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FREE REPORT

PATENTING YOUR NOVEL PRODUCT, DESIGN OR PROCESS RECOMMENDED STEPS FOR SECURING A U.S. PATENT

- I. DEVELOPMENT PHASE
- II. PATENT SEARCH PHASE
- III. PATENT APPLICATION PHASE
- IV. PATENT PROSECUTION PHASE

It is widely believed that recent developments in Patent Law, the current business and political climate and other factors have lead to a drop in the patent allowance rate at the United States Patent and Trademark Office over the last few years.

That is why it is especially important to take appropriate steps early to help maximize your chances of securing patent rights for your invention. The following steps are generally recommended, but may not be suited for all situations. Consultation with a licensed patent attorney or agent is therefore recommended to discuss your particular situation and how best to proceed.

Nevertheless, experience has shown that the following steps can be very helpful you achieve your goal of getting a U.S. Patent.

I. DEVELOPMENT PHASE

STEP 1: Keep a written record of when and how you developed your invention. It may be helpful to discuss the invention process from the perspective of trying to solve an identified problem or problems. Ideally, your invention solves a problem in a new or better way, or maybe your invention solves a problem that has never been solved before. Thinking about you invention in terms of solving a problem may help you describe your invention more easily.

STEP 2: Keep your new idea secret. This means that you should not show it in public or try to sell it, at least until a proper patent application is filed.

STEP 3: Test your invention to make sure it works the way it's supposed to work. This may require building a prototype, but it can also be achieved through computer or mathematical modeling. Sometimes it's not practical to build a prototype, but you should do your best to make sure that your invention will work as described.

STEP 4: Once your invention or idea is fully developed prepare a clear written report describing your invention, including how it's made, what it does, and how it accomplishes its functions. Your report should generally include some drawings illustrating how your invention works. Rough sketches are acceptable as long as they clearly show how you invention works.

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II. PATENT SEARCH PHASE

STEP 5: Order a professional patent search. This step is especially important since you should try to get a clear idea of what has been patented in the field of your invention and whether it could be an obstacle to getting a patent. The patent examiner assigned to your case will do a search of their own so we should try to anticipate what the examiner will find and be aware of how your invention differs from other known inventions in a unique, non-obvious way.

STEP 6: Review the patent search report and the relevant patent references found in the search and discuss the report with a registered patent attorney or agent. This is your opportunity to ask questions about the patent search report and the patents found in the search.

STEP 7: Make an informed decision about whether to file a patent application and discuss different patent application options, including: Provisional Applications, Non-Provisional Applications and Design Applications.

III. PATENT APPLICATION PHASE

STEP 8: Assuming you decide to file a patent application, you should retain a registered patent attorney or agent to draft your patent application. This is important because a registered patent attorney or agent understands what is required to satisfy the Patent Office Rules and Regulations and will help you avoid some of the serious problems that can arise by failing to include all of the required information needed in a patent application. No matter how great or unique your idea is you can still be rejected if your application does not comply with the Patent Office Rules relating to content and format.

STEP 9: If you decided to file a Provisional Patent Application, you should try to arrive at a decision on whether to file the Regular Non-Provisional Patent Application as soon as possible, but definitely no later than one year from the filing date of your Provisional. This may involve doing one or more of the following: (1) a feasibility study to make sure your invention will work according to specification; (2) a marketability study to make sure there is sufficient market demand for your invention; (3) try to secure investment capital to help finance the development, commercialization and patenting of the invention.

STEP 10: If you file a Non-Provisional Patent Application you may still need to follow some of the steps outlined in Step 9 above. During the development and/or commercialization process you may find that your original invention has evolved. If this is the case, contact your patent attorney as soon as possible and send the attorney all information relating to the evolved or modified version of the invention. This version may be the subject of a Continuation Application.

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STEP 11: Foreign Patent Applications. Keep in mind that you only have up to one year from your earliest patent application filing to file your patent application in foreign countries, either directly or through the Patent Cooperation Treaty (PCT). You should therefore discuss foreign patent filings with your patent attorney as early in the process as possible.

STEP 12: After filing your patent application, you can work on commercializing and/or marketing the finalized invention. This may include securing trademarks and copyrights for your marketing materials. There may be a need for joint ventures with other companies or licensing agreements. However, some companies may be reluctant to enter into a license agreement or joint venture until a patent is secured.

IV. PATENT PROSECUTION PHASE

STEP 13: Respond to Office Action(s). An Office Action is a formal communication from the examiner assigned to your patent application. In most cases, an Office Action contains a rejection of some or all of the claims in the patent application. This is very common and should not be cause for alarm. Nevertheless, an Office Action must be treated very seriously and you should work with your patent attorney to prepare a response that addresses all of the rejections in the Office Action. This will usually involve studying the patent references cited by the examiner and finding non-trivial differences between your invention and the cited patent references. It is also possible that the examiner misunderstood a patent reference or some changes to the claims may be needed. Your patent attorney will discuss these issues with you, should they arise.

STEP 14: Have your patent attorney or agent conduct an interview with the patent examiner. A face-to-face interview with the examiner can be very helpful in resolving issues and clarifying any misunderstandings. We find that the interview can be instrumental in getting a patent allowed.

STEP 15: Respond to any further communications from the patent examiner. It is entirely possible that you receive another Office Action with new patent references cited against your patent application. This will require another response from your patent attorney or agent.

STEP 16: Receive a final decision from the patent examiner, either a Notice of Allowance or Final Rejection. A Final Rejection is not the end of the world and you should definitely discuss it with your patent attorney. It is very possible that the patent examiner may have erred or may be overworked to such a degree that he or she failed to give your application the attention it deserved. Such lack of attention could result in summary rejections that are not well founded. Therefore, an appeal may be needed to bypass the examiner and take your case before the Board of Patent Appeals and Interferences.

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STEP 17: Assuming you are awarded a patent for your invention, it is now time to take full advantage of your new rights. A patent gives you the right to stop others from making, using or selling your patented invention. The claims in your patent define your invention, so your patent rights largely arise from your claims. If you followed the earlier steps you may have commercialized your invention to the extent that you are ready to manufacture, sell, distribute and market your invention. If not, you can still license or sell you invention or become a new division of a company that wants to adopt your technology. A patent gives you many options and we encourage you to discuss them with your patent attorney.

We hope this free report is helpful in illuminating the path towards getting a U.S. Patent for your invention. There will always be unique circumstances or unpredictable developments that may give reason to deviate from these steps. You should therefore discuss your situation with a licensed patent practitioner so that he or she can help guide you in the right direction.

WOOD & EISENBERG, PLLC has helped many inventors and companies secure patents for their unique inventions. We offer a free initial consultation to discuss your particular needs and how we can best assist you. If you are ready to take the next step please contact our office at:

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