filing the patent application (or 17 years from the issue date, whichever is longer). In exchange for this right, the inventor must disclose the “best mode” of how the invention is made and works. The application provides a detailed description of the workings of the invention, the invention’s significance, preferred design and any alternative designs. A set of drawings which depict the invention is submitted as part of the patent application, if necessary.

Since patent applications are original documents, not just forms, the attorney who drafts the application must carefully set forth the invention in technical term, and according to the standards that are set forth by the Patent Office. Typically, attorneys work by the hour during this drafting process and consult with the inventor to understand fully the aspects of the invention and the inventor’s intentions. In this way, a strong application can be drafted that will hopefully be allowed.

The cost of preparing and filing a patent application varies over a wide range, depending on the detail and complexity of the invention, the number of forms or alternatives possible, and the extent to which the inventor prepares the invention description. Typically, applications can cost in the ranges as follows: Basic mechanical \$6,000-8,000, complex mechanical \$7,000-11,000, chemical \$7,000-9,000, electronics \$8,000-13,000, biotechnology \$8,000-14,000, and software \$7,000-14,000, or more. Please bear in mind that these are only broad estimates and that fees will vary depending on the number of embodiments of the invention to be described, the complexity of the subject matter, the availability of inventor review, etc.

Drawings may be required, which are drafted by our patent draftsman according to the strict requirements of the Patent Office. Drawings are done at a rate of about \$75 per sheet. The filing fee for individual inventors or small companies (<500 employees) is a minimum of \$500 (including the request for search and examination) depending upon the number of claims filed. The drafting process can take a month or more, depending on scheduling and the level of disclosure provided by the inventor. Three months after a patent application is filed, the applicant is responsible for filing a disclosure statement making the Patent Office aware of any information which may be relevant to the examination of the application. This usually costs about \$150 - 250.

IV. The Examination

The purpose of examining the patent application is to help ensure that the invention satisfies the standards set by the Patent Office for patentability. A high percentage of patent applications are initially refused by the

Patent Examiner. The process of examining an application usually requires that the patent application be amended and arguments made to persuade the Examiner that the invention is patentable. We recommend that you budget between \$1,500-4,000 for typical amendment work, though less or more may be required in specific cases. A first examination can take anywhere from 12-18 months, on average, after filing. Biotechnology, software and business method inventions are being examined about 24-30 months or more after filing. We will advise you of the examination and discuss preparing a response prior to taking any action.

V. Issuance

In the event the application is allowed, the issue fee is about \$1,000 and the accompanying legal fee for handling the issue related activities is approximately \$450. There are also “maintenance fees” due after the patent issues in order to keep the patent in force. These fees are due 3½, 7½ and 11½ years after the patent issues. Failure to pay the maintenance fees results in the patent expiring.

While there is no guarantee that the Patent Examiner will find an invention to be patentable, a well drafted application and amendments will help to ensure patentability. It is our goal to protect your invention and, if patentable, to obtain the strongest patent possible covering the invention. You should be aware that this is an investment you may make in your invention. There is no refund during this process if the application is eventually finally rejected.

VI. Design Patents

A different type of patent that may be available, depending on the invention, is a design patent. A design patent protects the ornamental nonfunctional features of an invention, such as the curved Coca Cola bottle design. An application for a design patent is a simpler process than for a utility patent since the claims in a design patent application are essentially drawings. The charge for preparing and filing a design patent application is approximately \$1,800-2,200, plus draftsman’s charges. This figure would include filing fees and attorney fees. Responding to office actions, filing an information disclosure document for further prosecution and issuance activities may result in additional charges. There are no maintenance fees for design patents.

VII. Points to Consider

- A. **Prior Disclosure and Sale:** You should try to avoid any disclosure or offer for sale of the invention prior to our evaluating whether it is patentable. Even the sale of a demo version or prototype can trigger a statutory deadline. Also, the sale or offer for sale of an invention to a customer who could not determine how the invention works from the item sold can still trigger a deadline. Indeed, even hiring a manufacturer to make a number of prototype units can be a problem. These statutory bars can be triggered by a number of activities that you might not expect would be covered, so you should bring to our attention any disclosures or uses whatsoever that you have made of the invention.
- B. **Confidentiality:** It is important to try to maintain an invention as secret until a patent application is filed. If you must make a disclosure of the invention prior to filing an

application, then you should have a secrecy agreement signed before making any such disclosure. We can prepare a secrecy agreement for your particular use. Be careful about using “generic” or form agreements as they often are not effective. Please note, however, that we strongly recommend that you file a patent application prior to making any disclosures of the invention, to establish your priority in the invention and avoid the loss of any potential patent rights.

- C. Disclosure Document: As a preliminary matter, we can file a Document Disclosure with the Patent Office, which provides strong evidence of your conception of the invention as of the date of recordation in the Patent Office. Please note that a Disclosure Document filing is not a patent application, its receipt date can not become the effective filing date of a later filed application, and a patent application must be filed in order to obtain patent protection on the invention. The cost of a Disclosure Document filing is \$150-\$250, including the filing fee.

We accept Visa, MasterCard and American Express as alternative methods of payment. We request our fee in advance for patentability searches, and will request an advance on our services in the event that you would like us to prepare and file a patent application. Please give us a call if we can be of further assistance.

Jason A. Bernstein

One Atlantic Center
Fourteenth Floor
1201 West Peachtree Street, NW
Atlanta, Georgia 30309

jbernstein@pogolaw.com

Tel.: 404.572.6900

Fax: 404.572.6999