

entitled to the benefit of the filing date of the parent or prior application for purposes of overcoming prior art.

You can also file a continuation of a continuation. In fact, it's theoretically possible to file an unlimited sequence of continuation applications. The PTO has attempted, but so far failed, to implement rules to limit the number of continuations. Also, if an issue has been reached in a parent application, the examiner can, and often will, make the first OA final in a continuation application or will make the next OA final after a continuation is filed. In other words, a continuation application will be quickly rejected unless you truly come up with a different slant on or definition of your invention that was not previously considered by the PTO.

If you want to delete any inventors when you file a continuation, you may do so by including a simple request on a separate form. All inventors named in the prior application should sign the form.

As with a regular application, you'll receive your email acknowledgment or postcard back with the filing date of (and a new serial number for) your continuation. Thereafter, you'll receive a filing receipt and the first Office Action in due course.

If the claims that are finally allowed in a continuation application, or divisional application (see Section D, below), differ significantly from the claims originally presented in the parent application, file a Supplemental Declaration (Form 13-3) before or when you pay the issue fee.

Filing a continuation application is very similar to filing a regular, original application. You must prepare the continuation like an original application as in Chapter 10. I.e., provide a complete new copy of the specification and claims, and drawings. You should amend the specification at the beginning (under "CROSS-REFERENCE TO RELATED APPLICATIONS") with the following sentence:

"This is a continuation of application Ser. Nr. ____ /_____, Filed _____, now abandoned [or now Patent Nr. _____ [fill in later], granted _____ [fill in later]]."

Rewrite the claims as you want them and number them from number 1, and so forth. Prepare and sign a new patent application declaration (PAD—Form 10-1). If you are going to file by mail, fill out a Patent Application Transmittal (Form 10-2) and a Fee Transmittal (Form 10-3) as before, except you should also fill out Block 18 in Form 10-2 to refer to the parent case. Don't forget the return postcard. You must get the continuation application on file while the parent case is pending, so if mailing it, make sure you allow enough mailing time, or you can use Express Mail with Form 10-2 as explained in Chapter 10. (Don't use a Certificate of Mailing.) If you want to file the continuation

electronically, go to the PTO's electronic filing website as instructed in Chapter 10 and fill out the forms and a new ADS (application data sheet) on your computer and file the specification, claims, drawings, declaration, and ADS in PDF format as before. In the ADS, in the "Domestic Benefit/National Stage Information," under "Prior Application Status" select "Pending"; for "Continuity Type" select "Continuation of"; and fill in the Prior Application's Ser. Nr. and Filing date. Your continuation will receive a new serial number and filing date, but it will be entitled to the filing date of the parent case.

You also have to file an IDS again. If you're filing by mail, prepare the cover letter (Form 10-5) and the actual IDS Forms (10-6) (use a photocopy of the IDS in your parent case but change the Serial Number and the filing Date), but you don't have to file the references again if your IDS cover letter refers to the IDS in the prior case. Just type the following on Form 10-5:—"Pursuant to Rule 98(d), the references listed on attached Forms SB/08 (A and B) are not enclosed because these were supplied in the parent case, Ser. Nr. ____/_____. " If you're filing electronically follow the instructions in Chapter 13 for filing an IDS online. You may file the IDS when you file or up to three months later.



TIP

Changing Examiners. If you feel that the examiner in your parent case was unduly tough, it may be possible to get a different examiner in your continuation case by claiming your invention differently. The examining division to which a patent application is assigned is determined by the class and subclass to which the application is assigned. The class and subclass is in turn determined by the subject matter of the narrowest (longest or most specific) claim in the case.

EXAMPLE: Suppose you've invented a new gear for a bicycle and the narrowest claim of your parent case recites the fine details of the gear per se. Your case will be assigned to an examining division in the "gear" arts. If your "gear" examiner is a hardnose, you'll probably be able to get it into bicycles, a different examining division, by adding the bicycle to your narrowest claim. You can do this by providing a "bicycle" preamble for the claim (see Chapter 9) or by actually reciting other parts of the bike in the body of the claim. If your narrowest claim is directed to a bike, your whole case will be classified in the bike division, and you'll have a different examiner.

Obviously, this maneuver can't be done in every instance. You should do some research on the PTO's Examining Division art assignments (see the "Patent Examining Corps" page of any recent *Official Gazette*) to

make sure your end run around a particular examiner will work. Lastly, in an effort to get a new examiner, it also helps to change the title of your invention to one that is commensurate with your revised narrowest claim. For example, change “Gear with Anti-Backlash Pawl” to “—Bicycle Pedal Drive Gear—.”



SEE AN EXPERT

Changing examiners is one of several situations where I believe a consultation with a patent attorney or agent may be called for, due to the artsy nature of claims drafting. (See Chapter 6, Section E.)



CAUTION

20-Year Term. Under GATT Law, if you file an RCE or continuation application (or a continuation of a continuation) and get a patent on your RCE application or continuation, the patent will expire 20 years after the filing date of your first, original, or parent application. So it behooves you to file any RCE application or continuation as soon as possible and to prosecute it diligently if you don't want your monopoly to be shorter than the former 17-year term. Since any continuing application (continuation, division, or CIP) will expire 20 years from the filing date of its parent case, before filing any continuing application, consider whether you'll really need to rely upon the parent case's filing date. If you're certain that no adverse prior art has issued since the parent's filing date, you can have any new case expire 20 years from its filing date (rather than from the filing date of the original case) if your new case doesn't claim priority of your original case, i.e., if you file it as a regular patent application, rather than as an extension.

C. Request for Continued Examination (RCE)

Requesting a Continued Examination (RCE) of an existing application has the same effect as filing a continuation application but without going through the paperwork of filing a new application. The applicant simply sends in a form, pays an RCE fee, and continues prosecuting the same application. Prosecution continues as if there were no final action. In other words, filing an RCE is a way of buying your way out of a final action so you can continue prosecution for one or two more go-arounds, as in the old days.

In order to file an RCE, prosecution in the application must be “closed”—that is, the last OA must have been a final action, a notice of allowance, or some other action closing prosecution. Also, the application must be a regular utility application (not a PPA or design application). When a patent issues on an RCE, the heading of the patent will not indicate that it's based on the RCE.

When you file an RCE, the PTO uses your same file jacket, papers, Serial Number, and filing Date. The procedure is covered by the PTO's Rule 114 and the RCE Transmittal Form (Form 14-1/PTOSB/30).

To file an RCE, simply do the following:

- If filing by mail, complete Form 14-1.
- Prepare a check or CCPF (Form 10-4) for the RCE fee (large or small entity—see Appendix 4, Fee Schedule). Note that the RCE fee is less than a new filing fee and is fixed regardless of the number of claims in the application.
- Prepare an amendment containing the new claims you desire to prosecute or check the appropriate block on Form 14-1 if you want to have your Amendment under Rule 116 entered.
- If you file by mail, attach a receipt postcard (see Chapter 10).

You must send your RCE before the period for response to the final rejection expires or before any time extensions you've bought expire. (For an explanation of purchasing extensions of time, see Chapter 13.) As is the case with an amendment, you can eFile, fax, or mail your RCE request on the last day of the period for response if you complete the Certificate of Mailing section at the bottom of Form 14-1. Since you're not filing a new application, you don't have to use Express Mail and you don't have to get the RCE on file before the period expires. Fax the papers to the PTO's central fax number or mail to Mail Stop RCE, P.O. Box 1450, Alexandria, VA 22313-1450.

If you're a registered eFiler you can file the RCE electronically at the PTO's Electronic Business site. Convert the completed RCE Transmittal Form (Form 14-1/PTOSB/30), and amendment to PDF and file them as if filing an amendment. Pay the RCE fee on the PTO's site by credit card. You don't have to file a new IDS or ADS when you file an RCE.

For the Amendment, complete Form 13-1 exactly as you would do with a regular amendment. Then proceed as usual: Cancel the old claims and insert the new claims in the normal amendment manner, numbered in sequence after the highest numbered claim of the prior application. Under “Remarks,” you should state, “The above new claims are submitted to be patentable over the art of record for the following reasons.” Then give your reasons and arguments

in the same manner as you would for a regular amendment, as explained in Chapter 13.

Be sure to include all the claims you desire in the amendment, since the next OA after the RCE is filed may be made final if the examiner doesn't cite any new prior art. If you mailed your RCE, you'll receive your postcard back with the filing date of your RCE but no new serial numbers. After that, you'll receive the next Office Action.

If the claims that are finally allowed in either an RCE, continuation, or a divisional application (see Section D, below) differ significantly from the claims you originally presented in the parent application, you should file a Supplemental Declaration (Form 13-3) before or when you pay the issue fee.

Note that Divisional and CIP applications must be filed like a regular application under Rule 53(b). They cannot be filed via an RCE.

D. Divisional Applications

A divisional application or "division" is "a later application for a distinct or independent invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in the earlier or parent application" (MPEP 201.06). You should file a divisional application when (1) the PTO decides that two separate or distinct inventions have been claimed in the parent application (not permitted, since your filing fee entitles you to get only one invention examined), (2) you've agreed to restrict the parent application to the set of claims to one of the inventions, and (3) you want to get a patent on the other, nonelected invention. You don't have to file a divisional application on the other invention, and should do so only if you think it's important enough to justify the expense of a separate application and patent and you think it may be patentable. Divisional applications are so called because they cover subject matter that is "divided out" of the parent case.

A divisional application is entitled to the filing date of the parent case for purposes of overcoming prior art. The parent application of a divisional application can either issue as a patent or become abandoned if you feel the parent is not patentable over the prior art. The divisional must be filed as a complete new application under Rule 53(b), and, like the Rule 53(b) continuation application, will receive its own serial number and filing date for PTO administrative purposes. A patent issuing on a divisional application will show the serial number and filing date of the parent application; this will be the divisional's effective filing date. But remember that the divisional application must be filed while the parent is pending. Also note that you can file a

division of a continuation application, and a continuation of a divisional application. (Definitely consult an expert if you get into these murky waters.)

Whether or not you're abandoning the parent case you'll have to proceed under Rule 53(b). To file by mail, send in a complete copy of the divisional application, including an Application Transmittal (Form 10-2), Fee Transmittal (Form 10-3), filing fee, drawings (see below), specification, claims, and abstract, PAD (Form 10-1), postcard, and optionally an ADS. Optionally, you may also file a Preliminary Amendment. Everything should be the same as if you were filing a completely new application (use the checklist in Chapter 10), with the following exceptions:

- a. Add the following sentence to the specification under "CROSS-REFERENCE TO RELATED APPLICATIONS":

"This is a division of application Ser. Nr. ____/_____, Filed 20_____, now abandoned [or now patent Nr. _____ [fill in later], granted _____ [fill in later].]"

- Also you should amend the specification, either directly on the copy of the specification you file, or by a Preliminary Amendment. Remove any matter directed exclusively to the embodiment or invention of the parent case, and make any editorial amendments you desire or which you've made in the parent case.
- b. Complete the Patent Application Transmittal (Form 10-2). Fill out box 18 to refer to the parent case and to indicate you're filing a divisional.
- c. Delete any nonapplicable figures from the drawings—that is, any figures directed exclusively to the embodiment of the parent case. Make sure your specification and drawings conform to each other.
- d. You also have to file an IDS transmittal letter (Form 10-5) and the actual IDS Forms (10-6) (use a photocopy of the IDS in your parent case but change the Serial Number and the Filing Date). Do this when you file or up to three months later. You don't have to file any references again if your IDS cover letter refers to the IDS in the prior case. Just type the following on Form 10-5: *"Pursuant to Rule 98(d), the references listed on attached Forms SB/08 (A and B) are not enclosed since these were supplied in the parent case, Ser. Nr. ____/_____."*

To supply drawings for a parallel divisional case (the parent case will be issuing), you have three choices:

1. If you've made formal Mylar film or Bristol board originals of your drawings, you can file very good xerographic copies of these for your divisional's formal drawings.

2. You can file rough xerographic copies as informal drawings and file formal drawings later, as explained in Chapter 10.
3. If you've made CAD drawings, print out new copies.

To supply drawings for a replacement divisional case (the parent case will be abandoned), you have four choices: the three above choices (1, 2, and 3) for the parallel divisional case. Also, you can request (use a separate letter) that the drawings be transferred from the parent case, which is being abandoned, to the divisional case.

If you want to delete any inventors when you file a division, you may do so by including a simple request on a separate form. All inventors named on the prior application should sign.

If you want to file the divisional electronically, prepare your specification, drawings, and signed declaration as described above, fill out an ADS online, convert them all to PDF, and file from the PTO's Electronic Business site using similar procedures as used when filing a regular application. In the ADS, in the "Domestic Benefit/National Stage Information" portion, under "Prior Application's Status" select "Pending"; for "Continuity Type" select "Division of"; and fill in the Prior Application's Ser. Nr. and Filing date.



CAUTION

Double Patent Warning. You're not permitted to obtain two patents on the same invention. If you do, it's called "double patenting," (DP), a situation in which both patents may be held invalid. However, if in your parent case the examiner required you to restrict the application to one of several inventions, there's a special statute (35 USC 121) that helps you. This statute states that if you file your divisional(s) on the nonelected invention(s) after a requirement for restriction, you can do so with total immunity from DP. However, if the examiner didn't require you to restrict, and you're filing your divisional "voluntarily," you must be sure that it's to a clearly different invention than that claimed in the parent case. Otherwise, both patents can be held invalid for DP.

Once again, I recommend that you consult with a patent attorney in the event you (or the PTO) decide that a divisional application is indicated.



CAUTION

20-Year Term Warning. The 20-year term warning for continuation applications in Section B also applies to divisional applications.

E. Continuation-in-Part and Independent Applications

As defined in MPEP 201.08, "a continuation-in-part" (CIP) is an application filed during the lifetime of an earlier application by the same applicant, repeating some substantial portion or all of the earlier application and adding matter not disclosed in the earlier application. CIP applications are not common; they're used whenever you wish to cover an improvement of your basic invention, for example, if you've discovered a new material or a better design. (Remember, you can't add these to a pending application because of the proscription on "new matter" discussed in Chapter 13 and mandated by Rule 121(f).)

I discuss the various CIP situations, below.

Generally, the parent application should be allowed to go abandoned when a CIP is filed. However, if you do want the parent application to issue, you must be sure that the claims of the CIP application are patentably different—that is, they define subject matter which is unobvious over that of the parent application. Otherwise the CIP and parent application patent can both be held invalid for double patenting, unless you file a terminal disclaimer. (See Section I, below.)

The advantage of a CIP application over a separate application is that the CIP is entitled to the filing date of the parent application for all subject matter common to both applications. However, if any claims of the CIP cover subject matter unique to the CIP, such claims are entitled to the filing date of the CIP only.

If your "improvement" of your Basic Application is different enough to be unobvious over the basic invention, you can file an entirely separate, independent application, rather than a CIP. However, it's usually better to use a CIP application, since the common subject matter gets the filing date of the parent application.

EXAMPLE 1: Suppose you've invented a bicycle gear with a new shape. You've claimed this shape in a patent application, which I'll call the parent application. After you file the parent application, your research shows you that the gear works much more quietly if it's made of a certain vanadium alloy (VA). The VA isn't patentable over the invention of the parent case and your parent case's claims cover the gear no matter what material it's made of. However, since the VA works much better, you'd like to add a few dependent claims specifically to cover a gear made of the VA. In this way, if there's an infringer who copies your gear made of the VA, you can show the judge that the infringer is infringing your specific as well as your broad claims. Also, you

will have specific claims to VA to fall back on if your broad claims are held invalid. You can't add the VA to the specification or the claims of the parent case, since it would be verboten "new matter." The solution: File a CIP, describing the VA in the specification, keep all of the original claims, and add a few dependent claims that recite that the gear is made of VA. To avoid any possibility of double patenting, you should abandon the parent case or file a terminal disclaimer (see Section I), since the VA isn't patentable over the invention of the parent case. For purposes of clearing the prior art, your broad claims to the gear shape per se will get the benefit of the parent case's filing date. However, the claims to the gear made of the VA will be entitled only to the later filing date of the CIP.

EXAMPLE 2: On the other hand, suppose your gear shape works well, but you've come up with a related, but nonobvious different shape that works better. That is, the new shape is patentable over the invention of the parent case. You should file a CIP with claims to the new shape and continue to prosecute the parent case to a patent. The CIP's claims generally will be entitled to only the CIP's filing date. However, their CIP status will entitle you to refer back to the parent's filing date to show when you came up with the underlying concept common to the parent and CIP gears. This will be useful in case the CIP is ever involved in litigation or an interference.

EXAMPLE 3: Lastly, suppose your gear shape works well, but you come up with an unrelated, and nonobvious different shape that works better. You should file a new, independent application, not related to the "parent," with claims to the new gear shape. The two applications would be entirely separate.

You can file a CIP of a continuation or divisional application or vice versa in either case. It's also theoretically possible to file an unlimited number of successive CIP applications to cover successive improvements. There have been rare cases where inventors have filed chains of CIPs with as many as eight or more applications, each of which issued into a patent.

If you are abandoning the parent case, you may claim whatever you want in the CIP, provided that the specification supports the claims. Only those claims that are supported by the specification of the parent case will be entitled to the filing date of the parent case. If the claims of the CIP are patentably different from those of the parent case, and the parent case issues, you don't need to

If You Want to Broaden the Claims by Reissue

If you wish to broaden the claims of your patent through a reissue application, you must do so within two years from the date the original patent issued. Moreover, anyone who manufactures anything between the issue dates of the original patent and the reissue patent that infringes the broadened but not the original claims is entitled to "intervening rights." These preclude a valid suit against this person for infringement of the reissue patent's broadened claims. (35 USC 251, 252.)

EXAMPLE: Suppose you invent a new gear shape and get a patent, but unfortunately you included an unnecessary limitation in your independent claims as filed, namely they all recite that the gear is made of carbon steel. If you discover your error within a two-year period after your patent's issue date, you can file an application to reissue the patent with broader claims—that is, claims that specify only the gear's shape and not its material. Your patent will be reissued with the broader claims. However, suppose that an infringer (Peg) made gears with your inventive shape, but out of aluminum, between the date of your original and reissue patents. Peg's aluminum gears would not infringe the claims of your original patent, but they would infringe the broader claims of the reissue. Nevertheless, Peg can continue to make her aluminum gears with impunity since she has "intervening rights" by virtue of her manufacture of the aluminum gears in the interim.

Note that a reissue can't be filed to "recapture" subject matter you deliberately gave up in the original case. In the example above, suppose that in your original case you simply recited "a gear" in the claims, but during prosecution you added that the gear was made of nylon to define over the prior art. Since this was a deliberate, conscious act, you aren't permitted to eliminate the "nylon" limitation (and thus "recapture" your broader claims) in a reissue.

file a terminal disclaimer. If the claims of the CIP are not patentably different from those of the parent case, you must file a terminal disclaimer to avoid double patenting.

If you're filing the CIP by mail, you must use the same procedure (Rule 53(b)) as outlined above for filing a divisional when the parent case will issue, except substitute or check "continuation-in-part" for "divisional" in the Transmittal Letter (Form 10-2) and specification. Don't forget the filing fee and postcard.

If you're filing the CIP electronically, use the same procedure as above for filing a continuation or divisional electronically. Also use the checklist in Chapter 10. The new subject matter in the CIP and any claims directed to it will be entitled to the CIP's filing date, not the filing date of the parent case.

As with continuation and divisional applications, you also have to file an IDS cover letter (Form 10-5) and the actual IDS Forms (10-6) (use a photocopy of the IDS in your parent case but change the Serial Number and the Filing Date). File the IDS when you file the CIP or up to three months later. However, you don't have to file the references again if your IDS cover letter refers to the IDS in the prior case. Just type the following on Form 10-5:

"Pursuant to Rule 98(d), the references listed on attached Forms SB/08 (A and B) are not enclosed since these were supplied in the parent case, Ser. Nr. ____ / ____."

If you want to delete any inventors when you file a CIP, you may do so by including a simple request on a separate form. All inventors named on the prior applications should sign.

If you're filing an independent application (rather than a CIP), do it in the usual manner (see Chapters 8 through 10), except that you can add the following sentence to the CROSS-REFERENCE TO RELATED APPLICATION part of specification:

"This application is related to application Ser. Nr. ____ / _____, Filed _____, now patent Nr. _____, granted _____."

If you want to abandon any parent case, you can do so in a separate letter or by not responding to an Office Action.



CAUTION

20-Year Term Warning. The 20-year term warning for continuation applications in Section B also applies to CIP applications.

F. Reissue Applications

As stated in MPEP 201.05, "a reissue application is an application for a patent that takes the place of an unexpired patent that's defective in some one or more particulars." Parts 1400 to 1401.12 of the MPEP discuss reissue applications extensively. Suppose you've received a patent and believe that the claims are not broad enough, that they're too broad (you've discovered a new reference), or that there are some significant errors in the specification. To remedy this, you can file an application to get your original patent reissued at any time during its term. (See "If You Want to Broaden the Claims by Reissue," above.) The reissue patent will take the place of your original patent and expire the same time as the original patent would have expired.

To file a reissue application you must:

- Reproduce the entire specification of the original application (a copy of the printed patent pasted one column per page is acceptable), putting brackets around matter to be canceled and underlining matter to be added. When the reissue patent issues, it will include the brackets and underlining.
- Supply a request for a title report on the original patent (see Fee Schedule for amount) and offer to surrender the original patent deed.
- Provide a declaration stating you believe the original patent to be wholly or partially inoperative or invalid and referring to and discussing at least one error in the patent. See Patent Rules 171-179.

Reissue patents are relatively rare and are identified by the letters "RE" followed by a five-digit number, for example, "Patent RE 26,420."

Although the procedure has been somewhat simplified recently, it is still relatively complicated, so I suggest that you consult a patent lawyer if you are interested in filing a reissue.



CAUTION

Reissue Warning. If you file a reissue, all of the claims of your original patent will be examined and can be rejected. Thus you should consider whether you want to take this chance before filing a reissue.

G. Statutory Invention Registration (SIR) and Defensive Publications

Suppose you've filed a U.S. application and for some reason don't wish it to issue as a patent, or can't obtain a patent on it. However, you want to be absolutely sure that no one else

will ever be able to obtain a patent on it. This can occur if you're manufacturing a product embodying the invention. You can elect to have an abstract of your application published in the *Official Gazette* and have your entire application published like a patent. This purely defensive procedure is called a "Statutory Invention Registration" (SIR). It will cause your invention to become a prior-art reference, effective as of its filing date. The SIR will thus preclude anyone else from obtaining a patent on the invention, provided no one else filed an application on the invention before yours. Your application will then be printed and published like a patent, but you won't have any monopoly rights. (You will retain the right to revive your application and get into interference if a patent or application is discovered that claims your invention.) If you do choose to convert your application to a SIR, follow PTO Rules 293-297 and 17(n) or (o).

I don't recommend use of the SIR procedure because of the generally higher fee required—it's cheaper to publish your own book about your invention or to list it with an invention register. One invention register is *Research Disclosure Magazine* (www.ResearchDisclosure.com). You can publish the details of your invention on your own website, or use an Internet publishing service such as IP.com (www.ip.com). If you use your own website, your publication should be a good defense if any later-filed patents are asserted against you, but if you use a service, the patent examiners are more likely to search it and use it to reject any such later-filed patents. If you have your invention published this way, the effective date of publication will be later than your filing date. However, the cost is generally much less and the later date won't make any difference unless someone has filed on the same invention before you publish it.

H. Substitute Applications

The term "substitute" is defined in MPEP 201.09 as "an application that is in essence a duplicate of an application by the same applicant that was abandoned before the filing date of the later case." A substitute (also called a "re-file") can be filed for the same purpose that you can file a continuation, division, or CIP. That is, you can file a substitute to continue prosecution that you didn't complete, to cover a different invention, or to cover an improvement invention.

I hope you never have to file a substitute application, since it doesn't get the benefit of the filing date of the earlier case. This is because it wasn't filed while the earlier case was pending. Thus any prior art that issues after the filing date of the earlier case and before the filing date of the substitute case is good against the substitute case. Suppose,

however, that you somehow abandon your application (not your invention) and you can't successfully petition the Commissioner of Patents to revive the application (see Chapter 13). You still may be able to cover your invention by filing a substitute application, assuming significant prior art hasn't been published in the meantime.

There are no special forms or procedures for filing a substitute application; just file it like you would a regular patent application, except that you can add a reference in the specification to the prior case. As stated, you won't get the benefit of your prior case's filing date. However, the date of the parent case may be useful if you ever have to swear behind a reference (see Chapter 13) or prove earlier conception and/or reduction to practice, such as in case of an interference. (See Chapter 13, Section K.) If your substitute application issues into a patent, the patent will expire 20 years from the filing date of the substitute.

I. Double Patenting and Terminal Disclaimers

Double patenting (DP) is a situation that exists when one person or entity obtains two patents on the same invention, or on two inventions that are not patentably distinct. It's very important to avoid DP, since both patents can be held invalid by a court. Also, if the PTO sees that you have two applications pending that aren't patentably distinct, they will reject them on the grounds of potential DP. Thus, you must always be aware of the DP trap whenever you file a second case on any invention.

There are two types of DP: statutory DP and obviousness-type DP.

In statutory DP, the two patents cover the same invention. This situation is prohibited by 35 USC 101, which says that "Whoever discovers any new and useful [invention] ... may obtain a patent therefor" This means that an inventor may obtain only one patent for an invention, not two patents. Statutory-type double patenting is absolutely prohibited and cannot be overcome by a terminal disclaimer.

In obviousness-type DP, an inventor obtains two patents on respective inventions which are not identical, but which are also not different enough to be considered unobvious over each other. This situation is prohibited by judicial decisions, because a second patent will usually extend the inventor's monopoly beyond the expiration date of the first patent. However, obviousness-type DP can be overcome by filing a terminal disclaimer (TD) in the later application so that any patent issuing on it will not extend beyond the expiration date of the first patent and to ensure that both patents will continue to be owned by the same entity.

(Rules 130(b) and 321(b).) Also, obviousness-type DP can be avoided if your examiner has required restriction. As explained in Section D, above, under “Double Patent Warning,” a special statute (35 USC 121) states that you have total immunity from DP if you file a divisional after the examiner required restriction.

Under a TD, you agree to give up the terminal (end) period of your second patent so that both patents will expire on the same date, and will continue to be commonly owned, thereby eliminating the harm to the public interest (extension of monopoly beyond normal term or prohibiting a second patent that is not patentably different from issuing to a different entity) of double patenting. Although I don’t provide instructions on preparing and filing TDs (the practice is tricky) I want to make you aware of their existence so you’ll know what options are available and when to consult an attorney. If you feel brave enough to venture into this area alone, TD forms and the filing fees are available on the PTO’s website.

J. Summary

A patent applicant can file a number of possible supplements from an original, parent, or base patent application. If the base application has two or more inventions and is restricted to only one of these inventions, a *divisional application* may be filed to cover the other invention. If you’ve gotten a final action in the base application and want to submit new claims and continue prosecution, you may file a *continuation application* or a *request for a continuing examination* (RCE). If you develop an improvement on the invention of the base application and want to claim it specifically and still keep the filing date

of the base application for the base invention, you may file a *continuation-in-part application* (CIP). The divisional, continuation, RCE, and CIP all get the benefit of the filing date of the base application, but also expire 20 years from the base application.

If you come up with a substantially different improvement or new invention, it’s best to file an *independent application*. If you get a patent and discover an error in it, such as claims that are too narrow, you can file a *reissue application* to have the patent reissued. The reissue patent takes the place of the original patent and expires when the original patent would have expired. You cannot use a reissue patent to claim (recapture) subject matter that you voluntarily gave up in the original case; any reissue with broader claims must be filed within two years from the original patent and is subject to the intervening rights statute.

If you can’t get or don’t want to get a patent on an invention, but want to prevent someone else from getting a patent on it, you can *defensively publish* your application privately or convert your application to a *Statutory Invention Registration* (SIR). A SIR is relatively expensive to file, but can be converted back to a regular application in case of an interference and it is prior art as of its filing date.

If you abandon your application and want to file on it again, you will have to file a *substitute* application; such an application has no connection to the base application. No one may legally receive two patents for the same invention since this would constitute statutory *double patenting*. Also no one may legally receive two patents for two inventions that are not patentably different since this would constitute *obviousness-type double patenting*. However *obviousness-type double patenting* can be avoided by filing a terminal disclaimer so that the two patents will expire at the same time.

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Inventor's Commandment 30

Once your patent issues, check it for printing errors, consider patent marking if you manufacture a product covered by the patent, be alert for infringements, and pay three maintenance fees (3.0 to 3.5, 7.0 to 7.5, and 11.0 to 11.5 years after issue) to keep it in force. You should also monitor all products in the field of your patent to discover any possible infringements.

A. Issue Notification

Several months after you pay the issue fee (Chapter 13), you'll usually receive an Issue Notification. This will indicate the number and issue date of your patent (commonly within two weeks after you receive the notice). On the issue date, which will usually be a Tuesday, the patent will be granted, published, and mailed to you so that several days later you'll receive your patent deed (also called "letters patent"). This consists of a copy of your patent on stiff paper, a fancy jacket, seal, and ribbon. You'll also receive (separately) the printed copies of your patent if you ordered them when you paid your issue fee. The *Official Gazette—Patents*, which is usually published electronically on the Tuesday of grant, will list the highlights of your patent. (The PTO publishes patent applications in which a Nonpublication Request has not been filed online every Thursday.)

B. Press Release

You may wish, when you learn the number and date of your patent, to prepare a press release about it. See any book on advertising to learn how to prepare a press release; it should cover the six facets of reporting:

*"I had six honest serving men
They taught me all I knew;
Their names were WHERE and WHAT and WHEN
And WHY and HOW and WHO."*

—Rudyard Kipling

Make your headline and text simple and short (250 words maximum), yet interesting and catchy—for example, "Midgeville Inventor Gets Patent on Jam-Free Bike Mechanism." Be conversational; don't use jargon or technical language. Type on only one side of the paper, double spaced, and include your name, address, phone number, and "For Immediate Release" at the top. If you have more than one page, number and type "more" at the bottom of each page

(except the last) and staple the pages together. Type "30" or "###" at the end. If you have an interesting or important invention, send a letter or copy of your PR (as soon as you get the issue notice) to N.Y. Times Patent Columnist, 229 West 43d Street, New York, NY 10036, and States News Service, Fax 202-737-1851. They may mention your patent in their regular column when your patent issues. Also send the PR to your local papers and trade magazines (each with a copy of your patent) on the day you get the patent. You can make extra copies of your patent from the deed, the printed copies, or download them from the Internet (see Chapter 6 for more on obtaining patent copies). One source for getting publicity is Publicity Goldmine (www.publicitygoldmine.com).

C. Check Your Patent for Errors

First, proofread your patent carefully, preferably aloud with a friend or coworker. Carefully examine the information in the heading of the patent—serial number, filing date, title, your name, etc.—to make sure all is correct. Then read the patent word for word and compare it with the application in your file as amended during the prosecution phase.

If you find errors, you have several possible courses of action.

1. If the Errors Aren't Significant

If the errors aren't significant, that is, if the meaning you intended is obvious and clear, the PTO may not issue a Certificate of Correction, but you should make the error of record in the PTO's file of your patent. To do this, simply write a "make-of-record" letter to be put in the file of your patent, listing the errors you found. This letter should be captioned similarly to Form 15-1 with the patent number, issue date, and patentee(s) name(s) and should be headed, "Make-of-Record Letter for Errors in Printed Patent." It should then list all the errors in the patent. File the letter by mail, fax, or online if you're a registered eFiler.

2. Certificate of Correction

If any of the errors you discover are significant, that is, if the meaning is unclear because of a wrong reference numeral, missing or transposed words, failure to include a significant amendment, any errors in the claims, etc., you may obtain a Certificate of Correction. If the errors are the fault of the printer, the PTO will issue the Certificate of Correction free. If the errors are your fault, that is, they appear in your file as well as in the printed patent, you still can get a Certificate of Correction. However, the error must

be of a clerical or minor nature and must have occurred in good faith. Examples are a wrong reference numeral or an omitted line or word. (The fee for a Certificate of Correction to fix your error is listed in Appendix 4, Fee Schedule.) To obtain a Certificate of Correction (printer's fault or yours), do the following:

Step 1: Fill out Forms 15-1 and 15-2. In Form 15-1 (the request letter), insert the patent number, issue date, patentee(s), Ser. Nr., filing date, and the date you mailed the form. Check paragraph 2 if the error is the fault of the PTO; check paragraph 3 and insert the amount from the Fee Schedule if the error is your fault.

In either case (whether you checked paragraph 2 or 3), in paragraph 4 list the places in the application file where the errors occurred and explain who was at fault; for example:

"4. Specifically, on p. 4, line 12, of the specification, applicant erroneously typed '42' instead of '24' and neither applicant nor the examiner detected this error during prosecution."

or

"4. Specifically, on p. 4, line 12, of the specification, the reference numeral '24' has been erroneously printed by the GPO in the patent as '42' instead of '24.'"

Step 2: Complete the caption of Form 15-2 with the patent number, issue date, and inventor(s). (The PTO also furnishes carbon sets of the Certificate of Correction form for free.) In the body of Form 15-2, indicate the necessary corrections to the actual printed patent by (a) sandwiching existing words to be changed, deleted, or followed by an insert with quotes and (b) sandwiching words to be inserted with dashes; for example:

"Col. 3, line 54, change 'the diode' to —varistor 23—."

"Col. 4, line 21, after "a" insert —red—."

"Col. 5, line 58, delete "the former.""

Put your return address and the patent number on the bottom of Form 15-2.

Step 3: If you're a registered eFiler you can file the Request and the Certificate by EFS-Web, but if not, send one copy of completed Form 15-1 and two copies of completed Form 15-2 to ATTN: Certificate of Correction Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, with a receipt postcard, and a check for the correct amount

if the error was your fault. You'll get an approved copy of your Form 15-2 back in several months and the PTO will affix copies of it to the copies of your patent that it maintains in its storage facilities and will include the Certificate as the last page of the patent on its Internet site.

D. Patent Number Marking

If you already have sales blurbs promoting your invention, change them to indicate that your invention is "patented" rather than "patent pending." If you, or a licensee of yours, is manufacturing a product embodying the invention, you should consider marking your product with the patent number.

A section of the patent laws (35 USC 287) states that products embodying a patented invention may be marked with the legend "Pat." or "Patent," followed by the patent number. If you make or sell products embodying your invention that are properly marked, you can recover damages from any infringers you sue from the date you began marking, whether they see your notice or not. If you make or sell products but don't mark them with your patent number, or mark them "Patented" without the number, your rights are reduced and you can recover damages only from the date you notify the infringer of infringement, or from the date you file suit against the infringer, whichever is earlier.

You should do the actual marking on the product itself, on its package, or by means of a label affixed to the product.

Suppose you don't manufacture any product embodying the invention, or if the invention relates to a process that's not associated with a product and hence can't be marked. In these cases you can recover damages from an infringer for the entire period of infringement without marking.

The disadvantage of patent marking is that any sophisticated person who wants to copy your product can easily see the number of your patent, order the patent, read its claims, and attempt to design around the claims of your patent. If you don't mark your product, the potential infringer can still probably get this same information, but only through a lot more expense and effort. In other words, by not marking you may depend in part on human inertia to protect your invention from being copied. Many companies, therefore, favor *not* marking their patented products, or simply marking them "Patented" without including the number. They rely on their own familiarity with the field to enable them to quickly spot and promptly notify any infringer of the existence of the patent.

If you do mark, be careful because you can be subject to substantial damages if you mark improperly. A statute, 35 USC § 292, states that if you mark falsely with intent to deceive, you can be subject to \$500 in damages for each offense. In *Pequignot v. Solo Cups* (CAFC 2010), a patent attorney sued Solo to obtain damages because Solo marked its paper cup lids with the number of an expired patent. The court held that Solo was not liable for the \$500 penalty per lid because they marked on the advice of counsel and to save money in mold costs and prevent business disruption—that is, they had no intent to deceive. So if you do mark, make sure the patent’s claims cover the product and the patent is still in force and maintenance fees have been paid up to date.

E. Advertising Your Patent for Sale

If you still haven’t licensed or sold your invention by the time your patent issues, you can advertise the availability of your patent for license or sale on the Internet or in one or more of several publications, such as:

- *Patent Official Gazette*, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
- *The International Invention Register*, P.O. Box 547, Fallbrook, CA 92028
- *The Wall Street Journal*, *U.S.A. Today*, local newspapers in large cities, etc.

Contact the publications for listing information and fees.

The Internet provides many opportunities for advertising your invention and many sites provide methods for listing inventions for sale or license including Cool License (www.coollicense.com), and *Inventor’s Digest* (www.inventorsdigest.com). Contact these sites for more information.

However, the number of patentees who make successful contacts by advertising their patents is relatively low. Your chances of a successful nibble will be far greater if you use the targeted, individual approach described in Chapter 11.

F. What Rights Does Your Patent Give You?

Now that you’ve actually obtained a patent, you’ll undoubtedly want to know exactly what rights you receive under it. While I’ve indicated that a patent provides a monopoly on the manufacture, use, and sale of your invention that expires 20 years from the filing date of your application (plus any extension granted by the PTO), I’ll now specifically discuss what this means in the real world.

A Calculator That Determines Expiration Dates and Maintenance Fees

If you are uncertain as to the expiration date of a patent, there’s an online Patent Calculator (www.ssjr.com) that can help. Enter your patent’s Application File Date and Issue Date. If your patent issued from a parent application, enter the filing date of the originally filed parent application in the blank next to Earliest Effective Filing Date. Enter any Term Adjustment if an adjustment was granted by the USPTO. The calculator will then calculate the expiration date and maintenance fee calendar.

1. Enforceable Monopoly Against Manufacture, Use, Sale, Offer for Sale, Importing, Etc.

The grant of a patent gives you, or any person or entity to whom you “assigned” (legally transferred) your patent or patent application, a monopoly on the invention *defined by the claims of the patent*. The monopoly begins with the patent’s date of issuance and expires 20 years (plus any extension granted by the PTO), from the date you filed your application (or the first application in the chain if your patent issued from a division, continuation, or continuation-in-part). (For applications issuing before 1995 Jun 8, the term is 17 years from issuance, and for applications filed before this date and issuing thereafter, the term is the greater of the 17- or 20-year term. The PTO will extend any term if you encountered a delay due to FDA processing of a new drug or medical device application, had to appeal or prosecute an interference, or had your application placed under a secrecy order. (35 USC 154-156.)) If the PTO published your patent application—usually 18 months after filing (unless you requested earlier publication)—and you actually notified an infringer of your patent application, you can recover damages from the infringer from the actual date of notification. (35 USC 154(d).)

Your monopoly gives you the right (35 USC 271) to bring a valid suit against anyone who does any of the following during the term of your patent:

1. Makes, uses, offers to sell, sells, or imports the invention defined by the claims of your patent. (There is a DNA exemption which is too complicated to cover here. See 35 USC 271(e)(1).) Note also the medical exemption discussed in Section 3, below.
2. Files a new drug application on your invention in the U.S.

3. If your U.S. patent covers a process, imports a product made abroad by your patented process.
4. Induces infringement of your patent.
5. Offers to sell, sells, or imports a material component of your patented machine or process made especially for use in infringement of your patent and not a staple article of commerce with substantial non-infringing use.
6. Supplies in or from the U.S. a substantial portion of the components of your patented machine for assembly outside of the U.S.

You can use your ownership of the patent to obtain value in any of seven ways:

1. Sell the patent outright.
2. License others to make, use, and/or sell the patented invention in return for royalties under a variety of conditions, subject to the antitrust laws mentioned in the note below. (See Chapter 16 for a more detailed discussion about the sale and licensing of patent rights.)
3. Create a monopoly by preventing anyone else from making, using, or selling the invention. In this case you would manufacture the invention yourself (or have it manufactured for you) and charge more than you'd have to in a competitive situation. Xerox did this in the early days of photocopiers and Polaroid and Sony do it now with their instant film, cameras, and the one-gun Trinitron CRT. In other words, a patent will give you the right (within limits) to fix the price of your product—a capitalist's dream!
4. If accused of patent infringement, you may be able to assert your patent against the other patent holder and generate a cross-licensing arrangement to avoid paying royalties or having to stop infringing.
5. You can tout your patent in advertising.
6. The patent is a publication (as of its filing date) that will prevent others from patenting the same thing.
7. While a patent does not give you any immunity from infringing others' patents, if you are manufacturing anything and another patent holder charges you with infringement, you can sometimes use the patent to (a) show that your products are separately patentable and thus are not direct copies, and (b) prevent the infringer from using the doctrine of equivalents.



TIP

Antitrust Note. Occasionally, companies or individuals who own a patent or manufacture a patented invention use their patent to extend their monopoly in ways that violate the antitrust laws. For example, compulsory package

licensing, compulsory price fixing, and other practices that impose undue restraints on free trade all violate the antitrust laws. This is very rarely a problem for the independent inventor but can occasionally raise problems for large corporations. For a discussion of antitrust law as it affects the use of patents, go to any law library and look for any books on patent-antitrust law. One text is *Antitrust Law Handbook 1999*, by William C. Holmes (West 1999). Also look under the heading "Patents," subhead, "antitrust," in any legal encyclopedia, such as *Corpus Juris Secundum*.

Extending the Effectiveness of Your Patent

If you want to continue to make money from your creativity after your patent expires, you should plow back some of your royalties or proceeds from the sale of the patent for research. In this way you can invent further developments and improvements, and thereby get more and later patents so as effectively to extend your monopoly beyond its relatively short term. You can even file a new patent application on the improvements when you invent them, but withhold the introduction of products with the improvements until you've milked the market with the basic products. DuPont did this with its *Teflon* and *Teflon II*.

2. Property Rights

The law considers a patent to be personal property that its owner can sell, give away, or otherwise dispose of. It can even be seized by your judgment creditors, just like your car, a share of stock, or any other item of personal property. Although it's personal property, the actual patent deed you receive from the PTO has no inherent value; thus you need not put it in your safe-deposit box or take any steps to preserve it against loss. Your ownership of the patent is recorded in the PTO (just like the deed to your house is recorded by your county's Recorder of Deeds). If you lose the original deed, you can download copies, or the PTO will sell you copies of the printed patent (certified if you desire) and/or certified copies of a title report showing that you're the owner.

3. Medical Procedure Exemption

A few years ago, one physician sued another for infringement of a patented ophthalmic surgery technique. This upset the medical establishment, which used its

considerable clout to get a federal statute enacted which exempts health care providers (for instance, doctors, nurses, and hospitals) from liability for performing medical procedures covered by in-force patents. (35 USC 287(c).) In view of this statute, it no longer makes sense to patent medical procedures, as such. However, the statute still allows patent owners to sue health care providers for any activity that infringes a patent on (a) a device, (b) a drug, (c) the use of a drug or device, or (d) a biotechnology process invention.

While this medical proceedings exemption statute is well-intentioned, most patent practitioners believe that it stifles innovation. An example will show why. A client of mine invented a new and promising ophthalmic technique that would help sight-impaired persons. He needed funding to develop it. When he asked me to prepare a patent application on it, I told him about the new law. He realized that even if he got a patent, he would not be able to enforce it against any medical practitioners who used the technique. He also realized that any patent he got would be worthless. Since it would not pay to develop it unless he could get a proprietary position, he dropped it and the world will not have the benefit of his potentially valuable innovation. Thus, many people with impaired vision who could have been helped will have to live with their impairment.

G. Be Wary of Offers to Provide Information About Your Patent

Soon after being awarded a patent, a client of mine received an offer by mail, advising that an “article” about her patent was published and offering to send her a copy of the article for \$3.95. After anxiously sending in her money, she received the “article,” a photocopy of a page from the PTO’s *Official Gazette*, showing the usual main drawing figure and claim of her patent! Fortunately she was able to obtain a refund by threatening to call in the FTC and postal inspectors, but you may not be so lucky; new rackets originate all the time.

Another offer very frequently received by patentees, usually about a year or more after their patent issues, comes as a postcard, such as in Fig. 15A.

I believe this offer has marginal utility to most inventors, and at a very high cost. I wouldn’t accept the offer, since almost all patents in which earlier patents are cited as references are very different and extremely unlikely to be of any value to the owner of the earlier patent. You can obtain the same service free on the PTO’s site (www.uspto.gov) by clicking Patents, then SEARCH, then Patent Number Search, then enter the number of your patent, then

Important Notice

To: Owners of U.S. Patent # 4688283 _____
Assignor

Our search of your U.S. patent shows the _____ [#] _____
most recent patents, issued after your patent, that the U.S. Patent Office has classified identically or cross-referenced in the same class and subclass as your patent.

You may want to determine if your patent dominates the later patents, the activity of competitors, and the latest state of the art.

For each of the later-issued patents we will send you the patent no., an abstract, a drawing, plus address-information on the inventor, and/or the owner or manufacturer for \$1.00 each, plus a service charge of \$60.00 if you return **THIS CARD** (or a copy) with your payment of \$96.00. Make check or money order to _____ (Name) _____ payable on a U.S. Bank.

Or send \$60.00 for a list of later patent numbers.

CD 60

1-2-3-4-1 Providing Patent Information Since 1976 1-2-3-4-2

Fig. 15A—Postcard Offer of Dubious Value

click Referenced By. The site will then display a list of all subsequent patents that cite yours.

A third offer is the “Patent Certificate.” This offer is sent to many patentees in an official-looking letter from Washington, marked “U.S. Patent Certificate,” “For Official Use Only” (next to the postage stamp), and “Important Patent Information.” In reality, it’s from a private company that wants to sell you a nicely framed version of your patent. Needless to say, this product has no official value.

A fourth offer, definitely of questionable value, also comes on a postcard that states something similar to the following: “Our search of your patent has located X companies that manufacture, market, or sell products in a field allied to your invention.” It offers to sell you the names of the X companies for a stiff fee, usually about \$80. If you want to find the names of the companies that are in a similar field, I strongly advise that you save your money. Instead take a trip to a store or library where you’ll find plenty of suitable companies for free. (Use the techniques outlined in Chapter 11.)

A fifth offer is to include you in a compendium of inventors, such as a “Who’s Who” of inventors, or an offer to sell you such a volume with your name included.

Definitely not worth it, unless you like your ego stroked for a price.

A sixth recent scam comes in the form of an email to a patentee. The email states that it comes from a Japanese industrialist who is seeking to buy patents that cover inventions he can manufacture. A client traced back the email and found that the sender was a grifter based in Nigeria.

As a patentee, you may receive other offers along the lines of the foregoing. Be sure to investigate and think about it carefully (or ask a trusted advisor) before you follow up on any offer.

Beware of Published Application Scams

Recently I filed a PCT application for a client and the PTO published it in due course. Shortly afterward the client received an official-looking “bill” in the mail from an official-sounding organization in Florida, listing the details of his PCT application and asking for \$1,629.30 for “Charges For Registration.” *This is a scam.* I complained about this to the Florida Attorney General and found that they were already investigating this organization for other scams. You may get a similar “bill” if your regular patent application is published, so beware. Ask an attorney or your own state’s attorney general if you receive any similar “bill” that’s not from a source with which you’re familiar.

H. Maintenance Fees

In 1983, a law was passed under which the PTO instituted a maintenance fee (MF) system. While MFs are new to the U.S., their use had been commonplace in most countries for decades. Under the U.S. MF system, your patent, when granted, will subsist in force for 20 years from the filing date of its application, provided three maintenance fees are paid.

If you don’t pay any MFs, your patent will expire four years from grant. If you pay a first MF between years 3.0 and 3.5 from grant, the PTO will extend the patent to expire eight years from grant. If you pay a second (much higher) MF between years 7.0 and 7.5, the PTO will extend the patent to expire 12 years from grant. And if you pay a third and final (much higher yet) MF between years 11.0 and 11.5, the PTO will extend the patent to expire 20 years (plus any extension the PTO has granted), from filing. This information is presented in Fig. 15B, an MF timing chart. The adjustable arrow indicates that the expiration date varies, depending upon the length of pendency of the application. The online calculator in Section F above will calculate your maintenance fees for you.

To help you remember when to pay your MFs, I’ve provided an MF Reminder Sheet as Form 15-3; a sample is completed in Fig. 15C. You should copy this sheet and fill it out in ink—except write the year of MF I (three years after issue) in pencil on the top line and leave the last three columns in the table blank. Put the sheet at the end of your current year’s calendar. Keep moving it ahead to the end of each new year’s calendar at the end of each year, until the third year after issue when the fee is due. Write that the MF is due on the appropriate date on your calendar for the third

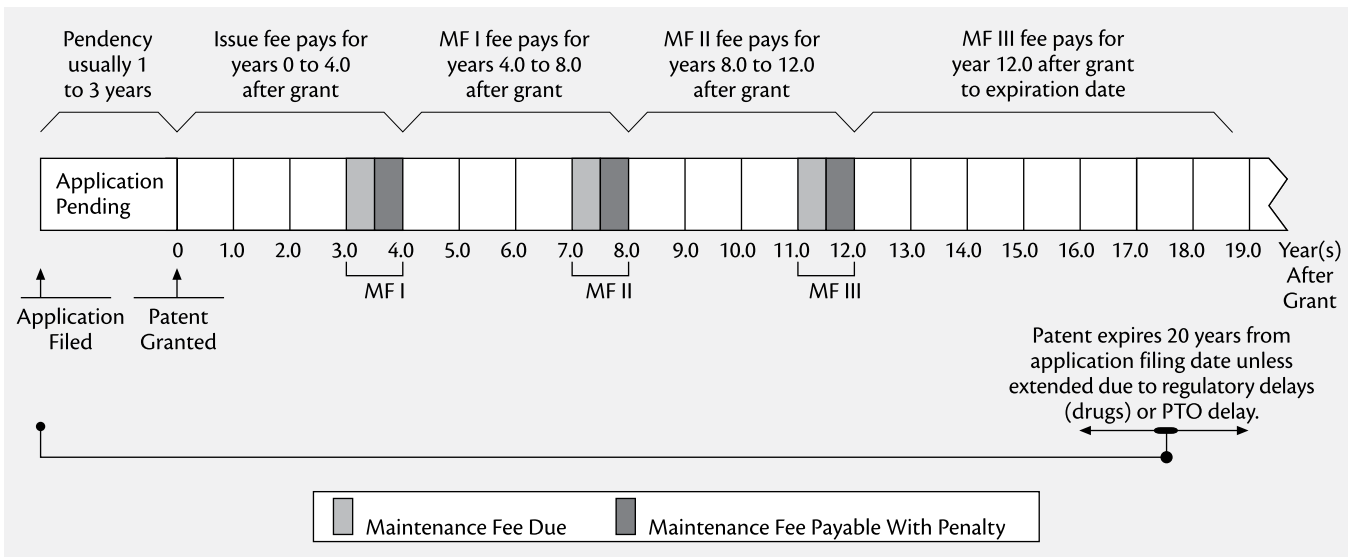


Fig. 15B—Maintenance Fee Timing Chart

Maintenance Fee Reminder

Next fee due: 2002 / 7 / 16
 yr mo date

(Write year in pencil and change after each payment)

Patent Nr.: 5,032,015 Issued: 1995/7/16
 Application Serial Nr.: 07/427,862 Filed: 93/10/27
 Title: "Shower Mirror with Valve"
 Patentee(s) (Inventor[s]/Applicant[s]): T.R. Christianson
 Assignee(s) (if any): ShowerTek, Inc.
 Expires 13/10/27 (if all three maintenance fees are paid).¹

Small entity status was filed in application or patent.
 (If not, large entity fees² must be paid.)

Maintenance Fee Number	Fee Due		Sent Form & Check ⁴	Amount	Received Receipt Statement
	From:	To:			
I. Due 3.0 - 3.5 YAI ³	98 / 7 / 16	99 / 1 / 16	99 / 8 / 16	\$ 320	99 / 9 / 15
II. Due 7.0 - 7.5 YAI	02 / 7 / 16	03 / 1 / 16	02 / 8 / 12	\$ 1,020	02 / 9 / 14
III. Due 11.0 - 11.5 YAI	06 / 7 / 16	07 / 1 / 16	/ /	\$	/ /

Notes: _____

¹ For applications filed after 1995 Jun 7, expiration is 20 years from filing date of application, or from any earlier domestic nonprovisional (regular) application from which it claims priority, plus any adjustment (extension) granted by the PTO.
² Please check all fee amounts before paying, since PTO fees change often.
³ YAI = Years After Issue date.
⁴ Send or make Internet payment at least a month before due date to allow time to take corrective action before entering grace (penalty) period in case PTO does not accept payment.

Fig. 15C—Maintenance Fee Reminder (Form 15-3 in Appendix 7)

year. Fill in the last three columns in the table. When you pay the first fee and receive your receipt statement, change the year at the top of the sheet to the seventh year after issue and repeat the process.

As indicated in Fig. 15B, if you forget to pay any fee during its normal six-month payment period, you can pay it in the six-month period (grace period) following its normal six-month payment period. However, as always, whenever you miss a PTO date you must pay a penalty or surcharge (see Appendix 4, Fee Schedule). If you pay a maintenance fee in the grace period, infringers do not acquire “intervening rights”—see below.

If you forgot to pay a maintenance fee in the normal and grace periods, the patent will expire at the end of the grace period. However, an expired patent can be revived on petition if you show, by declaration, that the delay was “unavoidable” (Rule 378(b)), or “unintentional” (Rule 378(c)).

An “unavoidable” petition (PTO/SB/65) must provide facts showing that you took reasonable care and steps to pay the fee in a timely manner but were unable to do so. An example of an unavoidable delay might be that your house burned down and as a result all your records were lost. You must accompany the petition by the MF, the MF transmittal letter, and the lower “unavoidable” fee (see Appendix 4, Fee Schedule).

An “unintentional” petition (PTO/SB/66) must merely state the nonpayment was unintentional. You must accompany the petition by the MF, the MF transmittal letter, and a very high “unintentional” fee (see Appendix 4, Fee Schedule). You must file the petition within two years after the end of the grace period. (See Chapter 13, Section Q, for how to prepare such a petition and declaration.)

If any infringement occurred or was prepared for after the patent expired and before it was revived—either with an unavoidable petition or an unintentional petition—the infringer has “intervening rights.” This means that the infringer can continue any infringing activity performed in the lapse period as if the patent were not revived. (35 USC 41(c).)

The easiest way to pay an MF is with a credit card through the PTO’s website. Go to the PTO website (www.uspto.gov) and click “Access Financial Services.” Next, click “USPTO Office of Finance Home Page,” then, click “Pay Patent Maintenance Fees.” At this point you must enter the patent number and the application serial number. You can find out how much is currently due by clicking “Retrieve Fees to Pay” or you can view the payment dates by clicking “View Payment windows.” After that, click “Pay Using Credit Card” and complete the form by supplying your credit card information. The PTO will present a Maintenance Fee Statement (receipt) on the website showing receipt of payment. Print out the Statement for your records.

If you don’t want to pay the fee online, use Form 15-4 or PTO/SB/45 to pay the maintenance fees. Complete every blank in the form including the serial number of the application, or the PTO won’t accept your fee and the delay may carry you into the grace period, costing you a surcharge. (If you’ve assigned or licensed your patent to a large entity, check “large entity” on Form 15-4 and pay the large-entity fee.) If the PTO accepts your maintenance fee, they’ll send you a Maintenance Fee Statement to this effect. Anyone can sign Form 15-4. Note that the address for payment is different than the usual address.

If you use the Certificate of Mailing at the end of the form, you can send in the fee on the last day of the period. If the last day of the period falls on a Saturday, Sunday, or holiday, it’s extended to the next business day. And don’t forget a postcard! Of course, if you feel, at any time a maintenance fee is due, that your invention’s prospects have become nil, you shouldn’t pay the fee. In this case, your patent will expire as indicated above.

The PTO won’t accept a maintenance fee before its due period and usually sends you an MF reminder only after the due period expires, when you’re in the six-month grace (penalty) period. They also usually send you a Notice of Patent Expiration if you don’t pay the fee in either the regular or grace periods. The PTO publishes the numbers of lapsed patents in the *Official Gazette* and on its website. If you move, you must notify the PTO of your new address with a separate letter or PTO/SB/123 sent to Mail Stop Post Issue, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450; otherwise the PTO will send your MF receipt to your old address (even if you put your new address on your MF transmittal).

I. Legal Options If You Discover an Infringement of Your Patent

If you find an infringer, you may wish that the earth would shake, the skies thunder, and a mighty lightning bolt would come down and vaporize the miscreant. Failing this, you might wish that you could present details of the infringement to the PTO and they will get on a white horse, ride out to the infringer, and strike them down with the sword of justice. In fact, nothing will happen and the infringement will continue unless you affirmatively do something about it. Although some inventors think that the PTO plays a role in infringement situations, nothing could be further from the truth. Rather, the PTO is in the business of simply issuing patents and doing whatever ancillary functions are necessary. The patent owner must assume the full burden for stopping the infringer and obtaining damages.

If you haven't yet licensed or manufactured your invention, you may find some solace in an infringement of your patent, since it shows that your invention has at least made it in the marketplace. Keep in mind that well over 90% of patents never attain commercial success. Here, viewed broadly, are the steps you can take to complete the last step and get the remuneration you deserve:

- Ask the infringer to stop infringing and pay you compensation for the past infringement.
- Ask the infringer to pay you compensation for past infringement and royalties for future activity.
- Ask the infringer to buy your patent for a sum that will cover past infringement and the present value of future activity.
- If you're a manufacturer and the infringer has a patent of interest to you, exchange licenses with the infringer.
- Sue the infringer in federal court in the district where the infringer resides or has committed infringement (in the event your request is unsuccessful). If your suit is successful, you will be awarded damages and will also get an injunction, precluding the infringer from using your invention in the future, during the remaining term of the patent.

How much can you recover if you successfully sue for infringement? Section 284 of the patent statutes states that the court shall award damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the infringer's activity, plus interest and costs. Sometimes the court will award an infringer the profits that the infringer made if it's difficult to determine a reasonable royalty.

In addition to the above "regular" damages, Section 284 also states that the court may treble the damages and Section 285 states that in exceptional cases the court may also award attorney fees. Until the *In re Seagate Technology* case (2007 August), the standard for obtaining these enhanced damages was relatively low—the infringer had to violate a "duty of due care" when they instituted the infringing activity. In line with its recent antipatent holdings, the CAFC in *Seagate* increased the difficulty of obtaining enhanced damages by holding that the infringer had to be "objectively reckless." A patent owner now must prove the infringer knew or should have known that they were probably infringing and continued anyway; it's no longer enough to show they knew of the patent and did nothing about it.

Patent infringement damages and fees sometimes can even exceed the infringer's gross sales. In addition to monetary damages, the court can issue an injunction—an order signed by a federal court ordering the infringer not to infringe any more. If the infringer violates the injunction,

they can be subject to contempt-of-court sanctions, including imprisonment and fines.

Unfortunately our legal system, especially in the field of patent enforcement, is mainly accessible to (and manipulated primarily by) organizations and individuals with deep pockets—those companies that can afford to hire expensive patent litigators and pay the costs of litigation. One disgruntled client who got a patent and found an infringement recently said to me bitterly, "Even if it infringes, I can't afford to sue the company anyway. The patent system is mostly useless for small inventors." While this is often true, it is also often possible for little folk to obtain relief by using a contingent-fee litigator or by just implying that they will sue as described below. However, a contingent-fee litigator will not take your case unless (1) you have a fairly strong patent, (2) the infringement is relatively easy to prove or clear, (3) the damages would be substantial, and (4) the infringer has deep pockets. Nevertheless, the value of the patent system would be far more valuable if it provided a way for those with shallow pockets to enforce their patents.

J. What to Do About Patent Infringement

Let's now take a closer look at what to do if your patent is infringed.

Step 1: Obtain Details of the Infringement

If you discover what you believe to be an infringement of your patent, obtain as many details and particulars about the infringing device or process and infringer as possible. To do this, procure service manuals, photographs, actual samples of the infringing device, advertisements, product-catalog sheets, etc., plus details of the individual or company that is committing the infringement.

Step 2: Compare Your Broadest Claim With the Infringing Device

I have encountered many inventors, who, after being awarded a patent, somehow get the notion that it covers everything in the field, no matter what the claims recite. Of course, you'll know this isn't true if you understood the purpose of claims, discussed at the beginning of Chapter 9. A patent covers only what the claims recite, plus their equivalents and contributory components (see Steps 3 and 4, below). Thus you must compare your patent's claims with the physical nature of the infringing device or process.

To infringe your patent, the device in question must physically have or perform all of the elements contained in the main or broadest claims of your patent. Even if the infringing device has additional elements, it will still infringe. For example, if your claim recites three elements, A, B, and

C, and the infringing device has these three elements, it will infringe. If it has four elements, A, B, C, and D, it will still infringe. But if the infringing device has only two of the three elements, A and B, it *won't* infringe. Similarly, if the supposed infringing device has three elements A, B, and C', it won't infringe, provided element C of your claim doesn't read on element C' of the supposed infringing device. A patent claim is, in effect, a little statute that says, "If each and every one of the following elements is met, infringement occurs. If not all of the elements are met, there is no infringement. If more than all elements claimed are present, infringement still occurs."

To analyze infringement, you should make a claim chart with two columns. Break the first independent claim into its elements, each one in a respective block in the left column. In each corresponding block in the right column write a brief narrative stating why you feel the corresponding element in the left column is met by the infringing device. Refer to an attached drawing or exhibit. You need do only one independent claim that you believe to be infringed, but if you can do all independent claims, that's best. If the other independent claims differ substantially from Claim 1, you should definitely do them. A sample claim chart is shown below.

You don't need to do the dependent claims at this time. Remember that each dependent claim incorporates all of the limitations of its referent claim(s) (the claim it refers to

and any claim(s) the referent claim(s) refer to). Also, each dependent claim is considered independently of its referent claim(s), after the limitations of the referent claim(s) are incorporated. This is so even if its referent claim(s) is held invalid.

Moreover, even if your patent has 50 claims, you need prove that only one claim is infringed to prove infringement; your damages do not depend upon the number of claims that are infringed. And even if your claims don't literally read on the infringing device, there are still two ways you may be able to bag the infringer: the "doctrine of equivalents" and the "doctrine of contributory infringement."

Step 3: Determine the Extent of the Infringement and the Ability of the Infringer to Pay Damages

In order to convince a contingent-fee litigator to represent you, you must show that (a) your patent is valid, (b) it is infringed, (c) the extent of the infringement is great enough to result in significant damages (money awarded to compensate you for the infringement), and (d) the infringer has enough resources to pay the damages. With regard to (a), since your patent was examined and issued by the PTO, it is presumed valid, but if a litigator wants to make a further validity search or investigation, they'll do it or tell you what to do, so it's not necessary to worry about this now. Your claim chart (Step 2) will show whether it is infringed. To determine the extent of the infringement and the ability of the infringer to pay, you'll

Claim 1 of Smith Patent x,xxx,xxx	Peel-O-Matic Device
1. A device for peeling potatoes, comprising:	The Peel-O-Matic device (POMD) is designed to peel potatoes. See description on package (Exhibit A) which states, "Peels all produce faster." A potato is an item of produce.
a handle with a series of finger grips,	The POMD has a handle with a series of finger grips as can be seen in the lower part of the photo on the package (Exhibit A).
a head attached to said handle,	The POMD has a head attached to its handle as shown in Exhibit A.
said head having an elongated blade,	The head includes an elongated blade as also shown in Exhibit A.
said elongated blade having a longitudinal slot,	The elongated blade of the POMD has a longitudinal slot as also shown in Exhibit A.
said longitudinal slot having a pair of elongated, sharpened edges on opposite sides of said slot, said edges facing each other,	The longitudinal slot of the POMD has a pair of elongated, sharpened edges on opposite sides of the slot and these edges face each other as clearly shown in Exhibit A.
whereby said device may be securely held in one's hands by said handle without slipping and may be used to peel potatoes using said sharpened edges of said slot.	The POMD device can be held securely by its handle due to its finger grips and the sharpened edges of its slot may be used to peel potatoes.

have to do some research. Use an Internet search engine such as Google or Copernic, or consult a librarian in the Business department of a good library, and find out all you can about the infringer and the infringing product. There are services such as Bitpipe.com that have sales figures for various products and can research them. Also investment advisories and research companies such as Hoover's, Value Line, etc., can also provide many sales figures. A business school professor may be able to provide suggestions. You may have to spend several days and travel down many avenues to get enough information to present to the litigator.

Step 4: Apply the Doctrine of Equivalents

The law, recognizing that humans aren't perfect, formerly provided an out if the essence of an invention was copied, but the claims weren't literally infringed. Under the doctrine of equivalents (DoE), even if each element of a patent's claim is not literally met by an element of the device, so long as the element of the device is the "equivalent" of the claimed element, the device can still infringe that element. A device element is equivalent if it performs the same function in the same way to achieve the same result as the claim element, or the role of the device element is substantially the same as that of the claim element. However, the DoE was severely limited by the U.S. Supreme Court on 2002 May 28 in *Festo v. Shoketsu*, 535 U.S. 722 (2002). Under *Festo*, if the patentee amends a claim in any way during prosecution to make it allowable (this is almost always the case), the DoE can't be used with that claim unless the patentee can show that the narrowing amendment did not surrender the particular equivalent in question—that is, if the particular equivalent is not related to the way the claim was amended or was not foreseeable at the time. Also, if the court can't determine the reason for the amendment, the DoE will not be available.

Even without *Festo*, the DoE did not apply if "file wrapper estoppel" (also known as "prosecution history estoppel") exists—that is, the claim element was amended during prosecution to define over prior art.

EXAMPLE: Minerva Murgatroid of San Francisco has a patent on a mechanism for bunching broccoli. Its main claim recites the mechanism, including a recitation that the broccoli is banded with a wire-reinforced paper band. She didn't claim the band more broadly because she didn't read Chapter 9 and think to do so, this being the only type of band that would work at the time she got the patent.

A few years later, LeRoy Phillips of Philadelphia discovers a plastic broccoli band that will work just as well as Minerva's wire-reinforced band. He makes broccoli-banding machines and sells them, with his plastic bands, to Fred Farmer, who

uses them to band broccoli on his farm in Fresno. Minerva can sue either LeRoy in Philadelphia or Fred in Fresno. Even though her main claim doesn't literally read on LeRoy's machine—that is, describe all of its physical elements—she can win the infringement suit using the DoE, provided she didn't amend her claims during prosecution so as to invoke the *Festo* doctrine. LeRoy's plastic band is equivalent in structure, function, and result to the wire and paper band, the band material being a relatively minor change that won't get LeRoy or Fred off the hook.

However, suppose during prosecution of her patent application before the PTO, Minerva originally had broad claims to any type of band but then narrowed them to the wire-reinforced paper band to avoid a prior-art reference. In this situation Minerva is subject to the doctrine of file wrapper estoppel and may not use the DoE to rebroaden her claim. Even if Minerva merely amended her claims to make them clearer, under the *Festo* doctrine, she can't use the DoE.

The Negative Doctrine of Equivalents

There's a rarely used converse of the doctrine of equivalents, the so-called negative doctrine of equivalents. Under this, even if your claims literally read on the infringing device, but the infringing device has a different structure, function, or result than your invention, the device may be held not to infringe.

Step 5: Consider Whether a Contributory Infringement Has Occurred

If your claims don't read on the infringing device, but the infringing device is a specially made component that's only useful in a machine covered by your patent, the infringer may be liable under the doctrine of contributory infringement.

EXAMPLE: In the example above, LeRoy makes an entire broccoli-banding machine like Minerva's, except that he doesn't sell or supply any bands. Minerva's claims don't literally read on LeRoy's machine since her claims recite the band. Nevertheless, Minerva can bag Fred under the doctrine of contributory infringement, since his broccoli-banding machine is useful only in the mechanism of Minerva's patent claim and since it has no other noninfringing use.

Under new legislation, if a patent holder sues to enforce a method or process claim, a defendant can escape liability

if the defendant built and commercially used the invention more than one year before the patent application filing date. (35 USC 273.)

Step 6: Find a Patent Attorney

When you first reasonably suspect that an infringement is occurring, you should take the step, described above, and then consult with a patent attorney. (See Chapter 6, Section E.) This is because you'll need to embark on a course of action that is very difficult for the nonlawyer to perform in its entirety. Unfortunately, the cost is high, and it's difficult to get a patent attorney to take this type of case on a contingent fee (you pay them only if you win). This means you'll have to pay the attorney up front (or at least partially up front). It depends on the complexity of your case, but an initial retainer of \$20,000 would be typical. However, if you've got a very strong case and if the infringer is solvent (would be good for the damages if you win), it's possible that you may find an attorney who will take your case on a contingent-fee basis. If you do get an attorney to do this, you still may have to pay the out-of-pocket costs through trial; these can run as high as \$100,000, so be sure you can afford them. See Section T for sources of patent litigation financing and contingent-fee attorneys.

If, as will usually happen, you can't get a contingent-fee arrangement, you should be prepared for a shock: patent trial attorneys generally charge about \$350 to \$700 per hour, and a full-blown infringement suit can run to hundreds or even thousands of hours' work, most of it before trial! The American Intellectual Property Law Association, a trade group for patent attorneys, estimates the median cost of patent infringement actions through trial is in the \$5 to \$6 million range. You should be sure that your damages, if you win, will make this worthwhile. Also, be sure the defendant can pay any judgment you obtain. And don't depend on getting attorney fees or triple damages; these are awarded only in "exceptional cases"—that is, those where the defendant's conduct was "objectively reckless."

Of course, what's sauce for the goose is sauce for the gander: An infringer will usually have the same fee burden, and may be inclined to settle if your attorney writes a few letters and he or she thinks you're serious about suing. A substantial number of cases are in fact settled before suit is even brought and most are settled before trial.

Bear in mind that even though you think you have a good case and your patent is being willfully infringed, it is impossible to predict anything with certainty in the law. Factors may prevent a fair outcome so that an infringer prevails. As Len Tillem, a cynical talk-show lawyer in San Francisco stated of trials, "Whoever puts on the better show wins."



TIP

The material in the following steps is not intended to help you do your own patent infringement litigation. It would take a big book just to get you started. However, it will give you an overview of what's involved so that you can play an active role in deciding on your course of action and, if a lawsuit is brought, helping your attorney bring its prosecution to a successful conclusion.

Step 7: Write a Letter

The first step to follow in the event an infringement has occurred is to write a letter. This letter can:

- Ask the infringer to stop infringing your patent and to pay you royalties for past activity.
- Offer the infringer a license under your patent for future activity and again ask for a settlement for the past. Remember, any infringer is a potential licensee, so don't make war right away.

As is often the case, the letter may go unanswered, or your demands may not be acceded to. If so, you'll have to sue for patent infringement if you want to recover damages or an injunction. Also, if your letter creates a reasonable apprehension that you will sue them, the infringer can sue you in an inconvenient location to have your patent declared invalid under what is known as a "declaratory judgment (DJ) action." To prevent this, don't threaten to sue, but instead simply notify the infringer about your patent. Previously I advised that you could offer the infringer a license, but, under recent antipatentee decisions, many litigators feel that even this may give the infringer a reasonable apprehension of suit and enable them to file a DJ action against you.

Step 8: Act Promptly

The statute of limitations for patent infringement is six years, which means you cannot recover damages that occurred more than six years back from the date you filed suit. However, despite this rather lengthy limitations period, it's important that you not wait six years, but act rapidly once you become aware of an infringement. Otherwise, the infringer may reasonably argue that it continued to infringe because you appeared not to be concerned. Your inactivity may prevent you from collecting the bulk of the damages you would otherwise be entitled to. This would occur under the legal doctrines known as *estoppel* and *laches*, which generally mean that a court won't award you damages if your action (or lack of action in this case) in some way brought them about.

If you're selling a product embodying the invention and you failed to mark it with the patent number (see Section D, above), the six-year term of damages can be considerably

shortened as a practical matter by application of the patent-marking statute (35 USC 287). On the other hand, you can bring suit even after your patent has expired and still go back six years during the time the patent was in force (again, provided that you had some valid reason for delaying your action).

Step 9: Who Should Be Sued?

Obviously, you can sue any manufacturer who makes, uses, sells, imports, or offers for sale any device or practices any process covered by the claims of your patent. You must bring suit against the manufacturer where (1) it has a place of business, and (2) has committed an act of infringement. (If you have a process patent which covers a process used abroad to make a device that is imported into the U.S., under a new statute, the device will be considered to infringe.)

You can also sue the retailer or ultimate purchaser of the invention (including a private individual) as well as the manufacturer. Suits against the retailer or customer are sometimes brought in order to find a court that's favorable, or at least geographically close, to the patent owner. If a suit is brought against the retailer or customer of a patented invention, under the Uniform Commercial Code the manufacturer of the patented invention must step in and defend or reimburse the customer's suit. If your infringer is an out-of-state manufacturer and you can sue its local retailer, it puts a tremendous burden on the manufacturer to defend at a distance.

Lastly, don't be afraid to take on a big company simply because they have more resources to defend a patent infringement suit than you have to prosecute it. You have the right to a jury trial (see Section O, below), which helps equalize the odds.

If the Infringer Has a Government Contract

If the infringer of your patent is a company or individual who's making products embodying your invention under a government contract, you can sue only the government in the Court of Claims in Washington. You can't sue the company and you can't sue in your local jurisdiction. Moreover, you can't get an injunction prohibiting the company from manufacturing your invention, since the infringing device may be useful for national defense. In other words, we have compulsory licensing of any patent that covers an invention used by the government. You can, however, recover damages and interest.

Note that if you assert patent rights, your opponent may cite prior art including (a) any publication, including

a patent, that was published before your filing date, or (b) a U.S. patent that was filed on any date before your filing date. If this prior art anticipates or renders your invention obvious, it will defeat your right to sue unless you can prove (1) you conceived the invention before the date of a or b and you were diligent in filing your patent application or building and testing the invention, or (2) you built and tested the invention before a or b.

See the article, "The Truth About Patent Litigation for Patent Owners Contemplating Suit," by Vanderburg, at page 331 of the *Journal of the Patent and Trademark Office Society* for 1991 April.

Step 10: Consider Stopping Importation of the Infringing Device

If a device covered by your invention is being imported into the U.S. and the effect of such importation is to harm a domestic industry, you can bring a proceeding before the International Trade Commission to have the device stopped at the port of entry. This proceeding can be brought in addition—or as an alternative—to any other legal action. While such a proceeding is complex and expensive, it provides a remedy that is extremely powerful. The pertinent statute is 19 USC 1337(a), and two articles about ITC actions can be found in the *Journal of the Patent and Trademark Office Society* for 1979 Mar., page 115, and 1984 Dec., page 660. (It used to be possible to hire the U.S. Customs and Border Protection (CBP) service to make an import survey to determine the address of any importer whose goods appear to infringe, but CBP discontinued this service in 2004 due to lack of demand. CBP still maintains a trademark registration system to prevent importation of goods with infringing trademarks. For information go to CBP's site, www.CBP.gov.)

Design Patent Infringement

Under the *Egyptian Goddess, Inc. v. Swisa, Inc.* case (CAFC, 2008 Sep 22, 498 F.3d 1354), design patent infringement is determined by the "deceived purchaser" test: The court will hold the design patent infringed if the defendant's accused design could reasonably be viewed as so similar to the patented design that a purchaser familiar with the prior art would be deceived by the similarity between the claimed and accused designs, "inducing him to purchase one supposing it to be the other." (The previous test—known as the "point of novelty test"—has been abandoned.) As in most evidentiary trials, both sides will call in their "hired guns" (experts) to testify for their side.

Patent Trolls and Submarine Patents

You may have heard of the terms “patent troll” and “submarine patent” recently. What do these terms mean and how do they affect inventors?

As well defined by Wikipedia, “patent troll” is “a pejorative term for a person or company that enforces its patents against one or more alleged infringers in a manner considered unduly aggressive or opportunistic, often with no intention to manufacture or market the patented invention. Less pejorative synonyms are *nonpracticing entity*, *patent assertion company*, *non-manufacturing patentee*, *patent marketer*, and *patent dealer*, which describe a patent owner who does not manufacture or use the patented invention. Under the U.S. and most other patent systems, patentees are not required to—and feel that their rights should not be lessened if they don’t—practice their inventions. Many inventors are very creative but are not business oriented and would like their creativity rewarded fully even if they don’t commercialize their inventions. Thus if you have a patent but don’t practice the invention, I suggest you consider yourself no less worthy than a patentee who manufactures the patented invention.

Wikipedia defines the related term “submarine patent” as “a patent first published and granted long after the initial application was filed... [I]t stays under water ... for long periods, then emerges ... and surprises the relevant market.” I believe that few, if any, submarine patents ever issued. However under present U.S. law, where supplemental cases (divisions, continuations, and CIPs) expire 20 years from the date of the original application, any patent that is significantly delayed by being a supplemental case will have a much shorter in-force period. If you obtain a patent after delay due to one or more supplemental cases, I similarly suggest you consider your patent no less worthy than a patent which issued directly from the first filing.

Remember that in both situations (patent troll and submarine patent), any relevant patent already covers a significant advance in the art since it issued only after the PTO found that the claims defined a useful, novel, and unobvious invention. Remember also that the U.S.’s greatness is due in large part to the creativity and contributions of independent inventors. I favor not abridging their rights if they choose not to engage in business activity.

If You Discover an Infringement During Pendency

You may recover a reasonable royalty for an infringement during the pendency of your application, but you must wait until the patent issues to sue for such royalties and the royalty will only be applicable to infringements that occur after the publication of the application. You must also notify the infringer of the published patent application (PubPA) and the infringing device or process must be substantially identical to the invention as claimed in the PubPA. (35 USC 154(d).) The royalty you receive will be applicable to any infringements that occur after the publication of the application.

If you filed a Nonpublication Request, you should rescind it in order to have your application published so that you can take advantage of this “royalties before issuance” statute. If you discover the infringement well before the normal 18-month-after-filing publication date, you may request that the application be published earlier than 18 months by requesting same and paying the publication fee. (Rule 219 (37 CFR 01.219).)

K. Product Clearance (Can I Legally Copy or Make That?)

This is the other side of the coin: Here I’ll assume that, instead of having your own invention, you’re interested in copying the invention or product of someone else or making a new product that you feel may be covered by someone else’s patent. What can you legally do and how do you find out?

1. Common Misconceptions

Before giving you the applicable rules and information, first I want to dispel some widespread misconceptions so you’ll start from neutral territory.

Common Misconception: If you make an identical copy of a device or circuit, you can be validly sued for infringement, even if the copied device is not patented.

Fact: You are free to copy any device or circuit, even to the minutest detail, so long as you do not infringe any applicable patent, trademark, or copyright, and so long as you don’t copy any features that have a “secondary meaning.”

Common Misconception: If a product is not marked “Patented” and it does not have a patent number, you are free to copy the product, since the law requires patented products to be marked with the legend “Patented” and the patent number.

Fact: Patented products don’t have to be marked as such: See “Patent Number Marking” (Section D).

Common Misconception: If a product that you intend to make is shown in the drawing of another’s patent, you would be an infringer of that patent if you made the product.

Fact: Only the claims of a patent determine infringement. (See Chapters 9, 13, and Section J, above.)

Common Misconception: That which you do in your own home or for your own personal use will not infringe a patent that is otherwise applicable.

Fact: While “home infringement” may be difficult to detect, nevertheless it is a form of infringement that is legally actionable and can subject the infringer to paying damages and/or an injunction prohibiting further infringement.

Common Misconception: If you change a patented product a fixed percentage, say 20%, you won’t be an infringer.

Fact: The amount you’ll have to change a patented product to avoid infringement is not subject to quantitative analysis, but rather is determined by the breadth of the patent’s claims. (See Section J, above.)

2. Find Out If There’s an Applicable Patent and Whether You Will Infringe It

Suppose you do want to manufacture a specific product or perform a specific process commercially, and you have some reason to believe it may be covered by an in-force patent or pending application. Under the law, you have a duty of due care to determine whether or not you infringe any in-force patents. *Knorr-Bremse v. Dana Corp*, 383 F.3d 1337 (Fed. Cir. 2004). How can you fulfill this duty and determine whether you can proceed without infringing any existing or future patent?

Unfortunately, there is no way to be 100% sure, because no search can cover pending patent applications. However I can give you some pretty specific instructions and guidelines.

If the process or product you wish to duplicate is already manufactured or used, look at the product, the literature accompanying it, and the packing material, to see if any patent number is given. If you can get the patent number, download it from the PTO website (see Chapter 6, Section H) or order the patent from the PTO or a private service. If

the patent issued before 1995 Jun 8, it expired (or expires) 17 years from issue; if it issued after 1995 Jun 8, it expires 20 years from its filing date, or the filing date of any parent cases from which it originated, whichever is sooner. Here’s a rough guide that will help you make a rough determination as to when any patent issued: Patent No. 1 issued in 1836; No. 100,000 in 1870; No. 500,000 in 1893; No. 1,000,000 in 1911; No. 1,500,000 in 1924; No. 2,000,000 in 1935; No. 2,500,000 in 1950; No. 3,000,000 in 1961; No. 3,500,000 in 1970; No. 4,000,000 in 1977; No. 4,500,000 in 1985; No. 5,000,000 in 1991; No. 5,500,000 in 1996; No. 6,000,000 in 1999; No. 6,500,000 in 2001; No. 7,000,000 in 2006, and No. 7,500,000 in 2009, and No. 8,000,000 will issue in 2011.

If the patent is in force, things usually aren’t as bad as they seem. Often a patent that supposedly covers a product in reality may cover only a minor aspect of the product (such as the housing) that is easy to design around. Sometimes the patent doesn’t cover the product at all. How can you be sure? The only way is to read its claims carefully, diagramming them and preparing a claim chart, if necessary, to know exactly what they cover. (See Section J, above.) If what you want to manufacture is not covered by the claims, and if you feel there is no other patent on the item you wish to manufacture, you are free to do so.

If the product or process you wish to manufacture is simply marked “Patented” and carries no number, your task is more difficult. You can write to the company, asking for the number and date of their patent, or whether their patent is in force, but they’re not bound to answer, and you’ll have tipped your hand by communicating with them.

You can have a (relatively cheap) search made in the PTO or on its website of all of the patents issued to the company in question (see Chapter 6, Section H). But there is no guarantee that this will uncover the manufacturer, since the patent may not be owned by the company in question; the manufacturer may simply be a licensee. The best way to determine whether an in-force patent is applicable is to make a search in the relevant classes and subclasses of the PTO (see Chapter 6), have someone make the search for you, or search on the Google or PTO sites. The search should seek to find any patent on the invention in question. This will involve a greater expenditure of time or money, but at least you will be fairly certain of your position. If, however, there is a patent pending on the product or process, there is no way to obtain any details, even if the manufacturer marks the product “patent pending”; thus, not all risks can be eliminated.

If the product or process you wish to manufacture has been known or used in the marketplace for over 17 years, you can be pretty sure that no in-force patent will be applicable, or that even if one is applicable, it is just about to expire anyway.

If you can't find any U.S. patents and the product or process is relatively new, you shouldn't feel free to copy it because it may be the subject of a pending patent application. It's not possible to search pending U.S. patent applications, since they're kept secret unless they are published 18 months after filing. You can search published U.S. applications and you can often find some pending U.S. applications by searching for published corresponding foreign applications, which are all published 18 months after filing. (To search published foreign applications, use one of the database searching services listed in Chapter 6, Section H.) Also, if the probable owner of a patent application you want to research has been selling the product under a trademark, such as "the Zorch widget," investigate the item in the PTO (trademark applications are not kept secret) to obtain the date of first use of the trademark in the United States. It's likely that the filing date of any patent application is just before the date of first trademark use.

If you find an applicable in-force patent or patent application, and you don't think you can break it, avoid it, or get a license at a reasonable royalty, consider designing around the patent or using older (nonpatented) technology.

3. What to Do If an In-Force Patent Is Applicable

If there is an in-force patent applicable, and you still wish to manufacture the product, you have several alternatives:

- Although I don't advise it, some companies manufacture or use the product or process and hope that the patentee won't catch them. When they do this, they usually follow a good accounting practice, by keeping reasonable royalty reserves (see Chapter 16 for what is a reasonable royalty) in case they're ever caught. Also, they usually analyze the patent, or have a patent attorney do so, to see if there are any good defenses to show that they were not a "willful" infringer, since willful infringers may be subject to triple damages or attorney fees in a lawsuit. They must always be aware that the patent owner may discover the infringement, and sue them, and get an injunction prohibiting further manufacturing. Although the idea of manufacturing without a license may seem deceitful, risky, and inadvisable, it is done frequently in the U.S. (but not commonly in Japan). The infringer simply takes the full-speed-ahead-and-damn-the-torpedoes attitude and hopes to be able to negotiate a favorable settlement or break the patent if caught.
- You can ask the patent owner for a license to manufacture under the in-force patent. However, here you take the risk, if you aren't familiar with the

patent owner's practices, of being refused a license. Moreover, you'll have shown your hand, so that if you do manufacture, the patent owner will be looking out for you and will certainly sue or accuse you of willful infringement in short order.

- You can make an extended validity search to try to "break" the patent. You should use a professional, experienced searcher to do this and should expect to spend several thousand dollars in order to make the widest and most complete search possible. Also, you should order a copy of the PTO's file of the patent (see Fee Schedule for cost) to see if there are any weaknesses or flaws in the patent that are not apparent from the printed patent itself. Again, the services of an experienced attorney should be employed here, because breaking patents requires a highly skilled practitioner. If the attorney feels that the patent can be invalidated or is not infringed, you can have them write a "green-light letter" to you, explaining in detail why it would not be likely that you would be liable for infringing the patent. This letter can show you are not a willful infringer and thus avoid treble damages or attorney fees if you are sued.
- If you find highly relevant prior art, you can bring it to the attention of the patent owner and ask it to disclaim or dedicate the patent to the public. Or, you can send the art to the PTO to be put in the file of the patent (35 USC 301) or apply to have the patent reexamined (35 USC 302; see Section N, below).

Defending Against Method (Process) Claims

Effective November 1999, if you are commercially using a method or process that has been patented by someone else and your use preceded the patent's filing date by more than one year, you have an absolute defense against an infringement charge. However, this defense is personal to you and will generally not invalidate the patent. (35 USC 273.)

- Your last alternative is to review the claims of the patent and then try to design around them. Often you will find that the claims of a patent, upon analysis, have one or more limitations that can be eliminated in your product or process so that you can make the patented invention even cheaper than the patentee. Alternatively, you can design around one of the elements of the patent, make an improved device, and get your own patent on

it. Remember, if you don't infringe the independent claims, you won't have to worry about the dependent claims. (See Chapters 9 and 13, and Section J, above.)

4. If No In-Force Patent Is Applicable

Unless there is an in-force patent covering an item, anyone is free to make and manufacture identical copies of it, provided:

- one doesn't copy the trademark of the product
- the shape of the product itself is not considered a trademark (such as the shape of the *Fotomat* huts), and
- you don't copy "secondary meaning" features. (See Chapter 1.)

If you buy a product from another in the course of business, your vendor is obligated to indemnify you for any such infringement under the Uniform Commercial Code. However, you can be sued for infringement and be liable for damages. (Hopefully, your vendor will be around to reimburse you.) You can also be subject to an injunction ordering you not to infringe any more.

One manufacturer's effort to copy a small hardware item by having it manufactured cheaply in the Orient backfired. He sent the item overseas with instructions to make several thousand identical copies of the item. Since he didn't give any further instructions, the Oriental manufacturer did as instructed, manufacturing and shipping back several thousand copies of the item, including a faithful copy of the embossed trademark of the manufacturer's competitor. The manufacturer then had to spend significant money obliterating the trademark, thereby losing his entire profit in the process.

L. Citing Prior Art Against Patent Applications and Patents

Suppose you're aware of prior art that would affect a patent or patent application and you want to make the PTO or the public aware. Perhaps you want to get the art in the file of your own patent or application to get it behind you and show your good faith and put forth your arguments as to why it doesn't invalidate your claims. Or maybe you are manufacturing (or contemplating manufacturing) something based on the invention and you don't want someone to get a patent on it. Or possibly you just want to do it as a public service to prevent an improper patent from issuing or cast a cloud on a patent you know was improperly issued. How do you apprise the PTO or the public of this prior art?

There are five ways that you can cite prior art relevant to your own or someone else's patent or patent application:

1. File a passive citation against your own patent application (Rule 97).
2. File a passive citation against a published patent application (Rule 99).
3. File a protest against a pending application (Rule 291).
4. File a passive citation against a patent (Rule 501).
5. Request a reexamination (Rules 510 and 902).

Let's examine each of these in more detail.

1. File a Passive Citation Against Your Own Patent Application (Rule 97)

As part of your "duty of disclosure" under Rule 97 you are required to provide an Information Disclosure Statement (IDS) in which you cite prior art that you are (or become) aware of, against your own application. (I include it here for the sake of completeness. There is no fee if you timely file the IDS. For more information, see Chapter 10, Section G.) Once your patent issues, this obligation ends, although it would be considered highly improper and subject you to sanctions to sue on a patent that you know is invalid.

2. File a Passive Citation Against a Published Patent Application (Rule 99)

Under Rule 99, anyone can cite prior art against a published patent application. The PTO will enter the citation in the application file if it includes a fee (see Appendix 4, Fee Schedule), a list of the citations, and a copy of each citation. (The relevant portions of non-English citations must be translated.) A copy of the citation must be sent to (served upon) the applicant. The person filing the citation should not explain the relevance of the citations. There is no fee, but the citation must be filed within two months after the application is published or prior to a Notice of Allowance, whichever is earlier.

3. File a Protest Against a Pending Application (Rule 291)

Under Rule 291, anyone can protest any pending application before it has been published or allowed. The protest must be filed with the PTO (no fee required) and a copy must be served upon the applicant. If the protestor does not know the address of the applicant, they must file two copies with the PTO. If the protest is made on the basis of prior art, it must include a list of the prior art, copies of the art, and an

explanation of the relevance of each citation. (The relevant portions of non-English citations must be translated.) If the protest is made on some other basis, such as fraud or improper inventorship, it will be put in the file without any further action. The protest should identify the application as completely as possible. No fee is required and the PTO will not communicate further with the protestor, except to return the usual postcard if one is included with the protest. If you don't know the serial number, filing date, and/or name of the inventor (the usual case), you should identify the application with as much information as you can.

4. File a Passive Citation Against a Patent (Rule 501)

Under Rule 501, anyone can cite prior art in the file of a patent. (If the patentee makes the citation, it must include an explanation of the pertinence of the art and how the claims differ from the art.) The person making the citation can make it anonymously and should send copies to the PTO (no fee required) and the patentee, or should file it in duplicate with the PTO. No fee is required.

5. Request Reexamination (Rules 510 and 902)

Anyone can cite newly discovered prior art against a patent and have it reexamined. There are two types of reexamination, *ex parte* (one party) under Rules 510 et seq., and *inter partes* (two parties) under Rules 902 et seq. As reexamination procedures are relatively complicated and the PTO fees are expensive, I suggest you consult an attorney if you want to institute a reexamination.

M. The Court of Appeals for the Federal Circuit (CAFC)

Full-blown patent infringement suits are very expensive and can cost each side hundreds of thousands, and even millions, of dollars in attorney fees, travel, and deposition expenses, witness fees, and telephone and secretarial expenses. Also, patent litigation can take one to ten years to complete. Thus, litigation favors wealthy or large corporations, which are far better equipped to defend and maintain patent infringement suits than a single individual. In the past, if you discovered an infringement, it was usually to your advantage not to sue and to accept a settlement that was less than you thought you were owed. In short, "gold ruled the law."

In the 1980s, the pendulum swung back in favor of the patent owner, primarily because of several important

statutory and common-law changes. One of these was the creation of the Court of Appeals for the Federal Circuit (CAFC) to hear all patent appeals. It is headquartered in Washington, DC, but it sometimes travels around the U.S. to hear appeals in major cities. Previously, appeals of patent cases were decided by the various Circuit Courts of Appeal covering the area of the country where the trial court (the relevant U.S. District Court) was located. The result was a patchwork quilt of inconsistent patent decisions. In the 1980s the CAFC was considered to be pro-patentee, but in the years since 2005, the CAFC appears to have turned strongly anti-patentee. Commentators claim that the CAFC looks for any reason it can find to reduce the rights of patentees by invalidating claims and interpreting them very narrowly. While it is beneficial to have one court now decide all patent appeals—it creates a uniform body of patent law—unfortunately this body of law has not favored inventors. The Supreme Court appears to be following this course, as well.

In *eBay v. MercExchange* (2006), the U.S. Supreme Court held that even if a court finds that a patent is valid and infringed, the patent owner is not automatically entitled to a court order enjoining further infringement. Under the Supreme Court's ruling, a trial court shouldn't issue an injunction unless the patent owner shows a balance of equity in its favor—for example, the patent owner is selling products employing the invention and would be damaged by letting the defendant continue to infringe. Before this ruling a company would be more inclined to cave in to the demands of a patent holder because of fears that an injunction would be granted automatically.

But this is not the full extent of the damage. The CAFC's opinions have also been regarded as confused and conflicting. Consider what one eminent authority, Professor Irving Kayton of George Mason University, has said:

"80% (and increasing) of litigated patent claims in recent years have been held not infringed or invalid for violation of the written description requirement of Section 112, paragraph 1, the blame for which Federal Circuit panels chronically place upon the shoulders of ex parte patent practitioners, to the exclusion of its own chaotic claim construction opinions which have become the subject of ridicule among many federal district court judges and at least one of the Federal Circuit's own sitting members.... [There have been] multitudinous conflicting and confusing dictates of the [CAFC's] opinions ... during the past ten years."

One judge on the CAFC was so disgruntled with the CAFC's actions that he bitterly said, in a dissent in *Phillips v. AWH Corp. et al.*, 2005 Jul 12, "The court's opinion today

is akin to rearranging the deck chairs on the Titanic—the orchestra is playing as if nothing is amiss, but the ship is heading for Davy Jones’ locker.”

In the *Phillips* case the court revised the rules for determining the meaning of terms in a claim as follows. To interpret the meaning of a crucial term in a claim, use the following procedure:

1. As a baseline, determine the meaning of the term to a person with ordinary skill in the art; other sources can be referred to for this.
2. See if the context of the term in its claim and other claims sheds light on the term’s meaning. That is, if the term is used broadly in an independent claim, such as “a baffle” and a dependent claim states that the baffle is inclined, this indicates that the baffle should not be interpreted as being inclined in the independent claim.
3. Refer to the specification to interpret the term. If the specification defines the term, this is controlling.
4. Look at the prosecution history; this can be useful but less so than the preceding factors.
5. Lastly, refer to extrinsic evidence, such as dictionaries, treatises, and testimony of experts. Less reliance should be placed on extrinsic evidence than in the past. The limitations in the specification should generally not be imported into the claims. For example, if the specification shows a baffle that is inclined and the claim simply recites a baffle, the baffle should not be limited to inclined baffles.
6. If a claim is ambiguous, it should be construed in a manner that sustains its validity. If a claim recites a means which includes some hardware—for example, “means comprising a baffle”—the means clause is not restricted to the part described in the specification and its equivalents and should be interpreted more broadly.

N. Using the Reexamination Process to Reduce the Expense of Patent Infringement Suits

Despite the sad situation at the CAFC, a positive and valuable statutory change has been the reexamination process (35 USC 302) in which the PTO can be asked to reexamine any in-force patent to determine whether prior art newly called to its attention knocks out one or more of the patent’s claims. How does this help the patent holder? Suppose the patent holder decides to go after an infringer. Very soon after the first letter is sent, or suit is filed, the infringer will likely make a search and tell the patent holder

of prior art that the infringer feels invalidates one or more claims in the patent. Formerly, if it still thought its patent was valid, the patent holder had to push ahead with an expensive patent infringement lawsuit and hope that the U.S. District Court judge (who is often unfamiliar with patent principles) would decide its way instead of for the infringer.

Now, instead of leaving the matter up to the judge, anyone can request a reexamination by the PTO. The party requesting the reexamination can participate in the reexamination process, and has the right to appeal any decision in favor of the patentee. The PTO will reexamine the claims in light of the prior art and either issue a certificate of patentability, or unpatentability. A reexamination is better for an infringer than for a patentee because the standard to prove patent invalidity is a preponderance of the evidence, while in litigation invalidity must be proven by clear and convincing evidence. In the case of the former, this opinion will weigh almost conclusively in favor of the patent holder in any ensuing litigation and quite often will lead to a favorable settlement beforehand. In the event the latter occurs (certificate of unpatentability), the unpatentable claims will be canceled automatically by the PTO. While this will not result in victory for the patent holder, it will save time and money that otherwise would have been spent haggling in court.

The reexamination process can also be used to your advantage if you’re accused of infringement. By obtaining a PTO certification that the patent holder’s claims are unpatentable over the prior art, you may save yourself an expensive defense in court.

To institute a reexamination of any patent, anyone can file a request, together with the patent number, prior art, and the fee. (See Fee Schedule.) The fee appears huge, but is small compared with the expense of litigation. If the PTO feels that the prior art is relevant, it will conduct the reexamination. The reexamination can be conducted *ex parte* (only the requester can file briefs) or *inter partes* (both sides can file a brief setting forth their arguments). If the PTO feels the newly cited art isn’t relevant, it will terminate the proceeding and refund a large part of the fee.

O. Jury Trials

Most juries love individual patent holders and have awarded very large damages in patent infringement actions, especially where an individual patent holder has sued a large corporation. Thus, if you sue on a patent, always demand a jury trial: most juries usually award more than a judge will. Be aware, however, that the Supreme Court

in *Markman v. Westview Instruments, Inc.*, 116 S.Ct. 1384 (1996), has removed juries' powers to interpret claims and hence reduced their power to decide the issue of infringement.

P. Arbitration

Instead of a lawsuit, if both parties agree, the entire infringement dispute can now be submitted to arbitration. In this case, an arbitrator, usually a patent attorney or retired judge, will hear from both sides in a relatively informal proceeding. The arbitrator will adjudicate the patent's validity, infringement, etc. The arbitrator's fee (about \$10,000 to \$50,000 and up) is far cheaper than the cost of a regular lawsuit complete with depositions, formal interrogatories, and other formal proceedings. In addition, it's much faster. The arbitrator must file the award with the PTO. The American Arbitration Association is frequently used and has rules for arbitration of patent disputes, but the parties can use any arbitrator(s) they choose.

Q. How Patent Rights Can Be Forfeited

Patents and their claims can be and often are retroactively declared invalid or unenforceable by the PTO or the courts for various reasons, such as:

- relevant prior art that wasn't previously uncovered (Chapter 6)
- public use or sale of the invention prior to the filing date of the patent application (Chapter 5, Section E)
- misuse of the patent by its owner—for example, by committing antitrust violations, and
- fraud on the PTO committed by the inventor—for example, by failing to reveal relevant facts about the invention and the prior art (Chapter 10, Section E4).

In addition to losing your patent rights, you may discover that what you thought was a broad claim is so narrow as to be virtually useless. Generally, you'll discover this when your airtight infringement action goes down the drain when the PTO or the judge declares your patent noninfringed.

Most people are surprised to learn that patents, although duly and legally issued, can be declared invalid, nonenforceable, or noninfringed. In other words, a patent isn't the invincible weapon many believe it to be. Rather, a patent can be defeated if it has weaknesses or if it isn't used in the proper manner. Still, 50% of patents that get to court are upheld. In addition, the percentage of patents that are treated as valid is higher than the court statistics

indicate, since they don't count the many patents that don't get to court because the infringers saw the impossibility of invalidating them or didn't want to spend the \$250,000 or more necessary to fight the patent.

An accused infringer of a patent can avoid liability (that is—defend against the infringement action) in three different ways:

- by showing that the claims of the patent aren't infringed
- by showing that the patent isn't enforceable, or
- by showing that the patent is invalid.

With regard to the first, noninfringement has already been covered above in Section J.

Under the second, a patent can be declared nonenforceable if the owner of the patent has misused the patent in some way or has engaged in some illegal conduct that makes it inequitable for the owner to enforce the patent. Some examples of conduct that will preclude enforceability of a patent are:

- false marking (marking products with patent numbers that don't cover the product marked)
- illegal licensing practices, such as false threats of infringement
- various antitrust violations, such as package licensing
- extended delay in bringing suit, which works to the prejudice of the accused infringer, and
- fraud on the PTO, such as withholding a valuable reference from your Information Disclosure Statement, or failing to disclose the full and truthful information about your invention in your patent application. (See Inventor's Commandment 17 in Chapter 10.)

Third, the validity of the patent being sued on can be challenged by:

- prior-art references that the PTO didn't discover or use properly
- proof that the specific machine covered by the patent is inoperable
- a showing that disclosure of the patent is incomplete, that is, it doesn't teach one skilled in the art to make and use the patented invention
- a showing that the claims are too vague and indefinite under section 112, or
- a showing that the patent was issued to the wrong inventor, etc.

As you can imagine, the subjects of patent nonenforceability and invalidity are also complex and difficult. In fact, it has been said that if enough money is spent, almost any patent can be "broken." However, patents are respected in many quarters and, as stated, billions of dollars change hands in the United States each year for the licensing and sale of patent rights.

R. Your Patent Is Subject to Interference for One Year

For one year following the issuance of your patent, you are potentially subject to losing it if another inventor who has a pending application on the same invention can copy your claims in their application and can get the PTO to declare an interference. If the other inventor wins “priority” in the interference—that is, the PTO finds that the other inventor “reduced the invention to practice” (built and tested it or filed a patent application) before you, or conceived it first and was diligent in effecting a reduction to practice—you’ll effectively lose your patent or any claims in issue. While conflicts between patent applications and in-force patents are relatively uncommon, they do occur, due to the failure of the examiner to spot the interfering application before your patent issues. (See Chapter 13, Section K, for more on this.)

S. Tax Deductions and Income

I include this brief section because, unfortunately, most inventors give no thought whatever to taxes, either with regard to the money they spend to get their patents, or to the money they make when they sell or license their patents. I say “unfortunately” because the government will effectively subsidize your patent expenses by allowing you to deduct them. Because of space limitations, I can’t provide a full guide to all of the patent-tax rules, but here are the basics. You should consult a tax professional or the IRS for the final word:

1. You can legally deduct your patent and invention expenses (i.e., the cost of this book, patent searches, drafting and attorney fees, PTO fees, technical research, models, experimentation and testing, up to \$25,000 of depreciable property, etc.) if the IRS considers that your inventing constitutes a trade or business. If you buy depreciable property above the \$25,000 limit, you must depreciate this over its useful life. If you meet the trade or business test, you’re in luck: You can deduct any net Schedule-C loss against your other (ordinary) income. However if the IRS considers that your inventing is a hobby (that is, you’re a dilettante) they will allow you to deduct your patent and invention expenses only against any income that you receive from the hobby. What do you have to do to meet the trade or business test? The taxman will consider that you have engaged in a trade or business if you can show that you have been serious, diligent, and have spent substantial time on your invention

activities. In other words, Uncle Sam will give you a passing grade if you kept careful records, had a model made, did prior-art and marketing research, made substantial efforts to sell or license the invention, acted in a businesslike manner, etc.

2. If you license your invention on a nonexclusive basis (see Chapter 16), you haven’t given away all of your rights, so your royalties are considered ordinary income. Report on Schedule C or Schedule E.
3. If you sell all of your patent rights, or grant a full exclusive license, the IRS considers that you’ve sold it all; your receipts or royalties, even though received over a long number of years, are considered capital gains; report on Schedule D.

T. Patent Litigation Financing

Because of the high cost of litigation, cost assistance (at a price) is now available from several companies. Lloyds of London (www.lloyds.com) and Intellectual Property Insurance Services Corp. (www.infringeins.com), 9720 Bunsen Parkway, Louisville, KY 40299, 502-429-8007, write policies directly. These companies will, in return for an annual premium, reimburse part or all of the cost of patent enforcement litigation, up to the policy limit. You can even begin coverage while your patent application is pending. However, some companies may have a less-than-optimum rating and some may require you to jump through difficult hoops, such as getting an infringement and validity opinion from an independent attorney, before they will reimburse your expenses.

Below are some companies and firms that finance contingent-fee patent litigation. Carefully investigate any company before engaging them. Also, as stated, most litigating attorneys will take on contingent-fee litigation if the damages are substantial, the defendant has a deep pocket, and the patent is strong and clearly infringed. Below are just a few of the many litigating patent attorneys and services who have handled contingent-fee litigation. These listings do not imply any form of endorsement or recommendation of these attorneys or their services.

- Enpat, Inc. (www.enpat.com)
- General Patent Corporation International, (www.patentclaim.com)
- Patent Enforcement and Royalties Ltd. (www.Pearlltd.com)
- Costello, John P., Esq. (patents@cwnet.com)
- Hosteny, Joe, Esq. (jhosteny@hosteny.com)
- DiPinto & Shimokaji (shimokaji@dsattorneys.com)
- ThinkFire Services USA, Ltd. (info@thinkfire.com)

- America Invents (www.AmericaInvents.com).
- James Sokolove, Esq. (www.jimsokolove.com/other/patent-infringement/index.aspx)
- IP Contingency Consortium (www.ipcontingency.com)
- Acacia Technologies Group (www.AcaciaTechnologies.com).



RESOURCE

Nolo Lawyer Directory. Nolo maintains a lawyer directory (www.nolo.com/lawyers) with links to many patent and intellectual property attorneys.

If you want to sell your patent, Ocean Tomo (www.OceanTomo.com) holds auctions of patents and also provides other patent fiscal services.

Also, if you're sued for patent infringement, your own general liability insurance may reimburse you for the cost of defending the suit; see the article about this at p. 527 of the *Journal of the Patent and Trademark Office Society* for 1991 July.

U. Summary

After you pay the issue fee, the PTO will print your patent and send you an Issue Notification and then the deed in a few months. It may be helpful to prepare a press release or advertise your patent for sale at this time. Check your patent for printing or other errors and obtain a Certificate of Correction if necessary. If the error is yours, the PTO charges a fee for issuing a Certificate. If you or a licensee is manufacturing a product under the patent, consider marking the product with the patent number. If you mark you can recover damages from infringers from the date you started marking, but they will have easy access to your patent number and may be more inclined to break your patent or design around it. A patent is intangible personal property that gives you a monopoly on the invention covered by the claims (so long as maintenance fees are paid), against anyone who makes, uses, sells, imports, etc., the invention. You can profit from a patent by selling or licensing it or using it to exclude others to create a monopoly (with higher prices) for yourself. However patents on medical procedures are no longer enforceable against health care providers. Patentees get offers for goods or services, but most are of no value.

Be sure to pay the three maintenance fees to keep your patent in force: The first is due 3.0 to 3.5 years after issue

(YAI), the second 7.0 to 7.5 YAI, and the third 11.0 to 11.5 YAI. If you neglect to pay any fee in the due period you may pay it in a grace period (next six months) with a surcharge and thereafter if the delay was unintentional (two-year limit) or unavoidable. However if you pay it after the grace period any infringer will acquire intervening rights.

If you discover an infringer the PTO will not help you; you must contact and sue the infringer. First get details of the infringing product, the company that makes it, including the amount of product sales, and the financial resources of the company. Then, compare your claims to verify infringement (be aware of the doctrine of equivalents and contributory infringement), write a letter, and sue in court or with the ITC if necessary.

To determine if you can make a product it is usually necessary to make a subject-matter search for applicable in-force patents. If an in-force patent is applicable you can design around the patent, ask for a license, or try to break the patent.

There are five ways to cite prior art against patent applications and patents:

- the usual IDS citation against your own patent application
- citation against a published patent application of another
- protest against any pending application
- citation in the file of a patent
- file a request for reexamination (ex parte or inter partes)—reexamination can be used to invalidate a patent if new prior art is discovered.

All patent appeals must go to the Court of Appeals for the Federal Circuit, which has turned antipatentee in recent years. Juries no longer have the power to interpret patent claims, but they can otherwise be propatentee. Arbitration is an alternative to patent infringement lawsuits. Patent rights can be forfeited in various ways, e.g., if relevant prior art or a prior public use or sale is discovered, the patent is misused, or the patentee committed fraud on the PTO by not citing prior art that it knew of.

Up to one year after your patent issues anyone with a pending application on the same invention can get into interference with your patent. Patent expenses can be deducted from ordinary income if you're a serious inventor, or otherwise just against royalties. Insurance is available to finance patent litigation and companies and attorneys are available to finance patent infringement litigation on a contingency basis.

Ownership, Assignment, and Licensing of Inventions

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Inventor's Commandment 31

File a patent application in the names of all actual inventors, but no one else. To transfer part or the entire ownership of an application or patent, the inventor-applicant(s) must sign an *assignment*, and to give permission to practice a claimed invention, they must use a *license agreement*.

Inventor's Commandment 32

If a patent has several owners, absent any agreement to the contrary the law permits any owner to practice the invention without accounting to any other owners. All joint owners should thus consider signing a Joint Owners' Agreement requiring cooperation and sharing of any profits from the patent.

In the simplest possible situation, a single inventor invents something, obtains a patent on it, manufactures it, and markets it directly to the public for the full period that the patent remains in force. In most instances, things are not that simple. Two or more people may be involved in the conception of the invention, and many more in its development and marketing. A business may want to use the invention and be willing to pay large royalties for the privilege. Employees and employers may disagree over who owns a particular invention that was developed at least partially on company time or with company materials or facilities. Thus, the entire question of invention ownership and utilization can become complex.

In this chapter, I outline some of the ways to deal with these various ownership questions and the common agreements that are used in the process. However, because the subject of invention ownership, licensing, and transfer is complicated, you'll probably want to retain a lawyer, if only to review your plans and paperwork.

A. The Property Nature of Patents

Before I begin explaining who owns an invention, it might be helpful to review exactly what patent ownership means. Think of a patent as a valuable property right. This right, as I've stressed elsewhere in this book, gives you the right to exclude others from manufacturing, using, selling, and

importing your invention. This means that you have, in effect, an enforceable legal monopoly on the invention for the in-force period of the patent. If you do grant a company permission to use your invention, the law terms this permission a "license." As with most other intangible economic rights—such as the right to operate a business, the right to withdraw money from a bank account, and the right to vote stock in a corporation—patent rights, or a portion of them, can be sold to others, or licensed for a particular use over a particular period of time.

An invention has virtually no economic value to its inventor unless it is patented, sold, licensed, or used as a trade secret, or it has some other protection under intellectual property laws (see Chapter 1, Sections G to S). Most inventors find it difficult to make sales of nonpatented inventions or inventions protected under trade secret law. For that reason, patent ownership and invention ownership often amount to the same thing.

B. Who Can Apply for a Patent?

As stated in Chapter 10, Section E2, only the true inventor(s) can apply for a patent. As mentioned in Chapter 1, when it comes to eligibility to apply for a patent, the status of the applicant(s)-inventor(s) makes no difference, so long as each is a true inventor. That is, an applicant can be of any nationality, sex, age, or even incarcerated, insane, or deceased. (Insane and deceased people can apply for patents through a legal representative.)

What happens to patent ownership if more than one person is involved in a particular invention? If other people are involved in the inventing stage, they're considered joint or coinventors. Most often, the trick is to determine what type of activity constitutes invention. For instance, suppose one person came up with the concept of the invention, while the other merely built and tested it—that is, did not contribute any inventive concepts but merely did what any skilled artisan or model maker could do. In this situation the second person is not a coinventor. Similarly, financiers, or others who provided business advice, but not technical input, should not be listed as coinventors.

On the other hand, suppose one person came up with the idea for an invention and a model maker then came up with valuable suggestions and contributions that went beyond the skill of an ordinary model maker or machinist and made the invention work far better. In this situation both people should be named as coinventors on the patent application (see Chapter 10, Section E2), provided the model maker's contribution is present in at least one claim.

The PTO and the courts don't recognize degrees of inventorship. Thus, the order in which the inventors are

named on a patent application is legally irrelevant, although the first-named inventor will be more prominent in the printed patent.

If the joint applicants invented different parts of the claimed invention, they should keep accurate records as to what part each invented. That way, if one inventor's part is dropped later during the prosecution, they can change the named inventors. For this purpose I have provided Form 16-1, Joint Applicants—Statement of Respective Contributions, (see Appendix 7). I strongly recommend that all inventors complete this form whenever two or more people apply for a patent.

Completing this form is straightforward: Enter the title of the application or invention, then fill out each inventor's contribution in the right-hand blocks. Have each inventor sign and date in the left-hand column adjacent to their contribution. Each inventor should keep a copy of the form (don't file it with the PTO) and refer to it later—for example, if the claims are changed in any way so that one inventor's contribution is no longer claimed, the inventors should remove that inventor from the application. See Patent Rules 48 and 324. Joint inventors need not have worked together either physically or at the same time, and each need not have made the same type or amount of contribution. To qualify as a coinventor, as stated, an inventor need merely have contributed something to at least one claim of the application, even if it's a dependent claim.

Another problem sometimes arises when two or more persons work on an invention, but not all of them are named as applicants in the patent application. Disputes regarding inventorship with the omitted inventor(s) sometimes arise later. For example, a model builder may later come back, after an application is filed, and claim to have been wrongfully excluded as a joint applicant. As I stated in Chapter 3, the best way to avoid such problems is for all inventors to keep a lab notebook—that is, a technical diary, which faithfully records all developments and is frequently signed by the inventor(s) and witnesses. In that way the complaining model builder can be answered by positive proof from the true inventor(s). Also using the Consultant's Work Agreement (Form 4-3) will eliminate many potential disputes since it requires the consultant to assign (legally transfer ownership of) all inventions that they make to the inventor who hires the consultant. Absent such documentation, or agreement, expensive disputes can arise, with only vague memories to deal with.

It's important to include in your application all the inventors who are true inventors and to exclude those who aren't inventors. If it is discovered later that your inventorship is incorrect, and that the mistake resulted from bad faith, your patent can be held invalid, although this rarely

happens. (If you do discover that the wrong inventor(s) is (are) named on a patent or patent application, this can be corrected under Patent Rules 48 or 324.)

Common Misconception: If you want to make your financier a 50% owner of your invention, it is okay to do this by filing the patent application in both of your names.

Fact: A U.S. patent application must be filed in the name(s) of the true inventor(s) only. There are several legitimate ways to convey an interest in your invention to a non-inventor. (See Sections E and G, below.)

Common Misconception: If you came up with a bare concept for a valuable invention and your associate “took your ball and ran with it”—that is, built and tested the invention after hundreds of hours of work leading to final success, then your associate must be named as a coinventor with you.

Fact: As stated above, only the true inventor(s)—that is, the one(s) who came up with the inventive concepts recited in the claims—should be named as applicant(s). An associate who did only what any model maker would have done should not legally be named as coinventor, no matter how much work was involved. On the other hand, if your associate contributed inventive concepts that made the invention workable, and that are recited in one or more claims, then the associate should be named as a joint inventor with you.

Changing Inventorship

If you find that the incorrect inventors are named in a patent application or patent, for example, due to a change in the subject matter claimed, or discovery of an earlier error, you can correct inventorship by following the procedures under PTO Rule 48 (patent applications) or Rule 324 (patent). At least one original inventor must always be retained, that is, it is not possible to change inventorship so that all inventors in the application as originally filed are changed.

C. Joint Owners' Agreement

Problems commonly arise in situations where there are two or more inventors or owners of a patent application or patent. These include questions as to who is entitled to commercially exploit the invention, who is entitled to any financial shares, what type of accounting must be

performed on partnership books, etc. Fortunately, most of these predictable problems can be ameliorated, if not completely prevented from arising, by the use of a Joint Owners' Agreement (JOA).

The JOA is also desirable because a federal statute (35 USC 262) provides that either of the joint owners of a patent may make, use, or sell the patented invention without the consent of and without accounting to (paying) the other joint owner(s). This statute seems unfair, since it can work a severe hardship on one joint owner in either of two ways:

1. If one joint owner exploits and derives income from the patent while pushing the other aside, the passive joint owner will not be rewarded for any inventive contribution (if an inventor) or any capital contribution (if an investor—that is, someone who has bought part of the patent).
2. If one joint owner works hard to engineer and develop a market for the patented product, the other joint owner can step in as a competitor without compensating the engineer or marketing pathmaker for the efforts accomplished.

The JOA that I provide as Form 16-2 prevents these results from occurring and also accomplishes the following:

- Prohibits any joint owner from exploiting the patent without everyone's consent, except that if there is a dissenter, a majority can act if consultation is unsuccessful.
- Provides that in case of an equally divided vote, the parties will select an arbiter, whose decision shall control.
- Provides that disputes are to be resolved by mediation or binding arbitration if mediation fails.
- Provides that the parties shall share profits proportionately, according to their interests in expenditures and income, except that if one party does not agree to an expenditure, the other(s) can advance the amount in question, subject to double reimbursement from any income.
- Provides that if an owner desires to manufacture or sell the patented invention, that owner must pay a reasonable royalty to all other owners, including the manufacturing owner.

You should not regard this agreement as cast in stone, but merely as one solution to an unfair statute. You may ignore, modify, add to, or replace this agreement with any understanding you wish, so long as you're aware of the problems of Section 262, as paraphrased above.

The manner of completing the JOA of Form 16-2 is straightforward. Fill it in after or concurrently with an assignment (Section E, below) or a joint patent application (Chapter 10). Fill in the names and respective percentages

owned by each at the top of the form, identify the patent application (or patent) next, and have each joint owner sign and date the end of the form. As with all agreements, each joint owner should get and preserve an original signed copy. The JOA should not be filed in the PTO.



CAUTION

Space does not allow me to freely explain the possible ramifications of each paragraph in the JOA, or the many possible variations that might be more appropriate to your situation. If you want to be sure that your joint owners' agreement accurately reflects your needs, consult a patent attorney.

D. Special Issues Faced by the Employed Inventor

Many inventors are employed in industries that are at least somewhat related to the inventing they do on their own time. Such inventors naturally have a strong desire to learn what rights, if any, they have on inventions that they make during their employment, both on their own time and when they are on the job. This complex subject is covered in detail in *Who Owns Innovation? The Rights and Obligations of Employers and Employees*, by Spanner (Dow Jones Irwin 1984). I'll just cover the high points here.

Generally, the rights and obligations of employed inventors are covered by the Employment Agreement (EA) they sign with their employer—that is, the EA prevails—unless it conflicts with state law. (See below.) Below is an example (Fig. 16A) of a typical EA.

If you have *no* EA, it is possible that an employer may own rights to your employee-created invention under the “employed to invent” doctrine. How does this rule apply? If you are employed—even without a written employment agreement—to accomplish a defined task, or are hired or directed to create an invention, your employer will own all rights to the subsequent invention. This doctrine is derived from a Supreme Court ruling that stated, “One employed to make an invention, who succeeds, during his term of service, in accomplishing that task, is bound to assign to his employer any patent obtained.” (*Standard Parts Co. v. Peck*, 264 U.S. 52 (1924).) Generally, most companies prefer to use an EA because it is more reliable and easier to enforce than this implied agreement.

If you have no EA and are not employed to invent, you'll own all your inventions, subject to the employer's extensive “shop rights” (that is, a right to use the invention solely for

Agreement



IN CONSIDERATION of my employment or the continuance of my employment by VARIAN ASSOCIATES, I agree as follows:

For the purpose of this Agreement the term “the Company” shall include VARIAN ASSOCIATES, its subsidiaries and, or its affiliates in which VARIAN ASSOCIATES now or hereafter during the term of this Agreement owns more than twenty percent of the stock eligible to vote for directors and the assignees and licensees of VARIAN ASSOCIATES, its subsidiaries and affiliates.

I agree that all information and know-how, whether or not in writing, of a private, secret or confidential nature concerning the Company’s business affairs, including its inventions, products, processes, projects, developments, and plans are and shall be the property of the Company, and I will not disclose the same to unauthorized persons or use the same for any unauthorized purposes without written approval by an officer of the Company, either during or after the term of my employment, until such time as such information has become public knowledge. I also agree to treat all U. S. Government classified information and material in the manner specified by applicable Government regulations.

I agree that all files, letters, memos, reports, sketches, drawings, laboratory notebooks or other written material containing matter of the type set forth in paragraph 2 above which shall come into my custody or possession shall be and are the exclusive property of the Company to be used by me only in the performance of Company duties and that all such records or copies thereof in my custody or possession shall be delivered to the Company upon termination of my employment.

I agree that my obligation not to disclose or to use proprietary or confidential information of the types set forth in paragraphs 2 and 3 above also extends to such types of information of customers of the Company or suppliers to the Company, who may have disclosed or entrusted such information to the Company or me in the course of business.

I hereby assign and agree to assign to the Company or its designee all my right, title and interest in and to all inventions, improvements, discoveries or technical developments, whether or not patentable which I, solely or jointly with others, may conceive or reduce to practice during the term of my employment and which are conceived or first actually reduced to practice (a) in the utilization by the Company of my services in a technical or professional capacity in the areas of research, development, marketing, management, engineering or manufacturing, or (b) pursuant to any project of which I am a participant or member and that is either financed or directed by the Company, or (c) at the Company’s expense, in whole or in part. All other inventions, improvements, discoveries or technical developments shall remain my property.

I agree to promptly disclose to and to cooperate with the Company or its designee, both during and after employment, with respect to the procurement of patents for the establishment and maintenance of the Company’s or its designee’s rights and interests in said inventions, improvements, discoveries or developments, and to sign all papers which the Company may deem necessary or desirable for the purpose of vesting the Company or its designee with such rights, the expense thereof to be borne by the Company.

Since I am to assign to the Company certain inventions which I may conceive or first actually reduce to practice after I enter the employ of the Company, I have listed below all those inventions which I own at this time and which I believe should be brought to the attention of the Company to avoid future misunderstandings as to ownership.

I agree that I will make no claim for pecuniary award or compensation under the provisions of the Atomic Energy Act of 1954, as amended, with respect to any invention or discovery made or conceived by me, solely or jointly with others, in the course of or under any contracts that the Company now has or may have pertaining to work for the Atomic Energy Commission during the term of my employment.

DATE _____ EMPLOYEE _____

DATE _____ WITNESS _____

PRIOR INVENTIONS OWNED BY EMPLOYEE
(PLEASE USE REVERSE SIDE IF MORE SPACE IS REQUIRED)

Fig. 16A—Typical Employment Agreement

the employer's business, without paying the employee) on inventions made using company time, facilities, or materials.

If you *have* an EA, it will almost certainly require that you assign (legally transfer) to your employer all inventions, that are:

1. made during the term of employment (note that Form 16A asks you to list all inventions you owned prior to employment—those are excluded from the agreement)
2. related to the employer's existing or contemplated business
3. made by using the employer's time (that is, the time for which the employee is paid), facilities, or materials, or
4. made as a result of activity within the scope of the employee's duties.

Note that under items 1, 2, and 4, even if an employee makes an invention at home, on the employee's own time, the employer still can be entitled to ownership.

Also, you'll usually be bound to disclose *all* inventions to the employer (so the employer can determine if they're assignable). Lastly, most EAs will require you to keep your employer's trade secrets confidential during and after your employment. Some states, such as California, have enacted statutes (Calif. Labor Code, Sections 2870 et seq. and 2860) prohibiting the employer from requiring the employee to sign any EA that is broader than the foregoing. For example, under such statutes the employee can't be made to turn over all inventions, no matter where and when made, to the employer. Similarly, the employer is prohibited from providing an EA that states that everything an employee acquires from the employer (except salary) belongs to the employer.

EXAMPLE: Griselda is an engineer employed by Silicon Valley Chips (SVC) to design integrated circuits. Griselda's EA requires her to disclose to SVC all inventions made during the term of her employment at SVC and to assign to SVC all inventions which relate to integrated circuits or SVC's business, or which she makes using SVC's time, facilities, or materials. While employed, Griselda invents a new toilet valve at home in her workshop. The toilet valve is clearly outside the scope of SVC's business and therefore, Griselda owns it totally. However, she should disclose the valve to SVC (regardless of whose time it was invented on). Later, Griselda, while still employed but on vacation, is cogitating about an integrated circuit design problem she had last week at work. She comes up with a valuable, less-expensive integrated circuit passivation technique. Since this invention relates to SVC's business, SVC owns it and Griselda must disclose it to SVC and sign

any patent application and assignment on it that SVC requests.

If the invention is clearly within the scope of the EA, or is in a gray area, I still recommend first disclosing it to the employer. If the employer isn't interested in the invention after reviewing it, the employee can apply for a release, a document under which the employer reassigns or returns the invention to the employee. (The employer may retain a "shop right" under the release—that is, a nontransferable right to use the invention for its own purposes and business only.)

If the invention is in the gray area and the employer wants to exploit the invention, the employee can then try to negotiate some rights, such as a small royalty, or offer to have the matter decided by arbitration. Failing this, a lawsuit may be necessary, but I favor employees disclosing "gray-area" inventions so that a cloud of ownership uncertainty will not engulf their invention.

Most EAs also require the invention-assigning employee to keep good records of inventions made and to cooperate in signing patent applications, giving testimony when needed, even after termination of employment. Most companies give the employee a small cash bonus, usually from one to several thousand dollars or more, when the employee signs a company patent application. This bonus is not in payment for the signing (the employee's wages are supposed to cover that) but to encourage employees to invent and turn in invention disclosures on their inventions. Some employers, such as Lockheed, give their inventor-employees a generous cut of the royalties from their invention, and some will even set up a subsidiary entity (partly owned by the employee-inventor) to exploit the invention. Most, however, prefer to reward highly creative employees via the salary route.

Legislation has been proposed and engineering organizations have sought to expand the rights of the employed inventor. One of these proposals is to change the U.S. to the German system, where employees own their inventions but usually assign them to their employers in return for a generous cut, such as 20% of the profits or royalties.

E. Assignment of Invention and Patent Rights

Suppose you're an employed inventor and you make an invention on your employer's time and your employer wants to file a patent application on it. Under the law, every patent application must be filed in the name(s) of the true inventor(s). This raises a problem. If it's filed in your name, how will the employer get ownership? Since inventions,

patent applications, and patents aren't tangible things like a car, money, or goods, you can't transfer ownership by mere delivery, or even by mere delivery with a bill of sale or receipt. To make a transfer of ownership in the arcane patent world, you must sign an "assignment"—a legal document that the law will recognize as effective to make the transfer of ownership.

An assignment for transferring ownership of an invention and its patent application is provided as Form 16-3 (Appendix 7). (The PTO does not provide an assignment form.) The assignment should be recorded in the PTO to be fully effective—see next section.

As indicated, employed inventors ("assignors") usually make full assignments (transfer of 100% of the invention and its patent application) to their employers ("assignees"). They do this because they have agreed, in their EA, to assign all inventions they make within the scope of their employment to their employer. In these cases the assignee is usually a corporation.

A partial assignment (transfer of less than 100%) is usually made where the assignee (the person getting the transferred interest) has financed all or part of the patent application.

The assignment document presented here, like the Joint Owners' Agreement, is but one of many possible alternatives. If you use it, you may want to change a number of provisions to fit your situation. Also, keep in mind my cautionary note regarding the Joint Owner's Agreement, that is, a consultation with a patent attorney is advisable if you wish to fully understand how this agreement will affect your rights. For example, where there will be many owners of the patent application, the percentage interest of each should be specifically listed in the last sentence of paragraph 1.

The assignment can also be used to convey title to provisional applications, as well as title or ownership of any reissues or continuing cases (see Chapter 14) of the basic application referred to in part (B) of the assignment, as well as any provisional applications that the basic application claims priority of, and any regular (nonprovisional) applications which claim priority of the basic application, if the basic application is a provisional. A regular patent application can claim priority of a provisional application even if the regular and provisional are not commonly owned, so long as they both have a common inventor and the regular is filed within a year of the provisional.

To complete the assignment do the following:

Lines 1-3: Insert the names of the assignors (the inventor patent applicants) on lines 1 and 2 of the first paragraph after "received," and insert their cities and states of residence after "of" on line 3.

Lines 4-6: Do the same for the assignee on line 4.

Line 7: Put the percentage of the patent rights being assigned (normally 100%).

Lines 8-9: Put the title of the invention on line 7.

Lines 10-12: Put the date the patent application was signed (sometimes termed "executed" in the law) on line 11. If the application has already been filed, also put the serial number of the patent application on line 11 and put the filing date on line 12. Put the percentages owned by the assignor and assignee in the penultimate line of this paragraph.

Each assignor should sign and date the assignment. If the assignment is to be used abroad, have two witnesses sign and date the bottom two lines to make it recordable abroad. The PTO no longer requires notarization. A completed assignment is shown in Fig. 16B

F. Record Your Assignment With the PTO

To be fully effective, the assignment must be recorded in the PTO (just as the deed to your house must be recorded with your county clerk). If the assignment is not recorded, and the assignors make a subsequent (fraudulent) assignment to a different assignee who is unaware of the first assignment, the second assignee's rights will prevail over those of the first assignee if the second assignee records the assignment first. (Lawyers call this situation a "race arrangement" since the assignee who prevails is the one who wins the race to the PTO.) This means any assignee should record the assignment as soon as possible after it's signed.

The easiest way to record an assignment in the PTO is to do so online. Make a PDF copy of the signed assignment with a scanner, then go to <http://epas.uspto.gov>, and follow the instructions: Fill out the recordation form online, attach the assignment, pay by credit card, and submit the forms for recording. If you don't have a scanner and Internet access, you can record the assignment by mail or fax. First fill out a cover sheet (Form 16-4 or PTO-1595) and note the PTO's recordation fee, which is listed in Appendix 4, Fee Schedule. Then send or fax the assignment and cover sheet to the PTO with the recording fee. You can pay the recording fee by a credit card payment form or check. The mail address and the fax number are listed at the bottom of the cover sheet form. If you mail the papers, don't forget the usual receipt postcard. The PTO will record the assignment by making a copy of it and the cover sheet, and return the recorded assignment and cover sheet and a record sheet listing the assignment data to the person requesting recording.

If an assignment has been signed before the patent application is filed, it is permissible to send the assignment

Assignment of Invention and Patent Application

For value received, Roberta Ann Briskin,

of Merion Station, PA

(hereinafter ASSIGNOR), hereby sells, assigns, transfers, and sets over unto Rotten Kid Enterprises, Inc.

of Marcus Hook, PA

and her or his successors or assigns (hereinafter ASSIGNEE) 100 % of the following: (A) ASSIGNOR's right, title, and interest in and to the invention entitled "Poetry Therapy Systems"

invented by ASSIGNOR; (B) the application for United States patent therefor, signed by ASSIGNOR on 2011 Jan 11, U.S. Patent and Trademark Office Serial Number 10/123,456,

filed 2011 Jan 5; (C) any patent or reissues of any patent that may be granted

thereon; and (D) any applications which are provisional patent applications which said application claims priority

of, or nonprovisional applications which claim priority of said application, or continuations, continuations-in-

part, substitutes, or divisions of said application. ASSIGNOR authorizes ASSIGNEE to enter the date of signature

and/or Serial Number and Filing Date in the spaces above. ASSIGNOR also authorizes and requests the Commis-

sioner for Patents to issue any resulting patent(s) as follows: 0 % to ASSIGNOR and 100

% to ASSIGNEE. (The singular shall include the plural and vice versa herein.)

ASSIGNOR hereby further sells, assigns, transfers, and sets over unto ASSIGNEE, the above percentage of

ASSIGNOR's entire right, title, and interest in and to said invention in each and every country foreign to the

United States; and ASSIGNOR further conveys to ASSIGNEE the above percentage of all priority rights resulting

from the above-identified application for United States patent. ASSIGNOR agrees to execute all papers, give any

required testimony, and perform other lawful acts, at ASSIGNEE's expense, as ASSIGNEE may require to enable

ASSIGNEE to perfect ASSIGNEE's interest in any resulting patent of the United States and countries foreign

thereto, and to acquire, hold, enforce, convey, and uphold the validity of said patent and reissues and extensions

thereof, and ASSIGNEE's interest therein.

In testimony whereof ASSIGNOR has hereunto set its hand and seal on the date below.

Signature Roberta Ann Briskin Date 2011 Jan 11

Signature _____ Date _____

Witnessed by:

Signature Maxwell Spillane Date 2011 Jan 11

Signature Michael Barre Date 2011 Jan 11

Fig. 16B—Completed Assignment Form (Form 16-3 in Appendix 7)

in with the application and have it recorded at that time (see Chapter 10, Section H). However, you must fill in the date the application was signed (executed) on the assignment and cover sheet. (You won't be able to insert the serial (application) number or filing date since you don't know those yet.) However, even if the assignment is signed before filing, I prefer to wait until I can add the filing date and application (serial) number to it before sending it in for recording. This will connect it to the application in an unequivocal way. If you want to file the assignment after you file the application, you can file it online, or you can fax the assignment, the cover sheet, a CCPF or check (mail only) for the fee to Fax: 703-306-5995, or mail to "Mail Stop Assignment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450." If you mail the papers, don't forget the usual receipt postcard.

G. Licensing of Inventions—An Overview

If the owner of a patent application or patent can successfully exploit the invention, they will usually need to give permission to a manufacturer to make and sell the invention. Inventors, after all, are rarely also manufacturers. When an inventor gives another permission to manufacture and market an invention in exchange for compensation (such as a royalty or flat payment), it is, as stated, done with a document termed a "license." It is essential that a license agreement be written and signed by the inventor or owner of the patent or patent application (the licensor) and the manufacturer (the licensee). Here are just a few major considerations and terms that can be written into a license agreement:

1. The proposed licensee can buy an option from you (the licensor) under which you give it the exclusive (or nonexclusive) right to obtain a license under your patent application or patent within a fixed time, say two years. The payment for this option can be merely the company's agreement to research and develop your invention (this is a typical arrangement), or it can involve a cash payment. The general rule is that the more you receive up front, the more seriously the licensee will view and promote your invention.
2. As noted, if you grant the company a license, the license can be *exclusive*, under which you agree to license only the company and no one else. Alternatively, it can be *nonexclusive*, under which you license them but also have the right to license others. Exclusive licenses are more common, since manufacturers want to have a monopoly. Nonexclusive licenses are usually used where a very valuable invention exists and several manufacturers want licenses to get into the business. For example, Pilkington Brothers, the great British glass company, granted many nonexclusive licenses under its float glass patents.
3. The license, if granted, can be for the life of the patent, or just for a limited term, say five years, with an option to renew for succeeding five-year terms.
4. The license can require the payment of an advance that may be recoverable against royalties, or it may be in addition to royalties. You, of course, want to get as much money at the beginning as possible under the old "bird-in-the-hand" theory.
5. The license can require the payment of minimum annual royalty payments during each year of its existence. This is usually done when an exclusive license is granted.
6. The license rights can be transferred ("assigned") by your licensee to another manufacturer, or any such assignment can be prohibited. From your point of view, it's a good idea to try to get a provision included in the agreement prohibiting assignment without your approval.

There are hundreds of other, less important, considerations in licensing, which I won't discuss here. Licensing, as you may have gathered by now, is a difficult, complex subject, and one that requires knowledge as well as negotiation skill. Unfortunately, most invention licensing agreements tend to be tailor-made by large corporations to protect their interests. To date, no good self-help law book deals with the ins and outs of doing this. However, I refer to several standard patent law treatises in Appendix 2, Resources: Government Publications, Patent Websites, and Books of Use and Interest.

It's important to realize that even though you can make a great invention, prepare a patent application on it, and sell it to a manufacturer, you may not be able to represent yourself adequately in negotiating a license agreement unless you're familiar with licensing and adept at business. It's therefore often wise to hire a patent lawyer to review any contract that is offered to you. You'll find this will probably cost several hundred dollars or more, but the money will be well spent, especially if you have a potentially good deal in the offing.

In fact, most reputable companies would prefer that you be represented by an attorney when you negotiate a license agreement and often give you money to pay an attorney. The reason for this is that an agreement between an unrepresented inventor and a much larger company is likely to be interpreted against the company by the courts. If the inventor is represented by an experienced lawyer, the courts will tend to treat the parties equally if a dispute later arises.

H. Universal License Agreement

If you do feel confident enough to represent yourself, and you're the type of person who can go through a long license agreement with nit-picking skill and then competently negotiate with corporate pros, more power to you. Start your quest by referring to the Universal License Agreement in Appendix 7 (Form 16-5). This agreement can be used to exclusively or nonexclusively license your invention as well as to license know-how. It can also be used to grant a potential licensee an option to evaluate your invention for a given period in return for a payment. As I've said, most companies will either prefer their own license agreement or make one up from scratch, but you can use the Universal License Agreement for purposes of comparison.

Do you find the agreement long and complex? So do I. To deal with it easily, it's best to consider each of its parts separately. The sample shown (Fig. 16C) is for the first page of an exclusive license with an option grant and a know-how license.

Part 1: Parties and Summary of Terms. The licensor is the party, usually the inventor, who does the licensing, while the licensee is the party who is licensed—that is, given permission to use the invention, patent, know-how, etc.

The Patent Royalty rate is the percentage rate the licensee pays for use of the patent. I made this rate low (2%) purposely, since a know-how license has been granted at a rate of 3% for an overall (total) royalty of 5%. It's usually to an inventor's advantage to license know-how, as well as patent rights, and to make the know-how rate as high a proportion of the total rate as possible. This is because patents can be held invalid and can only be licensed for a limited term (the duration of the patent application plus the approximately 18-year term of the patent), usually a total of about 19 years; whereas a know-how license can extend indefinitely. In order for know-how to be licensed, the inventor must actually transfer (or be able to transfer) some actual know-how to the licensee.

A licensing fee (advance) is customarily paid to the licensor upon signing the agreement as a reward for past work. In the agreement, the licensing fee is computed as an estimate of the first year's sales by multiplying (a) the Patent Royalty Rate by (b) the Estimated First Year's Sales in Units by (c) the Estimated Unit Price in dollars. Again, it's usually in the inventor's interest to get as large a signing bonus as possible, and not to have this money be set off against later royalty payments.

The "Exclusive" box is checked, indicating that only the licensee will be entitled to make, use, or sell the invention. If the "Nonexclusive" box is checked, the licensor will be able to license others, and the licensee and the licensor

will be able to make, use, and sell the invention. The title, serial number, and filing date of the patent application are identified next.

The "Minimum Number of Units to Be Sold to Compute Minimum Annual Royalty" (whether or not they are actually sold) is provided to ensure that the licensor receives an adequate income from the licensee inasmuch as he can't, under an exclusive license, license others to derive more income. This minimum annual royalty has been computed on the basis of a minimum annual number of units to be sold (rather than a fixed dollar amount) to give the licensor the benefit of inflation in unit price. While the manufacturer can cut the price of the licensed product and thereby reduce its royalty payments to you, it's generally not in its interest to do this, since it will be reducing its profits as well. However, if you want protection against this possibility, you can substitute a fixed dollar amount for the minimum annual royalty.

For the privilege of obtaining an option to exclusively evaluate the invention for the Option Term, an Option Premium (a one-time cash payment) has been paid to the licensor.

The Know-How Royalty Rate is stated and is added to the Patent Royalty Rate to get the total, or Running Royalty Rate.

Part 2: Effective Date. The effective date of the agreement is the date when the last signature is made.

Part 3: Recitals. Here the Recitals provide the background reasons or premises for the agreement to aid in interpreting it. The recitals simply state that the licensor has an invention, a patent application, and possibly know-how, and the licensee desires to evaluate licensor's invention (if an option has been granted) and to make, use, and sell the licensed invention.

Part 4: Option Granted. This covers the parties' rights if an option has been granted. In this case, the regular license grant doesn't take effect yet, but the licensee has the exclusive right to investigate the invention for the option term indicated in Part 1. If the investigation is favorable, the licensee will exercise its option and the patent license grant of Part 5 will take effect. If not, the option will not be exercised and all rights will revert to the licensor and the licensor will get the results of the licensee's investigation of the invention.

Part 5: License Grant. This contains the actual license grant. This comes into play immediately if the invention is licensed or if an option is granted or if the option is granted and exercised. Remember, if an option is granted, the actual license isn't granted until the option is exercised. The license granted (exclusive or nonexclusive) gives the licensee the right to make, use, and sell the licensed product in the

Universal License Agreement

1. Parties and Summary of Terms:

Parties: This agreement is between:

Licensor: Henry Beresofsky

of Chernegov, Ukraine

Licensee: Chernobyl Reactor Works, Inc.

of Russian Hill, CA

Summary: Type of License: Exclusive Nonexclusive

Invention Title: Perpetual Energy Machine

Patent Application Ser. Nr.: 07/123,456, Filing Date: 20xx Aug 9

If Exclusive License, minimum number of units to be sold to compute Minimum Annual Royalty (MAR):

MARs start first quarter of 20xx

Option Granted: Premium \$ 5,000 For term of: 18 months

Patent Royalty Rate 2.00 % Know-How Licensed: Know-How Royalty Rate: 3.00 %

Total Royalty Rate (Patent Royalty Rate plus Know-How Royalty, if applicable): 5.00 %.

Estimated 1st year's sales (units): 200 x Estimated Unit Price \$ 1,000.00

x Total Royalty Rate 5.00 % = Licensing Fee \$ 10,000.00

2. Effective Date: This agreement shall be effective as of the latter of the signature dates below written and shall be referred to as the Agreement of such date.

3. Recitals:

- A. LICENSOR** has developed an invention having the above title and warrants that LICENSOR has filed a patent application on such invention in the U.S. Patent and Trademark Office, which patent application is identified by the above title, Serial Number, and Filing Date. LICENSOR warrants that LICENSOR has full and exclusive right to grant this license on this invention and LICENSOR's patent application. If the "Know-How Licensed" box above is checked, LICENSOR has also developed know-how in connection with said invention and warrants that LICENSOR owns and has the right to license said know-how.
- B. LICENSEE** desires, if the "Option Granted" box above is checked, to exclusively investigate LICENSOR's above invention for the term indicated. If said "Option Granted" box is not checked, or if said box is checked and LICENSEE investigates LICENSOR's invention for the term indicated and such investigation is favorable, LICENSEE desires to make, use, and sell the products embodying such invention and covered by the claims of LICENSOR's patent application and any patent(s) issuing thereon (hereinafter "Licensed Product").
- 4. If Option Granted:** If the "Option Granted" box above is checked, then (A) the patent license grant of Part 5 below shall not take effect except as defined in this part, and (B) LICENSOR hereby grants LICENSEE, for the option premium stated above, an exclusive option to investigate LICENSOR's invention for the term indicated above, such term to commence from the date of this Agreement. LICENSOR will furnish LICENSEE with all information and know-how (if any) concerning LICENSOR's invention in LICENSOR's possession. LICENSEE will investigate LICENSOR's invention for operability, costing, marketing, etc. LICENSEE shall report the results of its investigation to LICENSOR at any time before the end of the option term. If LICENSEE's determination is favorable, it may thereupon exercise this option and the patent license grant of Part 5 below shall become effective. If LICENSEE's determination is unfavorable, then said option shall not be exercised and no patent license grant shall take effect, all rights hereunder shall revert to LICENSOR, LICENSEE shall deliver to LICENSOR all results of its investigations for LICENSOR's benefit, and LICENSEE shall promptly return to LICENSOR all know-how (papers and things) received from LICENSOR or generated by LICENSEE in its investigations.

Fig. 16C—Completed First Page of Universal License Agreement (Form 16-5 in Appendix 7)

U.S., and it includes any derivative applications and patents (see Chapter 14). If the “know-how” box of Part 1 has been checked, then know-how is also licensed.

Part 6: Know-How. If know-how is licensed, then the licensor is obligated to communicate all of its know-how to the licensee within one month, plus provide up to 80 hours of consultation to the licensee, with travel and other expenses paid by licensee. The licensor disclaims any guarantee that the know-how is workable. The know-how royalty is to be paid for three years and thereafter for so long as the licensee enjoys a U.S. competitive market share of at least 15%. This means that the licensor can enjoy know-how royalty payments indefinitely, provided its know-how was valuable enough to give the licensee a market share of over 15% after three years have passed.

Part 7: Royalties. This concerns royalties and is the heart of the agreement.

Subpart A: If a Licensing Fee is paid; it’s an advance against future royalties. If the estimated Licensing Fee has been computed inaccurately (Part 1) then an adjustment is made when royalties are paid. (Note: It is permissible to draft an agreement whereby the licensing fee is a one-time payment and not an advance against royalties.)

Subpart B: The running royalty is covered and is paid quarterly, within one month after the end of each quarter, together with a report of the sales made in the quarter.

Subpart C: The minimum annual royalty (MAR) is to be paid if an exclusive license has been granted. The MAR payment is computed using the royalty rate times the minimum number of units of Part 1. Minimum annual royalties start as also stated in Part 1. If the minimum number of units is not sold in any year, the licensee must pay the appropriate makeup difference to the licensor with its payment for the fourth quarter.

Subpart D: If the minimum is not paid by licensee, either due to lack of sufficient sales or licensee’s choice, then the license grant will be converted to a nonexclusive one, and the licensor can immediately license others.

Subpart E: If the license is or becomes nonexclusive, then the licensor may not grant more favorable terms to any other licensee.

Subpart F: Patent royalties are not due after the patent expires, or if it is declared invalid, or if no patent is granted.

Subpart G: Late payments earn interest at 10%.

Subpart H: The “Net Factory Sales Price,” on which royalties are based, is the factory selling price, less shipping, insurance, taxes, etc., if billed separately. If the units are imported, then the importer’s gross selling price is the basis for royalties. The royalty paid on returns is deductible against future royalties.

Part 8: Records. This requires the licensee to keep full records for at least two years after each payment, so that the licensor can verify the royalty payments.

Part 9: Sublicensees. Here the licensee’s sublicensees are bound by all of the terms of the agreement and the licensee must notify the licensor if it grants sublicenses. A licensee will usually grant a sublicense when it has the licensed product made for it by a contracting company.

Part 10: Patent Prosecution. This simply states the parties’ responsibilities for patent prosecution.

Subpart A: Requires the licensor to pay for prosecution of the U.S. patent application, together with the patent maintenance fees that are payable after the patent issues. If the licensor intends to abandon the patent application, it must notify the licensee at least two months in advance to give it the opportunity to take over.

Subpart B: The licensor may file for patent coverage abroad, but if it doesn’t do so, then the licensee may do so. If licensor wants to license any foreign licensees, it has to give the licensee the opportunity of first refusal.

Subpart C: If the licensee takes over the U.S. patent prosecution, and is successful, then it can reduce its royalties by 25%, and can deduct its patent prosecution expenses. If the licensee elects to file abroad, then the royalty rate on foreign sales is 50% of the U.S. rate, less foreign prosecution expenses.

Part 11: Patent Marking. This requires the licensee to mark products sold with the legend “patent pending” while the patent application is pending and with the patent number (see Chapter 15) after the patent issues.

Part 12: Infringements. This states that if the patent is infringed, the licensor can sue to enforce its patent rights. If it doesn’t choose to do so, the licensee may do so. If the licensee sues, it can keep 75% of this recovery, less costs of the suit.

Part 13-A: No Validity Guarantee. This clause states that licensor doesn’t guarantee that its patent is valid or that it has any particular scope (breadth).

Part 13-B: Liability. This clause states, in effect, that if someone is injured by the patented product, the licensor is not liable.

Part 14: Term. This clause states that the term or maximum duration of the agreement shall be until the last patent of licensor expires, unless know-how is licensed, in which case Part 6 governs the term.

Part 15: Termination. This clause covers the situations when the parties may terminate the agreement before the term expires. Under Subparts A and B, the licensor may terminate the agreement if the licensee defaults in making royalty payments, or if it ever declares bankruptcy. Subpart

C, the antishelving clause, is very important. This protects the licensor in case the licensee stops production for 1.5 years, or doesn't start production within 1.5 years from the date the license agreement is signed. In these cases, the licensor can terminate the agreement.

Clauses like this one (and others) are designed to put teeth into the agreement to deter the licensee from defaulting: it is not enough to make a fair agreement; all agreements should also be structured to ensure the other party's performance by giving an incentive for performance, or a penalty for nonperformance.

Part 16: Notices. This clause states how and where notices under the agreement are to be sent.

Part 17: Mediation and Arbitration. This clause provides that if the parties have any dispute, they shall submit the matter to mediation. If mediation can't resolve the dispute, the parties must submit the dispute to binding and final arbitration. In no case will the dispute go to a court for resolution, since litigation is extremely expensive and thus works to the detriment of the independent inventor.

Part 18: Transfer of Rights. This clause allows the licensor to assign (legally transfer) its rights to anyone without permission, but the licensee needs advance permission of licensor to assign the licensee's rights unless it makes an assignment to its successor in business.

Part 19: Controlling Law. This clause specifies that the laws of licensor's state shall govern interpretation of the agreement. Normally, state law on the interpretation of contracts doesn't vary much, but since a licensor is usually at an economic disadvantage, I've given it the benefit here. Also, it specifies that any lawsuit on the agreement shall be brought in licensor's county.

Part 20: Good Faith. This states that neither party shall take any action that hampers the rights of the other and that both parties shall engage in good faith and fair dealing. This clause is supposed to be read into any agreement, but I've expressly stated it in order to increase cooperation and reduce disputes.

Part 21: Rectification of Mistakes. This states that in case of any mistake in the agreement, it shall be rectified to conform to the parties' intentions. The clause is designed to save a misdrafted agreement that otherwise might be thrown out.

Part 22: Supersession. This makes it clear the agreement supersedes prior or concurrent oral, or prior written, understandings.

Part 23: Counsel Consulted. This one states that the parties have carefully read the agreement and have consulted, or have been given an opportunity to consult,

counsel and that each has received a signed original. This makes a challenge to the agreement more difficult.

Other terms that can be added to the Agreement, if necessary, are Definitions of Terms (use if any unusual terms are present in the Agreement), Other Obligations of Licensee (e.g., Licensor has the right to approve the quality of Licensee's product, Licensee will spend certain efforts to commercialize product, etc.), Improvements (if Licensee or Licensor make improvements, who owns these and is royalty adjusted?).

All that remains is to sign and date the agreement. Each party should get an original, ink-signed copy.



TIP

Again, I remind you that while the Universal License Agreement incorporates most of the customary terms and covers many common licensing situations, it probably won't be appropriate for your situation without some modification. Obviously, if your arrangement won't fit within the terms of this agreement, or if you don't like any of the "fixed" terms, such as the 80 hours of consultation (Clause 6), the 15% market share (Clause 6), compulsory arbitration (Clause 17), etc., you should propose changes, or hire an expert to help you.

I. How Much Should You Get for Your Invention?

Many inventors seem to believe that patents are almost always licensed at a royalty rate of 5%. The 5% royalty generally means that you get 5% of the money received by the factory for its sales of the item embodying your invention. This is sometimes termed 5% of the "ex-factory" price. This assumption is simply not true. While 5% is often used as a starting point in many license negotiations, very few licenses are granted at this rate. I've seen them run from 0.1% to 15% of the factory price of licensed hardware items (as high as 30% of the retail price for software).

As you've guessed, many factors affect the royalty rate. Obviously, the more desirable your invention is to the licensee, the better royalty you'll get, subject to industry norms. Here's a list of some factors that militate in favor of increasing the royalty rate. Use as many of these as possible in your negotiations:

1. the product has a potential for large sales volume
2. the product can be offered at a low selling price
3. the product will not have much competition
4. the product will have a high profit margin
5. the product is ingenious and novel

Lump Sum Payment

If you're offered a single lump-sum payment for all your rights (this is rare), should you take it, and if so, how much should you get? To answer the first question, only you can decide if a relatively large bird in the hand is worth more than a potential (but by no means assured) stream of smaller, but aggregately heavier, birds in the bush over the years. To grapple with the second question, estimate the potential sales of your invention for the life of your patent application (one to three years), plus the term of the patent (approximately 18 years), then apply your royalty to this figure. Be willing to take half of this as a single payment lump sum for a fully paid-up license.

For example, suppose you expect your widget to be sold for the next 20 years (two years during patent pendency, and 18 years during life of patent), for an average factory price of 50 cents and an average yearly quantity of 150,000 units, and that a patent royalty of 5% is fair. Applying the formula, the substitute lump-sum payment for your royalty would be $\frac{1}{2} \times 20 \text{ years} \times 50\text{¢ unit price} \times 150,000 \text{ units} \times 5\% \text{ rate}$, or \$37,500. If you are offered much less than this, it may be unwise to sell.

Don't make Mary Jacobs's mistake. She invented the bra (out of two hankies and a ribbon) and was able to sell her patent for \$15,000 in 1914. Although this was a princely sum then, she practically gave it away since (as you know) her invention soon took hold and her patent eventually was worth \$15 million!

The disadvantage with the alternative lump-sum calculation is that it's very hard to estimate anything about what will happen in the next 20 years. Will sales go up or down? Will the product become obsolete or even more popular? Will competition affect its price, etc.? These are just some of the imponderables and unknowables, so, as stated, be extremely careful before selling your rights for a single lump-sum payment.



CAUTION

If you do have an opportunity to sell your invention, you should use the assignment form (Form 16-3), changing "For value received" at the beginning of the form to "In exchange for \$_____." For obvious reasons, make sure you actually receive the money by certified check or money order before you sign. Do not, under any circumstances, assign your patent in return for a series of payments. If your assignee defaults in the payments, you'll be left without your patent or your money, but with a big legal headache—getting your patent back. If someone wants to buy your patent for a series of payments, see a lawyer or legal forms book and make a suitable license with an agreement to assign only after all payments have been made.

6. the product required a lot of development
7. the invention substantially pervades the product
8. the licensed territory is a large, significant, or important market
9. the inventor will furnish considerable services, materials, parts, and/or tooling
10. there is no competition between licensee and licensor
11. this industry respects patents
12. it would be difficult to avoid the patent—that is, the patent is strong
13. negotiating the license agreement was difficult—for example, you expended considerable time or attorney fees
14. the licensee will save money on costs
15. the inventor has a strong reputation in the field
16. the product will have a long life
17. the start-up costs to produce the invention are low
18. the inventor has a number of patents or patent applications

19. consumers will pay a premium price for the product
20. the product can be sold at lower cost than its competition, and
21. a higher up-front payment will reduce the rate and vice versa.

Of course, your bargaining skill will transcend all of these considerations. As business negotiating seminar leader C.L. Karrass says: "In business, you don't get what you deserve—you get what you negotiate." An excellent guide to negotiating is "Take It or Leave It—The Only Guide to Negotiating You'll Ever Need," *Inc. Magazine*, August 2003.

Also, the custom of the industry will dominate—for example, toys usually get an exclusive royalty rate of 2.5% to 4%, medical products 6% to 7%, and software inventions up to 10% and sometimes more. An exclusive license will entitle you to about 50% more than a nonexclusive license.

In some industries the royalty rate may be a fixed (or per-unit) amount. For example, a patent owner may grant a license to a television manufacturer for a payment of 50¢ for

each patented and manufactured LCD screen, 25¢ for each patented chrominance demodulation circuit used, etc.

If your licensee doesn't want to pay the rate you ask, a good technique is to accept the lower rate they're willing to pay. However, add a proviso stating that the rate will be increased to the rate you want if "x" number of units are sold.

Instead of a negotiated percentage, some experts advocate getting a royalty equivalent to "one-third of the manufacturer's profit." This means that the company will take its selling price for your invention, say \$10, subtract its cost of manufacture, including overhead, say \$7, and give you one-third of the difference—that is, \$1 = 1/3 of its \$3 profit. This type of royalty is often enticing to a manufacturer since the company only contemplates parting with a portion of its profit, not paying a fixed sum per item, whether the particular product turns out to be profitable or not. If your licensee is willing to accept this type of royalty, you can substitute this language in the Universal Agreement. But, if you do so, be sure you include an auditing right (such as Clause 8) to ensure that you can verify its cost of manufacture.

J. Summary

All actual inventors must be named in the patent application, provided each contributed something to at least one claim. Financiers, advisors, model makers, or others that did not contribute any inventive concepts should not be named as inventors. If the claims of a patent application are changed, inventorship should be reviewed and changed if necessary. Use Form 16-1 in Appendix 7 to preserve each inventor's contribution.

Under patent law statute, any joint owner of a patent can practice the invention without paying any other inventor. To guarantee that all inventors receive compensation if the invention is commercialized, use the Joint Owners' Agreement—Form 16-2.

An employed inventor's rights are usually governed by an Employment Agreement, which mainly requires the employee to assign to the employer all inventions that are made in the course of the employer's business, use the employer's, time, facilities, or materials, or are within the scope of the employee's duties. Employees who are hired to invent have a common law obligation to assign inventions made in the scope of their duties. Other inventions are the property of the employee, but the employment agreement may require the employee to notify the employer about them.

A patent application and a patent are intangible personal property and part or full ownership must be transferred

by an assignment, which should be recorded in the PTO to prevent a subsequent, fraudulent assignment.

To collect royalties for use of an invention, an inventor (licensor) should make a licensing agreement with the manufacturer (licensee). The main considerations are the amount of any up-front payment, whether the license is exclusive or nonexclusive, and the royalty rate. It's advantageous to license know-how as well as patent rights. The Universal License Agreement (Form 16-5) covers most situations, but the terms must be negotiated. Factors affecting the royalty rate are the strength of the patent, the amount of design work already done, the anticipated sales volume, the profit margin, the field of the invention, etc. Never assign a patent or application for a series of payments; always get full payment at the time of assignment.

K. Desiderata for PTO

As this edition goes to press several patent bills are pending that would make various minor changes in the patent system. However I and many other persons concerned with helping independent inventors would like Congress to make major changes in the patent laws to make the patent system accessible to independent inventors and small businesses.


The change I would most like to see is a way to make it worthwhile for a contingent-fee litigator to take a case for those patentees who have an infringement where the damages aren't great enough to sue for, or the infringer isn't flush enough. As it is now, such patentees have in effect a worthless patent and thus it rarely makes sense to file for a patent unless the invention will be big enough for a contingent-fee litigator to take an infringement case. If we could have the PTO or some other agency adjudicate infringements in a cheap manner that doesn't require a skilled litigator or a patentee with the persistence and legal ability of Dr. Robert Kearns (see the movie *Flash of Genius*), this would immensely increase the value and incentive of patents. As it is now it doesn't make sense to file a patent application unless the invention is (a) so valuable that there are millions of dollars in damages, (b) very innovative so that the patent is strong enough to survive litigation, and (3) the infringer has very deep pockets so that they can afford to pay damages.

Another area where I favor major changes is to legislatively reverse many recent CAFC decisions that have invalidated patents for minor reasons, thereby providing many traps for those who may not have written the application in accordance with all of their picayune rules. Most of the CAFC judges have no experience in the real world of patents and have never written a patent

application. I favor legislation to overrule these irksome decisions by specifying that patent claims shall be construed to do substantial justice and not be invalidated for minor errors and also require CAFC judges to have real-world patent experience and be registered before the PTO.

Lastly, we could use legislation to simplify and loosen the requirements of patent applications and amendments to make things easier and cheaper for independent inventors. Almost everyone trips over the new rules for presenting claims in amendments, so much so that each Group in the PTO now has a special person, called a Legal Instruments

Examiner, just to check amendments to make sure they're canonical (in the proper format). If not, they will make you resubmit the amendment or part of it. Recently I filed a PCT application which I thought was fine. However I received a letter objecting to my submission as informal but not telling me how to fix it. I had to call to find out what was wrong. It turns out that the paper had an /S/ signature (“/John Smith/”) but it didn't have the signer's name (“John Smith”) typed again underneath the /S/ signature! I had to resubmit the paper with the signer's name typed twice: once sandwiched between slashes and then without the slashes!



Abbreviations Used in *Patent It Yourself*

Throughout *Patent It Yourself* (PIY) I've used many abbreviations to save space and to spare you the tedium of repeatedly reading long phrases like "Manual of Patent Examining Procedure." I've tried to define each abbreviation the first time I've used it and again if I've used it at a location remote from the first usage. However, in case I've failed to define any abbreviation adequately, here's a list of (hopefully) all the abbreviations I've used in PIY:

A&ARTP	Attorneys and Agents Registered to Practice	D	Design Patent
AF	After Final	DOE	Department of Energy; Doctrine of Equivalents
AIPO	African Intellectual Property Organization	DJ	Declaratory Judgment
BA	Basic Application	DP	Double Patenting
BAPI	Board of Appeals & Patent Interferences	DPED	Domestic Priority Establishing Document
BBS	Bulletin Board System	EA	Employment Agreement
BNA	Bureau of National Affairs	EAST	Examiner Assisted Search Tool
BRS	Bibliographic Research Services	EEC	European Economic Community
CAD	Computer-Aided Drafting	EFS	Electronic Filing System
CAFC	Court of Appeals for the Federal Circuit	EM	Express Mail
CASSIS	Classification And Search Support Information System	EPC	European Treaty Convention
CCPF	Credit Card Payment Form	EPO	European Patent Office
CFIM	Contingent-Fee Invention Marketer	FBIE	Fee-Based Inventor Exploiter
CFR	Code of Federal Regulations	FDA	Food and Drug Administration
CIP	Continuation-in-Part	FWC	File-Wrapper-Continuing
CM	Common Misconception; Certificate of Mailing	GATT	General Agreement on Tariffs and Trade
CRTP	Constructive Reduction to Practice	GPO	Government Printing Office
		IC	Inventors' Commandment
		IDS	Information Disclosure Statement
		ITC	International Trade Commission
		JOA	Joint Owners' Agreement
		JPTOS	<i>Journal of the Patent and Trademark Office Society</i>
		KISS	Keep It Simple, Stupid

MAR	Minimum Annual Royalty	PTMS	Petition To Make Special
MDC	Multiple Dependent Claim	PTMSUAEP	Petition to Make Special Under the Accelerated Examination Program
MF	Maintenance Fee	PTO	Patent and Trademark Office (U.S.)
MPEP	<i>Manual of Patent Examining Procedure</i>	PubPA	Published Patent Application
N/A	Notice of Allowance	RCE	Request for Continued Examination
N&UR	New and Unexpected Results	RPA	Regular Patent Application
NCC	Non-Convention Country	RTP	Reduced to Practice
NIH	Not Invented Here	S	Solution
NM	New Matter	SBA	Small Business Administration
N(N)C	Normally (Non-) Conductive	SD	Supporting Declaration
NPR	Nonpublication Request	SE	Small Entity
OA	Office Action	SED	Small-Entity Declaration
OG	<i>Official Gazette</i>	SIR	Statutory Invention Registration
OIPE	Office of Initial Patent Examination	SPO	Shadow Patent Office
P	Problem	SSM	Statutory Subject Matter
PA	Prior Art	TD	Terminal Disclaimer
PAD	Patent Application Declaration	TM	Trademark
PCT	Patent Cooperation Treaty	TN	Trade Name
PDF	Portable Document Format	TS	Trade Secret
PDL	Patent Depository Library	UC	Unfair Competition
PGL	Paranoia, Greed, Laziness	UCC	Uniform Commercial Code
PHOSITA	Person Having Ordinary Skill In The Art	USC	United States Code
PPA	Provisional Patent Application	VA	Vanadium Alloy
Pre-Ex	Preliminary to Examination		
PTDL	Patent and Trademark Depository Libraries		

Resources: Government Publications, Patent Websites, and Books of Use and Interest

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It has been said that knowing where to look is half the battle of knowing the law. With this in mind, this section is provided to help you avoid having to hire a patent lawyer in case you encounter any situations or problems which this book does not cover. I've also provided a number of resources and publications I feel will be of interest to inventors and other creative people.

A. Government Publications

In addition to being available in paper-bound publications, most of the publications below are now available on the Internet at the PTO website (www.uspto.gov) and on CD-ROMs, which are updated quarterly and which may be read on the computer in any Patent and Trademark Depository Library. (See the list of libraries in Chapter 6.) Because of this and because of the widespread availability of Internet access at home and libraries, I am omitting further references to paper-bound government publications.

Attorneys and Agents Registered to Practice Before the U.S.

Patent and Trademark Office. Annual. GPO. Contains alphabetical and geographical listings of all attorneys and agents. <https://oedci.uspto.gov/OEDCI>

Index to Classification. Loose-leaf. Contains all subclasses and cross-references arranged alphabetically. www.uspto.gov/web/patents/classification/uspcindex/indexoutspsc.htm

Manual of Classification. GPO. Loose-leaf. Contains 300 search classes for patents arranged numerically, together with subclasses in each class. www.uspto.gov/web/patents/classification

Manual of Patent Examining Procedure (MPEP). Revisions issued several times per year. GPO. Called "the patent examiner's bible," the MPEP provides answers to most questions about patent prosecution. www.uspto.gov/web/offices/pac/mpep/mpep.htm

Patent Laws (Title 35 of U.S. Code). The federal statutes governing patents. Available at the PTO's website under MPEP

Rules of Practice in Patent Cases (Title 37, Code of Federal Regulations). GPO. The PTO's Rules of Practice. Available at the PTO's website under MPEP.

B. Patent Websites

Below are three groups of patent links. The first group provides sources of information for inventors, the second group includes resources on patent law and intellectual property law, and the third provides patent searching

databases. As with all Internet links, we cannot guarantee the continued accuracy of any of these sites.

1. Inventor Resources

DaVinci Design Resource (www.uspatentinfo.com). Provides information and resources that may be helpful to the inventor in building a prototype of an invention and provides basic information about patents, copyrights, trademarks, and trade secrets.

Intellectual Property Owners (IPO) (www.ipo.org). An association that serves owners of patents, trademarks, copyrights, and trade secrets. It is the sponsor of the National Inventor of the Year Award. Write to them at Intellectual Property Owners, 1255 23rd Street NW, Suite 850, Washington, DC 20037. Phone: 202-466-2396; Fax: 202-466-2893; or email: info@ipo.org.

Invention Convention (www.inventionconvention.com). The National Congress of Inventor Organizations (NCIO) and its executive director, Stephen Paul Gnass, maintain this invention website that includes links, trade show information, and advice for inventors. National Congress of Inventor Organizations, 727 North 600 West, Logan, UT, 84321. Phone: 801-753-0888.

InventNet Forum (www.inventnet.com). Provides an online forum and mailing list if you wish to contact other inventors.

Inventor's Digest Online (www.inventorsdigest.com). Publishes online information and a print publication for independent inventors (\$36 per year). Includes articles on new inventions, licensing, and marketing, and advertisements from inventor help companies.

Minnesota Inventors Congress (www.invent1.org). One of the oldest and most respected inventor organizations.

National Technology Transfer Center (NTTC) (www.nttc.edu) at Wheeling Jesuit University. Helps entrepreneurs and companies looking to access federally funded research and development activity at U.S. universities: 316 Washington Avenue, Wheeling, WV 26003, Phone: 800-678-6882, Fax: 304-243-4388, email: technology@nttc.edu.

Nolo (www.nolo.com). Patent, copyright, trade secret, and trademark resources and products and updates of David Pressman's *Patent It Yourself*.

Patent Law Links (www.patentlawlinks.com). Provides links to everything "patent" on the Internet.

PTO Independent Inventor Resources (www.uspto.gov/web/offices/com/iip/index.txt). In 1999, the PTO

established a new office aimed at providing services and support to independent inventors. The PTO expects to eventually offer seminars and expanded educational opportunities for inventors. For more information, call: 800-PTO-9199 (800-786-9199) or 703-308-HELP.

Ronald J. Riley's Inventor Resources (www.inventored.org). Comprehensive links and advice for inventors.

United Inventors Association (UIA) (www.uiausa.org). A national inventors' organization. For more information, write to P.O. Box 23447, Rochester, NY 14692-3347, Phone: 716-359-9310; Fax: 716-359-1132, email: UIAUSA@aol.com.

2. Patent Law and Intellectual Property Law Websites

Copyright Office (www.loc.gov/copyright). The Copyright Office has numerous circulars, kits, and other publications that can help you, including one on searching copyright records. These publications and application forms can be obtained by writing to the Copyright Office at Publication Section, LM-455, Copyright Office, Library of Congress, Washington, DC 20559. Most Copyright Office publications can be downloaded directly from the Copyright Office website. Frequently requested Copyright Office circulars and announcements are also available via the Copyright Office's fax-on-demand telephone line at 202-707-9100.

European Patent Office (EPO) (www.european-patent-office.org/online). Agency that implements the European Patent Convention—a simplified method of acquiring a patent among member nations—by granting “regional” European patents that are automatically valid in each European Patent Convention member country.

Fedlaw (<http://fedlaw.gsa.gov>). Source of federal law links with a thorough collection of intellectual property statutes, case law, and readings.

Government Printing Office (www.access.gpo.gov/#info). Searchable source for U.S. Code of Federal Regulations, Congressional Record, and other Government Printing Office products and information.

Intellectual Property Mall (www.ipmall.fplc.edu). IP links and information.

Internet Patent News Service (www.bustpatents.com). Source for patent news, information about searching, and patent documents, news about patents, and information about bad patents, software, and business methods.

Legal Information Institute (<http://lii.law.cornell.edu>). Intellectual property links and downloadable copies of statutes and cases.

Patent & Trademark Office (PTO) (www.uspto.gov). Offers a number of informational pamphlets, including an introduction to patents (“General Information About Patents”) and an alphabetical and geographical listing of patent attorneys and agents registered to practice before the PTO (“Directory of Registered Patent Attorneys and Agents Arranged by States and Countries”). The PTO also has an online searchable database of patent abstracts (short summaries of patents). For purposes of patent searching, this database is an excellent and inexpensive first step in the searching procedure. Most patent forms can be downloaded from the PTO website, as can many important publications including the *Manual of Patent Examining Procedures* and *Examination Guidelines for Computer-Related Inventions*. For a catalog listing all the products and services available from the PTO online and off, call 800-PTO-9199 and ask for the “U.S. Patent and Trademark Office Products and Services Catalog.”

PCT Applicant's Guide (www.wipo.int). PCT information and software for facilitating completion of the PCT forms is available through the PCT's website.

Trademarks (www.uspto.gov). Trademarks are examined and registered by a division of the PTO. An introductory pamphlet about trademarks (“General Information About Trademarks”) and information about the operations of the Patent and Trademark Office are available from the Superintendent of Documents, Government Printing Office, Washington, DC 20402, or from the PTO's website at www.uspto.gov. This site includes the relevant applications and trademark office forms.

3. Patent Searching Online

Here are several organizations that offer computer searching of patent records and a description of their services. Several of the “for fee” databases also provide foreign patent information.

U.S. Patent & Trademark Office (www.uspto.gov/patft/index.html). Free online full-text searchable database of patents and drawings that covers the period from January 1976 to the most recent weekly issue date (usually each Tuesday). In order to view the drawings, your computer must be able to view TIFF files. The PTO's site is linked to a source that provides a free downloadable TIFF reader program. For faster searching there is also a Bibliographic Database that contains only the text of each patent without drawings.

Google Patents (www.google.com/patents) is an excellent free resource that includes U.S. patents back to the beginning. I strongly recommend this site.

Patents.com (www.patents.com) is another good free search site that goes back to 1976 and includes the maintenance-fee status (expired or in-force) and claims, abstract, or description on the front page.

Delphion (www.delphion.com). Fee-based online searchable database with full text searching capability for patents issued from 1974 to the present.

European Patent Office (www.espacenet.com). Enables searching of text, titles, and abstracts back to the 1920s.

LexPat (www.lexis-nexis.com). Commercial database of U.S. patents searchable from 1971 to the present. In addition, the LEXPAT library offers extensive prior-art searching capability of technical journals and magazines.

MicroPatent (www.micropatent.com). Commercial database of U.S. patents searchable from 1836 to the present. Users must first set up an account. Also offers delivery of patent copies dating back to 1790 by U.S. mail, fax, and email.

Pat2PDF (www.pat2pdf.com). Free PDF copies of patents.

QPAT (www.qpat.com). A database, which includes U.S. patents searchable from 1974 to the present and full-text European A (1987–present) and B (1991–present) patents.

Nolo Books on Intellectual Property

Nolo, the publisher of this book, also publishes a number of other titles on intellectual property, including:

- *Patent Savvy for Managers*, by Kirk Teska
- *How to Make Patent Drawings: A Patent It Yourself Companion*, by Jack Lo and David Pressman
- *What Every Inventor Needs to Know About Business & Taxes*, by Stephen Fishman
- *Nolo's Patents for Beginners*, by David Pressman and Richard Stim
- *Patent Pending in 24 Hours*, by Richard Stim and David Pressman
- *Patent, Copyright & Trademark: An Intellectual Property Desk Reference*, by Richard Stim
- *Profit From Your Idea: How to Make Smart Licensing Deals*, by Richard Stim
- *Legal Guide to Web & Software Development*, by Stephen Fishman
- *The Copyright Handbook: What Every Writer Needs to Know*, by Stephen Fishman.
- *The Inventor's Notebook: A Patent It Yourself Companion*, by Fred Grissom and David Pressman
- *The Public Domain: How to Find & Use Copyright-Free Writings, Music, Art & More*, by Stephen Fishman
- *Trademark: Legal Care for Your Business & Product Name*, by Stephen Elias.

Nolo's Legal Encyclopedia

Nolo's website (www.nolo.com) features an extensive [Legal Encyclopedia](#) that includes a section on intellectual property. You'll find answers to frequently asked questions about patents, copyrights, trademarks, and other related topics; as well as sample chapters of Nolo books and a wide range of articles. Simply click on "Legal Encyclopedia" and then on "Patents, Copyright & Trademark."

C. Books of Use and Interest

Below are lists of books and magazines that may be of special interest to inventors, including general interest books, business books, and books relating to self-improvement. Many of these books may be out of print or available only in libraries. You can often acquire out-of-print books from online booksellers, such as Amazon.com, Powells.com, and Bookfinder.com.

I provide comment where the title of the book or source isn't self-explanatory. Most books that can't be found in a general or business library may be found in a law library. (Most county courthouses and law schools have law libraries.) Prices aren't indicated since they change frequently. This list isn't exclusive by any means. If you browse in your bookstore or a patent depository or law library, you'll find many other valuable books.

1. Patent Books, Magazines, and a Museum Relating to Patents, Inventions, and Trademarks

A Patent on Murder, by Kaplan, Charles M., Esq. (Booklocker.com 2006). A mystery thriller involving a patent attorney and a client who invents a ray gun for combating Arab terrorists. This page-turner is not only a must read for anyone involved with patents and inventions, but also provides an irresistible introduction to patent lore for the newbie.

A Patent on Greed, by Kaplan, Charles M., Esq. (Booklocker.com 2008). A sequel to my colleague Mr. Kaplan's above book. Orin Aldrich invents a device that enables a car to get 250 mpg. Arab terrorists try to suppress it and murder him and try to kill his attorney. The president backs a free-lance assassin known as The Ghost to attack the leaders of the jihad. Another page-turner full of patent lore.

- American Heritage of Invention and Technology**, P.O. Box 5338, Harlan, IA 51593-2838. A beautiful, artistic, and interesting magazine. www.americanheritage.com/inventionandtechnology.
- The Catalyst**, by Harness, Charles R., Esq. Pocket Books, New York. Science fiction story involving a patent attorney, an invention, and an interference.
- Complete Guide to Making Money With Your Ideas and Inventions**, by Paige, R.E. Barnes & Noble, New York, NY. Excellent guide to invention marketing.
- Thompson CompuMark Directory of U.S. Trademarks**. Thomson & Thomson, Quincy, MA. Available in search libraries. Trademark search service. <http://compumark.thomson.com>.
- Edison, The Man Who Made the Future**, by Clark, R.W. Putnam, New York.
- The Existential Pleasures of Engineering**, by Florman, S.C. St. Martins, 1976. A brilliant, eloquent panegyric of technology; a crushing blow to Reich, Mumford, Rozak, et al.
- Eureka! The Invention and Innovation Newsletter**, 156 Columbia Street West, Waterloo, Ontario N2L 3L3. A quarterly inventor publication primarily for Canadian inventors.
- The Firefly Visual Dictionary**, by Corbeil and Archambault, Firefly Books 2002.
- How to Become an Inventor**, by Daniels, J.R. (ebook, www.booklocker.com).
- Idea Marketplace**, P.O. Box 131758, Staten Island, NY 10313, Phone: 800-IDEA-MRK (\$14.95/year/6 issues). A semimonthly magazine covering issues of interest to inventors.
- Inventing: How the Masters Did It**. Moore Pub., Durham, NC.
- The Inventor's Bible: How to Market and License Your Brilliant Ideas**, by Docie, R.L., Sr., Ten Speed Press, Berkeley, CA.
- Inventure Place**, 221 South Broadway, Akron, OH 44308, Phone: 216-762-4463. A museum of inventors and inventions.
- Landis on Mechanics of Patent Claim Drafting**, by Faber, R.C. (PLI 2006).
- Licensing Royalty Rates**, by Battersby, G.J. and Grimes, C.W. (Aspen 2005).
- License Agreements—Forms & Checklists**, by G.J. Battersby and C.W. Grimes (Aspen 2005).
- Man of High Fidelity: Edwin Howard Armstrong**, by Lessing, L. Lippincott, Philadelphia, PA. Biography of the inventor of frequency modulation; he committed suicide because of the delays and difficulties of patent litigation against the large radio companies, but his widow eventually collected millions in settlements.
- Marketing Your Invention**, by Mosley, Thomas E., Jr. Upstart Publishing, Chicago, IL. Another excellent guide to invention marketing.
- Millions From the Mind**, by Tripp, A.R. Teletyano Press 2003.
- The National Inventors Hall of Fame. **Biographies of Inductees**. NIHF Foundation, Room 1D01, Crystal Plaza 3, 2001 Jefferson Davis Highway, Arlington, VA 22202. Free.
- One Day at Kitty Hawk**, by Walsh, J.E. Crowell, New York, NY. The story of the development and sale of rights to the airplane.
- Patently Female—Stories of Women Inventors**, by Vare, E.A., and Ptacek, G. Wiley. A great history of female inventors.
- Patent Infringement Remedies**, by Sung, L.M. (BNA 2005).
- The Black Inventor Online Museum**. Stories of African-American inventors, including boxer Jack Johnson and peanut genius George Washington Carver. www.blackinventor.com.
- Will It Sell? How to Determine If Your Invention Is Profitably Marketable (Before Wasting Money on a Patent)**, by White, James E. (www.willitsell.com).

2. Publications Relating to Business

- Apollo Handbook of Practical Public Relations**, by Adams, A.B. Apollo Editions, New York, NY. How to get publicity.
- Applied Sciences and Technology Index**. H.W. Wilson Co., Bronx, NY 10452. Lists engineering, scientific, and industrial periodical articles by subject.
- Bacon's Publicity Checker—Magazines; Bacon's Publicity Checker—Newspapers**. Annual. Bacon Pub. Co., Chicago, IL. Classifies all sources of publicity.
- Business Plans That Win \$\$\$: Lessons From the MIT Enterprises Forum**, by Rich, S.R., and Gumpert, D. Harper & Row.
- California Manufacturers Register**. Annual. 1115 South Boyle Avenue, Los Angeles, CA 90023.
- Conover Mast Purchasing Directory**. Conover Mast, Denver, CO 80206. Annual. Three volumes. Manufacturers listed alphabetically and by products. Also lists trademarks.
- Dun & Bradstreet Reference Book**. Six issues per year. Lists three million businesses in the United States and Canada. D&B also publishes specialized reference books and

directories, such as *Apparel Trades Book* and *Metalworking Marketing Directory*.

The Entrepreneur's Manual. Brown, D. Ballantine.

Gale Directory of Publications and Broadcast Media. Annual. Ayer Press, Philadelphia, PA 19106. Lists United States newspapers and magazines geographically.

Getting to Yes; Negotiating Agreements Without Giving In, by Fisher, R., and Ury, W. Penguin.

Guide to American Directories. B. Klein Pubs., New York, NY. Lists directories by industry, profession, and function.

How to License Your Million Dollar Idea, by Reese, H., Wiley 2002.

How to Market a Product for Under \$500! by Dobkin, J. Danielle Adams Pub., Box 100, Merion Station, PA 19066.

How to Write a Business Plan, by McKeever, M., Nolo.

Innovation and Entrepreneurship, by Drucker, P. Harper & Row. How any organization can become entrepreneurial.

International Yellow Pages. R.H. Donnelley Corp., New York, NY 10017. Similar to local yellow pages, but provides foreign business listings.

Licensing Royalty Rates, by Battersby, G.J., and Grimes, C.W. (Aspen 2004). Details royalty rates for 1,500 products and services and ten major categories.

MacRae's Blue Book. MacRae's Blue Book Co., Hinsdale, IL 60521. Sources of industrial equipment, products, and materials. Also lists trademarks.

Marketing Without Advertising, by Phillips, M., and Rasberry, S. Nolo.

Form a Partnership: The Complete Legal Guide, by Clifford, D., and Warner, R. Nolo.

Pratt's Guide to Venture Capital Sources. Venture Economics, Inc.

R & D Partnerships, by Petillon, L.R., and Hull, R.J. Clark Boardman.

Thomas Register of American Manufacturers. Thomas Pub. Co., New York, NY 10001. Eleven volumes. Similar to *Conover Mast Directory* above.

Ulrich's International Periodicals Directory. R.R. Bowker Co., New York, NY 10036. Lists periodicals by subject.

Up Your Own Organization, by Dible, D.M. Entrepreneur Press, c/o Hawthorn Books, New York, NY. How to start and finance a business.

Young Inventors, A Kit for Competition Organizers, by Huta, Y. Inventors of the Future Project, P.O. Box 19405, Washington, DC 20030.

D. Books Relating to Self-Improvement

I believe that the real key to success and happiness, in inventing as well as life, lies principally within each individual's own mind. A positive, optimistic attitude, hard work and perseverance, the willingness to take full responsibility for one's own destiny, and living and thinking mainly in the present time—rather than luck, inherited abilities, and circumstances—are principally responsible for success and happiness. I have therefore provided a list of books whose main purpose is to prime you with the attitude to secure such success and happiness so that you'll be able to use *Patent It Yourself* as effectively as possible.

Explorations in Awareness, by Bois, S. Harper & Row. Break through mental blocks and preconceptions.

Higher Creativity—Liberating the Unconscious for Breakthrough Insights, by Harman, W., and Rheingold, H. J.P. Tarcher.

Language in Thought and Action, by Hayakawa, S.I., and A.R. Harcourt Brace Jovanovich.

Levels of Knowing & Existence, by Weinberg, H. Harper & Row. A new approach that answers many questions.

A New Guide to Rational Living, by Ellis, A., and Harper, R.A. Wilshire Book Co., Los Angeles, CA.

The Pleasure Trap, Mastering the Hidden Force that Undermines Health & Happiness, by Lisle, D.J., Ph.D., and Goldhamer, A., D.C. Healthy Living Publications, Summertown, TN 2003. How to recognize and overcome the distracting and often destructive pursuit of pleasure and focus on happiness instead.

People in Quandries, by Johnson, W. Harper & Row. Classic book on emotional problem solving.

The Psychology of Self-Esteem, by Branden, N. Nash, Los Angeles, CA.

Three Minute Therapy: Change Your Thinking, Change Your Life, by Edelstein, M.R., Ph.D. and Steele, D.R. Glenbridge Publishing, Denver, CO 1997. Rapidly applied techniques for overcoming problems and focusing on your goals.

303 of the World's Worst Predictions, by Coffey, W. Tribeca Communications, Inc.

Your Erroneous Zones, by Dyer, W.W. Funk and Wagnalls, New York, NY.

Glossaries

A. Glossary of Useful Technical Terms	460
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Section A contains a glossary of words used to describe parts and functions of inventions. Section B contains a glossary of legal terms and their definitions as used in patent law.

A. Glossary of Useful Technical Terms

This Glossary¹ provides a list of useful words to describe the hardware, parts, and functions of your invention in the specification and claims. The most esoteric of these words are briefly defined. While some definitions are similar, this is due to space limitations; all words have nuances in meanings.

If you're looking for a word to describe a certain part, look through the list for a likely prospect and then check a dictionary for its precise meaning. If you can't find the right word here, look in your search patents, in *What's What* or another visual dictionary, or in a thesaurus. If you can't find an appropriate word, you'll probably be able to get away with "member" or "means-plus-a-function" language. Also, for new fields, you may invent words, preferably using

Latin or Greek roots, as Farnsworth did with "television," or by extending the meaning of words from analogous devices (e.g., "base" for a part of a transistor). Very technical or specialized fields have their own vocabulary (e.g., "catamenial" in medicine, "syzygy" in astronomy); look in appropriate tutorial texts for these. The words are grouped loosely by the following functions:

1. Structure
2. Mounting and Fastening
3. Springs
4. Numbers
5. Placement (Relation)
6. Voids
7. Shape
8. Materials and Properties
9. Optics
10. Fluid
11. Electronics
12. Movement
13. Rotation/Machine
14. Biology.

¹ Expanded and used with kind permission and thanks from a list originally prepared by Louis B. Applebaum, Esq., of Newport, Rhode Island.

1. Structure

annulus (ring)	conveyor	head	putlog (horiz. support above ledger)
apron	cornice (horiz. top of structure)	header (base, support conduit)	race
apse (dome)	cover	homologous	raceway
arbor (shaft)	crenation (rounded edge)	horn	rank (row, series, range)
arm	cupola (projection)	housing	reticulum (netlike)
bail (arch wire)	cylinder	hub	rib
band	dasher (plunger, churn)	jacket	riddle (sieve)
barrel	derrick	jaw	riffles (obstructions)
bascale (seesaw)	detent	jib (crane arm)	ring
base	device	knocker (clapper)	rod
batten (support strip)	dibble (pointed tool)	lagging (support)	sash (frame)
beam	die	ledger (horizontal support)	score (notch, scratch)
—cantilever	disparate (dissimilar)	leg	screed (guide strip)
—simple	diversion	lip	scroll
belt	doctor blade (scraper)	list (margin strip)	sear (catch)
bib	dog (holder)	lobe	shell
billet (ingot or bar)	drum	magazine	shoe
blade	echelon (staggered line)	mandrel (tapered axle)	shoulder
blower	element	manifold	skeleton
board	enclosure	marge (edge)	sleeve
bob (hanging weight)	fence (stop on tool)	marginate (w/margin)	sluice (channel)
bodkin (stiletto)	felly (rim of spoked wheel)	medium	snare
body	fillet (narrow strip)	member	snorkel
bollard (thick post)	fin	mullion (dividing strip)	spar (pole, support)
boom	finger	nacelle (pod)	spline (projection on shaft)
boss (projection)	finial (ornament)	napiform (turnip-shaped)	spoke
bougie (body-insertion member)	flabellate (fan-shaped)	neck	sponsor (projection)
boule (pear-shaped)	flange	obcordate (heart shaped)	sprag (spoke stop)
branch	fluke (triangular part)	object	spur
breech (back part)	flute (groove on shaft)	outcrop	stanchion
bunker	frame	panel	station
caisson	fret	parietal (wall)	stay
canard (front wing)	frit (vitreous substance)	particle	stem
carriage	frustrum (cut-off area)	partition	stent (stretcher)
case	furcate (branch)	piece	step
channel	futtock (curved ship timber)	piston	stepped
charger (shallow dish)	gabion (support cylinder)	placket (slit in garment)	stile (dividing strip)
chase	gaff (hook, spar)	platform	stop
chord	gauge	plug	strake (ship plank)
cincture (encircling band)	generatrix (path traced)	plunger	strip
clew (sail part)	gnomon (sundial upright)	pontoon	strut
column	graticulate (squares)	portion	stylet
configuration	grommet	post	tang (shank, tool)
container	groove	pounce (fine powder)	tare (net weight)
	gusset (triangular insert)	projection	tendril (long, slender curl)
	handle	purlin (horiz. rafter support)	tine
			tip

tittle (a tiny bit)
 tongue
 trace (pivoted rod)
 tracery (scrolling)
 track
 trave (crossbar)
 truss
 tuft
 turret
 tuyere (air pipe)
 upright
 vang (guy)
 volar (palm, sole)
 wall
 ward (ridge or notch)
 warp
 woof (weft)
 ziggurat (pyramid with terraces)

2. Mounting and Fastening

attach
 belay
 billet (tip of belt)
 bolt
 bonnet
 braze
 busing
 cable
 camber
 caster
 clamp
 cleat (reinforcer)
 clevis (U-shaped pin)
 colligate (bound together)
 connection
 corbel (cornice support)
 couple
 coupling
 cribbing (support)
 demountably
 dentil (block under cornice)
 docking
 dowel
 engage
 fay (join tightly)

ferrule (barrel)
 ferruminate (attach, solder)
 fix
 funicular (ropelike)
 gib (holding member)
 gland (sliding holder)
 gunnel/gunwale (vessel's upper edge)
 guy wire
 harp (lamp shade support)
 hold
 holder
 hook
 imbricate (regular overlap)
 joint
 —universal
 keeper
 key
 latch
 lock
 lug
 matrix
 mount
 nail
 nut
 pin
 plinth (base)
 pricket (holding spike)
 pylon (support)
 restraint
 ribband (holds ribs)
 rivet
 scarf (notched joint)
 screw
 seam
 seat
 secure
 set
 sheathed
 sliding
 snare/loop
 solder
 spike
 spline (projection or groove on a shaft)
 springably
 support
 toe-in

thill (horse joinder stake)
 thrust
 trammel (restraint)
 weld

3. Springs

air
 bias
 —element
 coil
 compressed
 elastic
 expanded
 helical
 —compression
 —tension
 leaf
 press
 relaxed
 resilient
 torsional
 urge

4. Numbers

argument
 caboodle (collection, bunch)
 compound
 congeries (collection, aggregation)
 difference
 dividend
 divisor
 equation
 formula
 index
 lemma
 minuend
 modulo
 multiplicand
 multiplicity
 multiplier
 plurality
 power
 product
 quotient
 remainder
 sheaf

subtrahend
 variable

5. Placement (Relation)

adjacent
 aft
 aligned
 angle
 aposition (facing)
 array
 attached
 axial
 bottom
 close
 complementary
 concentric
 contiguous
 contracted
 course
 crest
 disposed
 distal
 divided
 edge
 engaged
 equitant (overlap in two ranks)
 evert (inside out)
 extended
 external
 face
 fiducial (reference)
 film
 fore
 horizontal
 imbricate (overlapping series)
 incline
 integral
 intermediate
 internal
 interposed
 juxtaposed
 layer
 located
 lower

mating
 meshing
 mesial (between)
 normal
 oblique
 obtuse
 offset
 open
 opposed
 overlapping
 parallel
 perpendicular
 pitched
 positioned
 projecting
 prolapsed (out of place)
 proximal
 proximate
 raked (pitched)
 reference
 removable
 resting
 rim
 row
 sandwich
 section
 slant
 spacer
 staggered
 superimposed
 supported
 surface
 surrounding
 symmetrical
 tilt
 top
 ubiety (located in a place)
 vernier (9:10 gauge)
 vertical

6. Voids

aperture
 bore
 cavity
 chamber
 concavity
 cutout

dimple
 duct
 embrasure (slant opening)
 engraved
 erose (irregular notch)
 filister (groove)
 foramen (opening)
 fossa (depression)
 furrow (groove)
 gain (notch)
 gap
 groove
 hole
 hollow
 infold
 intaginated (engraved)
 invaginate (enclosed, turned in)
 lumen (bore of tube)
 lunette (crescent opening)
 mortise (cutout)
 nock (notch on arrow)
 notch
 opening
 orifice
 passage
 placket (garment slit)
 polled (dehorned)
 rabbet (groove)
 raceway
 recess
 rifling (spiral groove)
 separation
 slit
 slot
 spandrel (triangular gap above arch side)
 sulcus (groove)
 ullage (lost liquid)
 via (path)
 void
 wicket (small door or gate)

7. Shape

acclivity (slope)
 acicular (needle-shaped)
 agonic (no angle)

annular
 anticline (peak)
 applanation
 arch
 arcuate
 bandy (bowed out)
 barrel
 bevel
 bifurcated (2 branches)
 bight (bend)
 botryoidal (like a bunch of grapes)
 bucket
 buckled
 catenary (curve of hanging cable)
 chamfer (beveled)
 channel
 circular
 coin
 concave
 congruent (same shape)
 conical
 convex
 convoluted (curled in)
 corner (inside, outside)
 corrugated
 crest
 crimp
 crispate (curled)
 cup
 cusp (projection)
 cylinder
 depression
 dihedral (two-faced)
 direction
 disc
 dome
 draw (depression)
 drawing (pulling out)
 elliptical
 fairing (streamlined)
 fin
 flange
 fold
 fork
 fossa (groove)
 fundus (base)

furcate (branched)
 goffer (ridges or pleats)
 helical
 hook
 incurvate (curved in)
 infundibuliform (funnel shaped)
 invaginate (sheathed, folded in)
 line
 lobe
 lozenge (diamond-shaped)
 lune (crescent)
 mammilated (nipple-shaped)
 navicular (boat-shaped)
 notch
 oblate (flattened)
 oblong
 ogive (pointed arch)
 orb (globe)
 oval
 parabolic
 parallelogram
 plane
 plicate (pleated)
 prolate (cigar-shaped)
 rectangular
 reticulated (gridlike)
 rhomboid (nonequal adjacent sides)
 rhombus (equal adjacent sides)
 rick-rock
 rill (long narrow valley)
 round
 salient (standing out)
 serrated
 setaceous (bristlelike)
 sheet
 shelf
 sinusoidal
 skive (shaven)
 slab
 spall (broken chips)
 spherical
 spica (overlapping reverse spirals)

square
 stamped
 striated (grooved or ridged)
 swaged (flattened)
 swale (depression)
 syncline (V-shaped)
 taper terminus (end)
 tessellated (tiled)
 topology (unchangeable geometry)
 tortuous (twisting)
 tram (on wheels)
 trefoil (three-leaved)
 triangular
 trihedral (3-sided)
 trough
 tubular
 tumescence (detumescence)
 turbinate (top/spiral shaped)
 twist
 upset (distorted)
 vermiculate (worm-eaten)
 volute (spiral)
 wafer
 web
 wedge
 whorl (spiral)
 xyresic (razor-sharp)

8. Materials and Properties

adhesive
 alluvial (sand or clay deposited by water)
 concrete
 cork
 dappled (spotted)
 denier (gauge)
 dense
 elastic
 enlarged
 fabric
 fiber
 flexible
 foraminous
 frigorific (chilling)
 frit (fused glass)

frosting (dull finish)
 gloss
 haptic (sense of touch)
 humectant (moistener)
 insulation
 intenerate (soften)
 liquid
 material
 metal
 nappy
 opaque
 passivation (inert coating)
 pied (spotched)
 placer (glacial deposit)
 plastic
 porous
 prill
 refractory
 resilient
 rigid
 rubber
 sand
 screen
 shirred (gathered)
 smectic (cleaning)
 stratified (layered)
 strong
 sturdy
 translucent
 transparent
 wood
 xerotic (dry)

9. Optics

aniseikonic (unequal sizes)
 astigmatic
 bezel
 bulb
 —fluorescent
 —incandescent
 fresnel
 lamp
 light
 —beam
 —ray
 opaque

parallax (change in direction)
 pellicle
 pellucid (clear)
 reflection
 refraction
 schlieren (streaks)
 translucent
 transmission
 transparent
 window

10. Fluid

accumulator
 afferent (to center)
 aspirator
 bellows
 bibb (valve)
 bung (hole or stopper)
 cock (valve)
 conduit
 confluent (flow together)
 connector
 convection
 cylinder
 —piston
 —rod
 dashpot
 diaphragm
 discharge
 dispenser
 efferent (away from center)
 filter
 fitting
 flue
 gasket
 hermetic
 hose
 hydraulic
 medium
 navicular (like boat)
 nozzle
 obturator (blocker)
 outlet
 pipe
 plunger
 poppet (axial valve)

port
 —inlet
 —outlet
 pump
 —centrifugal
 —gear
 —piston
 —reservoir
 —seal
 —siphon
 —tank
 —vane
 sparge (spray)
 spud (short connecting pipe)
 sprue (vent tube)
 suctorial (sucking)
 sufflate (inflate)
 swash (channel barrier)
 trompe (water pipe blower)
 tube
 valve
 —ball
 —check
 —control
 —gate
 —shutoff
 wattle (intertwined wall)
 weir (dam)
 wicket (gate or door)

11. Electronics

adder
 amplifier
 astable
 capacitance
 clipping
 conductor
 contact
 control element
 demodulator
 diode
 electrode
 electromagnet
 filament
 flip flop
 gate (AND, OR, etc.)
 impedance

inductance
 insulator
 integrated circuit
 laser
 lead
 light emitting diode
 line cord
 liquid crystal
 maser
 memory
 motor
 multiplier
 multivibrator
 oscillator
 pixel (CRT spot)
 power supply
 raster
 read-and-write memory
 read-only memory
 resistance
 sampling
 Schmitt trigger
 shift register
 Schottky diode
 socket
 solenoid
 switch
 terminal
 thermistor
 transformer
 transistor
 triode
 valve
 varistor
 wire
 Zener diode

12. Movement

alternate
 articulate (jointed)
 avulsion (tear away)
 cadent (rhythmic)
 cam
 compression
 cyclic
 detent (click)
 downward

draft (pull)
 drag
 drift pin
 drill
 eccentric
 emergent
 epicyclic (on circle)
 equilibrate (bring into equilibrium)
 escapement
 extensible
 extrude
 grinding
 impact
 inclined plane
 inertia
 interval
 lag
 lead
 lever
 linkage
 —parallel
 longitudinal
 machine
 meeting
 nutate (to and fro)
 pressing
 propelling
 pulverize
 sagging
 sequacious (regular)
 severing
 shuttle (to & fro member)
 skive (peel)
 slidable
 snub (stop)
 straight line
 —motion
 terminating
 toggle
 torque
 traction
 transverse
 traversing
 triturate (grind to powder)
 trochoid (roll on circle)
 urging
 vibrating

wedge

13. Rotation/ Machine

antifriction
 —ball
 —needle
 —roller
 —tapered
 arbor (shaft)
 bell crank
 bobbin (spool)
 brake
 —band
 —disk
 —shoe
 bushing
 cam
 chain
 clevis (circular holder)
 clutch
 —centrifugal
 —one-way
 —sprag (stop)
 —toothed
 cog (tooth)
 comminute (pulverize)
 connecting rod
 crank arm
 drive
 —belt
 —pulley
 —sheave
 —toothed
 flexible coupling
 friction
 fulcrum
 gear
 —bevel
 —crown
 —internal
 —noncircular
 —pinion
 —right angle
 —spur
 —wheel
 —worm
 gimbal (double pivot)
 gin (hoist, pile driver, pump)
 guide
 gudgeon (axle)
 hinge
 intermittent
 —escapement
 —geneva
 —pawl
 —pendulum
 —ratchet
 jack
 journal
 mandrel
 orbit
 pinion (small wheel)
 pintle (axle)
 pivot
 pulley
 radial
 radius bar
 score (thinned strip)
 screw
 seal
 sheave (pulley)
 spindle
 sprocket
 swash (wobble) plate
 tappet (valve cam)
 trunnion
 variable speed
 vertiginous (turning)
 ward (ridge or notch)
 winch
 yoke

14. Biology

anastomosis (connection of tubes)
 atrium (cavity)
 brady (slow)
 catamenial (menstrual)
 explant (transplant living tissue)
 fibrillation (twitching)
 tachy (rapid)
 ventricle (chamber)

B. Glossary of Legal Terms

abandonment (1) allowing a pending, active patent application to be removed from the PTO's active files and treated as if the inventor has given up all claims to a patent on the invention. An inventor can expressly abandon an application by letter or allow an application to go abandoned by not timely replying to an office action. (2) treating an invention as if the inventor has lost all interest in exploiting it, usually by not developing it or by not filing a patent application on it for a very long time.

abstract a concise, one-paragraph summary of the patent. It details the structure, nature, and purpose of the invention. The abstract is used by the PTO and the public to quickly determine the gist of what is being disclosed.

actual damages (also known as compensatory damages) in a lawsuit, money awarded to one party to cover actual injury or economic loss. Actual damages are intended to put the injured party in the position he was in prior to the injury.

agent (patent) a person licensed by the PTO to represent others in handling patents and patent applications before the PTO. Patent agents are required to have a technical degree or technical knowledge in a specific field.

answer a written response to a complaint (the opening papers in a lawsuit) in which the defendant admits or denies the allegations and may provide a list of defenses.

assignee a person or legal entity to which an assignment is made.

assignor one who makes an assignment.

assignment a document transferring ownership of an invention and/or a patent application or patent.

attorney (patent) a person licensed by the PTO to represent others in handling patents and patent applications before the PTO and who is also licensed to practice law. Patent attorneys are required to have a technical degree or technical knowledge in a specific field.

best mode a term indicating that a patent application should disclose the way the inventor presently prefers to make the invention.

Board of Appeals and Patent Interferences (BAPI) a tribunal of judges at the PTO that hears appeals from final Office Actions.

cease and desist letter correspondence from the owner of a proprietary work that requests the cessation of all infringing activity.

clear and convincing proof evidence that is highly probable and free from serious doubt.

complaint papers filed with a court clerk by the plaintiff to initiate a lawsuit by setting out facts and legal claims (usually called causes of action).

compositions of matter items such as chemical compositions, conglomerates, aggregates, or other chemically significant substances that are usually supplied in bulk (solid or particulate), liquid, or gaseous form.

conception the mental part of inventing, including how an invention is formulated or how a problem is solved.

confidentiality agreement (also known as a nondisclosure agreement) a contract in which one or both parties agree not to disclose certain information.

continuation application a new patent application that allows the applicant to re-present an invention and get a second or third bite at the apple. The applicant can file a new application (known as a "continuation") while the original (or "parent") application is still pending. A continuation application consists of the same invention, cross-referenced to the parent application, and a new set of claims. The applicant retains the filing date of the parent application for purposes of determining the relevancy of prior art.

Continuation-in-Part (CIP) less common than a continuation application, this form of extension application is used when a portion or all of an earlier patent application is continued and new matter (not disclosed in the earlier application) is included. CIP applications are used when an applicant wants to present an improvement but is prevented from adding a pending application to it because of the prohibition against adding "new matter."

Continuing Prosecution Application (CPA) a patent application that is like a continuation application in effect, but no new application need be filed. The applicant merely pays another filing fee, submits new claims, and files a CPA request form. CPAs can only be used for applications filed prior to 2000 May 29. Applications after that date must use the Request for Continued Examination.

contributory infringement occurs when a material component of a patented invention is sold with knowledge that the component is designed for an unauthorized use. This type of infringement cannot occur unless there is a direct infringement. In other words, it is not enough to sell infringing parts; those parts must be used in an infringing invention.

copyright the legal right to exclude others, for a limited time, from copying, selling, performing, displaying, or making derivative versions of a work of authorship such as a writing, music, or artwork.

counterclaim a legal claim usually asserted by the defendant against an opposing party, usually the plaintiff.

Court of Appeals for the Federal Circuit (CAFC) the federal appeals court that specializes in patent appeals. If the Board of Appeals and Patent Interferences rejects an application appeal, an applicant can further appeal to the CAFC within 60 days of the decision. If the CAFC upholds the PTO, the applicant can request the United States Supreme Court hear the case (although the Supreme Court rarely hears patent appeals).

date of invention the earliest of the following dates: (a) the date an inventor filed the patent application (provisional or regular), (b) the date an inventor can prove that the invention was built and tested in the U.S. or a country that is a member of the North American Free Trade Association (NAFTA) or the World Trade Organization (WTO), or (c) the date an inventor can prove that the invention was conceived in a NAFTA or WTO country, provided the inventor can also prove diligence in building and testing it or filing a patent application on it.

declaratory action a request that the court sort out the rights and legal obligations of the parties in the midst of an actual controversy.

deed (patent) a document under seal or certificate issued by the PTO containing a printed copy of a patent and granting a patent monopoly to the patentee and the patentee's assignee.

deposit date the date the PTO receives a patent application.

deposition oral or written testimony of a party or witness and given under oath.

design patent covers the unique, ornamental, or visible shape or design of a nonnatural object.

divisional application a patent application used when an applicant wants to protect several inventions claimed in the original application. The official definition is "a later application for a distinct or independent invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in the earlier or parent application" (MPEP 201.06). A divisional application is entitled to the filing date of the parent case for purposes of overcoming prior art. The divisional application must be filed while the parent is pending. A divisional application can be filed as a CPA.

Doctrine of Equivalents (DoE) a form of patent infringement that occurs when an invention performs substantially the same function in substantially the same manner and obtains the same result as the patented invention. A court analyzes each element of the patented invention separately. Under a recent Supreme Court decision, the DoE must be applied on an element-by-element basis to the claims.

double patenting when an applicant has obtained a patent and has filed a second application containing the same invention, the second application will be rejected. If the second application resulted in a patent, that patent will be invalidated. Two applications contain the same invention when the two inventions are literally the same or the second invention is an obvious modification of the first invention.

embodiment a physical version of an invention as described in a patent application; a patent application may describe several embodiments of an invention, but is supposed to state the one that the inventor considers the **best mode** as of the filing date; see **ramification**.

enhanced damages (treble damages) in exceptional infringement cases, financial damages may be increased, at the discretion of the court, up to triple the award for actual damages (known as "enhanced damages").

examiner's answer a brief submitted by a patent examiner in response to an applicant's brief in an appeal to the PTO's Board of Patent Appeals and Interferences.

exclusive jurisdiction the sole authority of a court to hear a certain type of case.

exhaustion (see "first sale doctrine").

ex parte (Latin: one party only) refers to legal proceedings where only one party is present or represented.

experimental use doctrine a rule excusing an inventor from the one-year bar provided that the alleged sale or public use was primarily for the purpose of perfecting or testing the invention.

file wrapper estoppel (or prosecution history estoppel) affirmative defense used in patent infringement litigation that precludes the patent owner from asserting rights that were disclaimed during the patent application process. The term is derived from the fact that the official file in which a patent is contained at the Patent and Trademark Office is known as a "file wrapper." All statements, admissions, correspondence, or documentation relating to the invention are placed in the file wrapper. Estoppel means that a party is prevented from acting contrary to a former statement or action when someone else has relied to his detriment on the prior statement or action.

final Office Action the examiner's response to the applicant's first amendment. The final Office Action is supposed to end the prosecution stage but a "final action" is rarely final.

first Office Action (sometimes called an "official letter" or "OA") response from the patent examiner after the initial examination of the application. It is very rare that an application is allowed in the first Office Action. More often, the examiner rejects some or all of the claims.

first sale doctrine (also known as the exhaustion doctrine)

once a patented product (or product resulting from a patented process) is sold or licensed, the patent owner's rights are exhausted and the owner has no further rights as to the resale of that particular article.

generic (genus) an entire group or class, or a group of related items or species.

grace period a period in which an action may be taken even though the normal period for taking action has passed.

indirect infringement occurs either when someone is persuaded to make, use, or sell a patented invention without authorization (inducing infringement); or when a material component of a patented invention is sold with knowledge that the component is designed for an unauthorized use (contributory infringement). An indirect infringement cannot occur unless there is a direct infringement. In other words, it is not enough to sell infringing parts; those parts must be used in an infringing invention.

infringement an invention is infringing if it is a literal copy of a patented invention or if it performs substantially the same function in substantially the same manner and obtains the same result as the patented invention (see "doctrine of equivalents").

injunction a court order requiring that a party halt a particular activity. In the case of patent infringement, a court can order all infringing activity be halted at the end of a trial (a permanent injunction) or the patent owner can attempt to halt the infringing activity immediately, rather than wait for a trial (a preliminary injunction). A court uses two factors to determine whether to grant a preliminary injunction: (1) Is the plaintiff likely to succeed in the lawsuit? (2) Will the plaintiff suffer irreparable harm if the injunction is not granted? The patent owner may seek relief for a very short injunction known as a temporary restraining order or TRO, which usually only lasts a few days or weeks. A temporary restraining order may be granted without notice to the infringer if it appears that immediate damage will result—for example, that evidence will be destroyed.

intellectual property (IP) the law dealing with works that are produced by mental activity, including ideas, inventions, patents, trademarks, trade secrets, copyrightable material, and unfair competition.

intellectual property attorney a person licensed to practice law by one or more states and who specializes in intellectual property. There are two types of IP attorneys: those who are licensed by the PTO (and can handle invention and patent matters before the PTO); and those who are not.

interference a costly, complex PTO proceeding that determines who will get a patent when two or more applicants are claiming the same invention. It is basically a method of sorting out priority of inventorship. Occasionally an interference may involve a patent that has been in force for less than one year.

inter partes (Latin: between parties) refers to legal proceedings where all parties to the action are represented.

interrogatories written questions that must be answered under oath.

invention any new article, machine, composition, or process or new use developed by a human.

jury instructions explanations of the legal rules that the jury must use in reaching a verdict.

lab notebook a system of documenting an invention that usually includes descriptions of the invention and novel features; procedures used in the building and testing of the invention; drawings, photos, or sketches of the invention; test results and conclusions; discussions of any known prior-art references; and additional documentation such as correspondence and purchase receipts.

literal infringement occurs if a defendant makes, sells, or uses the invention defined in the plaintiff's patent claim. In other words, the infringing product includes each and every component, part, or step in the patented invention. It is a literal infringement because the defendant's device is actually the *same* invention in the patent claim.

machine a device or things used for accomplishing a task; usually involves some activity or motion performed by working parts.

magistrate an officer of the court, who may exercise some of the authority of a federal district court judge, including the authority to conduct a jury or nonjury trial.

manufactures (sometimes termed "articles of manufacture") items that have been made by human hands or by machines; may have working or moving parts as prime features.

means-plus-function clause (or means-for clause) a provision in a patent claim in which the applicant does not specifically describe the structure of one of the items in the patent and instead describes the function of the item. Term is derived from the fact that the clause usually starts with the word "means."

new matter any technical information, including dimensions, materials, etc., that was not present in the patent application as originally filed. An applicant can never add new matter to an application (PTO Rule 118).

new-use invention a new and unobvious process or method for using an old and known invention.

nonobviousness a standard of patentability that requires that an invention produce “unusual and surprising results.” In 1966, the U.S. Supreme Court established the steps for determining unobviousness in the case of *Graham v. John Deere*, 383 U.S. 1 (1966).

Notice of Allowance a document issued when the examiner is convinced that the application meets the requirements of patentability. An issue fee is due within three months.

objection a disapproval made by an examiner to a nonsubstantive matter, such as an unclear drawing or dependent claim having a rejected claim.

objects and advantages a phrase used to explain “what the invention accomplishes.” Usually, the objects are also the invention’s advantages, since those aspects are intended to be superior over prior art.

Office Action (OA, also known as Official Letter or Examiner’s Action) correspondence (usually including forms and a letter) from a patent examiner that describes what is wrong with the application and why it cannot be allowed. Generally, an OA will reject claims, list defects in the specifications or drawings, raise objections, or cite and enclose copies of relevant prior art demonstrating a lack of novelty or nonobviousness.

one-year rule a rule that requires an inventor to file a patent application within one year after selling, offering for sale, or commercially or publicly using or describing an invention. If an inventor fails to file within one year of such occurrence the inventor is barred from obtaining a patent.

on-sale bar prevents an inventor from acquiring patent protection if the application is filed more than one year from the date of sale, use, or offer of sale of the invention in the United States.

patent a grant from a government that confers upon an inventor the right to exclude others from making, using, selling, importing, or offering an invention for sale for a fixed period of time.

patent application a set of papers that describe an invention and that are suitable for filing in a patent office in order to apply for a patent on the invention.

Patent Application Declaration (PAD) a declaration that identifies the inventor or joint inventors and provides an attestation by the applicant that the inventor understands the contents of the claims and specification and has fully disclosed all material information. The PTO provides a form for the PAD.

patent misuse a defense in patent infringement that prevents a patent owner who has abused patent law from enforcing patent rights. Common examples of misuse

are violation of the antitrust laws or unethical business practices.

patent pending (also known as the “pendency period”) time between filing a patent application (or PPA) and issuance of the patent. The inventor has no patent rights during this period. However, when and if the patent later issues, the inventor will obtain the right to prevent the continuation of any infringing activity that started during the pendency period. If the application has been published by the PTO during the pendency period and the infringer had notice, the applicant may later seek royalties for these infringements during the pendency period. It’s a criminal offense to use the words “patent applied for” or “patent pending” (they mean the same thing) in any advertising if there’s no active, applicable regular or provisional patent application on file.

patent prosecution the process of shepherding a patent application through the Patent and Trademark Office.

Patent Rules of Practice administrative regulations located in Volume 37 of the Code of Federal Regulations (37 CFR § 1).

pendency period (see patent pending).

permanent injunction a durable injunction issued after a final judgment on the merits of the case; permanently restrains the defendant from engaging in the infringing activity.

Petition to Make Special an applicant can, under certain circumstances, have an application examined sooner than the normal course of PTO examination (one to three years). This is accomplished by filing a “Petition to Make Special” (PTMS), together with a Supporting Declaration.

plant patent covers plants that can be reproduced through the use of grafts and cuttings (asexual reproduction).

power of attorney a document that gives another person legal authority to act on your behalf. If an attorney is preparing an application on behalf of an inventor, a power of attorney should be executed to authorize the patent attorney or agent to act on behalf of the inventor. The power of attorney form may be combined with the PAD.

prima facie (Latin: on its face) at first sight, obvious.

prior art the state of knowledge existing or publicly available either before the date of an invention or more than one year prior to the patent application date.

priority the benefit of the filing date of an earlier patent application accorded to a later-filed patent application.

process (sometimes referred to as a “method”) a way of doing or making things that involves more than purely mental manipulations.

Provisional Patent Application (PPA) an interim document that clearly explains how to make and use the invention. The PPA is equivalent to a reduction to practice (see below). If a regular patent application is filed within one year of filing the PPA, the inventor can use the PPA's filing date for the purpose of deciding whether a reference is prior art. In addition to an early filing date, an inventor may claim patent pending status for the one-year period following the filing of the PPA.

ramification a version or variation of an invention that is different from a main version or **best mode**.

reduction to practice the point at which the inventor can demonstrate that the invention works for its intended purpose. Reduction to practice can be accomplished by building and testing the invention (actual reduction to practice) or by preparing a patent application or provisional patent application that shows how to make and use the invention and that it works (constructive reduction to practice). In the event of a dispute or a challenge at the PTO, invention documentation is essential in order to prove the "how and when" of conception and reduction to practice.

reissue application an application used to correct information in a patent. It is usually filed when a patent owner believes the claims are not broad enough, the claims are too broad (the applicant discovered a new reference), or there are significant errors in the specification. In these cases, the applicant seeks to correct the patent by filing an application to get the applicant's original patent reissued at any time during its term. The reissue patent will take the place of the applicant's original patent and expire the same time as the original patent would have expired. If the applicant wants to broaden the claims of the patent through a reissue application, the applicant must do so within two years from the date the original patent issued. There is a risk in filing a reissue application because all of the claims of the original patent will be examined and can be rejected.

rejection a disapproval made by an examiner to a substantive matter such as a claim which is deemed obvious over the prior art.

repair doctrine affirmative defense based on the right of an authorized licensor of a patented device to repair and replace unpatented components. It also includes the right to sell materials used to repair or replace a patented invention. The defense does not apply for completely rebuilt inventions, unauthorized inventions, or items that are made or sold without authorization of the patent owner.

reply a brief submitted by a patent applicant in response to an examiner's answer.

request for admission request for a party to the lawsuit to admit the truthfulness of a statement.

Request for Continued Examination (RCE) a paper filed when a patent applicant wishes to continue prosecuting an application that has received a final **Office Action**. Filing the RCE with another filing fee effectively removes the final action so that the applicant can submit further amendments, for example, new claims, new arguments, a new declaration, or new references.

request for production of documents the way a party to a lawsuit obtains documents or other physical evidence from the other side.

reverse doctrine of equivalents (or negative doctrine of equivalents) a rarely used affirmative defense to patent infringement in which, even if there is a literal infringement, the court will excuse the defendant's conduct if the infringing device has a different function or result than the patented invention. The doctrine is applied when the allegedly infringing device performs the same function in a substantially different way.

sequence listing an attachment to a patent application used if a biotech invention includes a sequence listing of a nucleotide or amino acid sequence. The applicant attaches this information on separate sheets of paper and refers to the sequence listing in the application (see PTO Rule 77). If there is no sequence listing, the applicant states "Non-applicable."

small entity a status that enables small businesses, independent inventors, and nonprofit companies to pay a reduced application fee. There are three types of small entities: (1) independent inventors, (2) nonprofit companies, and (3) small businesses. To qualify, an independent inventor must either own all rights, or have transferred—or be obligated to transfer—rights to a small business or nonprofit organization. Nonprofit organizations are defined and listed in the Code of Federal Regulations and usually are educational institutions or charitable organizations. A small-entity business is one with fewer than 500 employees. The number of employees is computed by averaging the number of full- and part-time employees during a fiscal year.

species one of a group of related individual items collectively subordinate to a genus.

specification a patent application disclosure made by the inventor and drafted so that an individual skilled in the art to which the invention pertains could, when reading the patent, make and use the invention without needing further experiment. A **specification** is constructed of several sections. Collectively, these sections form a narrative that describes and distinguishes the invention.

If it can later be proved that the inventor knew of a better way (or “best mode”) and failed to disclose it, that failure could result in the loss of patent rights.

statute of limitations the legally prescribed time limit in which a lawsuit must be filed. In patent law there is no time limit (statute of limitations) for filing a patent infringement lawsuit, but monetary damages can only be recovered for infringements committed during the six years prior to the filing the lawsuit. For example, if a patent owner sues after ten years of infringement, the owner cannot recover monetary damages for the first four years of infringement. Despite the fact that there is no law setting a time limit, courts will not permit a patent owner to sue for infringement if the owner has waited an unreasonable time to file the lawsuit (“laches”).

Statutory Invention Registration (SIR) a document that allows an applicant who abandons an application to prevent anyone else from getting a valid patent on the same invention. This is accomplished by converting the patent application to a SIR.

statutory subject matter an invention that falls into one of the five statutory classes: process (method), machine, article of manufacture, composition, or a “new use” of one of the first four.

substitute application essentially a duplicate of an abandoned patent application. (See MPEP § 201.09.) The disadvantage of a substitute application is that the applicant doesn’t get the benefit of the filing date of the previously abandoned patent application, which could be useful, because any prior art occurring after the filing date of the earlier case can be used against the substitute case. If the applicant’s substitute application issues into a patent, the patent will expire 20 years from the filing date of the substitute.

successor liability responsibility for infringement that is borne by a company that has purchased another company that is liable for infringements. In order for successor liability to occur, there must be an agreement between the companies to assume liability, a merger between the companies, or the purchaser must be a “continuation” of the purchased business. If the sale is made to escape liability and lacks any of the foregoing characteristics, liability will still attach.

summons a document served with the complaint that tells the defendant he has been sued, has a certain time limit in which to respond, and must appear in court on a stated date.

temporary restraining order (TRO) a court order that tells one party to do or stop doing something—for example to stop infringing. A TRO is issued after the aggrieved party appears before a judge. Once the TRO is issued, the court holds a second hearing where the other side can tell its story and the court can decide whether to make the TRO permanent by issuing an injunction. The TRO is often granted *ex parte* (without allowing the other side to respond), and for that reason is short in duration and only remains in effect until the court has an opportunity to schedule a hearing for the preliminary injunction.

traverse to argue against.

tying a form of patent misuse in which, as a condition of a transaction, the buyer of a patented device must also purchase an additional product. For example, in one case a company had a patent on a machine that deposited salt tablets in canned food. Purchasers of the machine were also required to buy salt tablets from the patent owner. A party that commits patent misuse may have its patent invalidated, may have to pay monetary damages, or both.

utility patent the main type of patent, which covers inventions that function in a unique manner to produce a utilitarian result.

verified statement a statement made under oath or a declaration. A false verified statement is punishable as perjury.

vicarious liability legal responsibility that results when a business such as a corporation or partnership is liable for infringements committed by employees or agents. This liability attaches when the agent acts under the authority or direction of the business, an employee acts within the scope of employment, or the business benefits from, or adopts or approves the infringing activity.

voir dire (“*speak the truth*”) process by which attorneys and judges question potential jurors in order to determine whether they may be fair and impartial.

Fee Schedule



CAUTION

The following table provides the patent-related PTO fees as of the date of publication of this edition. To see current fees go to the PTO website (www.uspto.gov), then click Patents, then Fees, then Current FY20xx Fee Schedule. If you file by EFS-Web (strongly recommended) all current fees are also on the Fee-Payment pages. The PTO usually raises its fees

every October 1, but has not done so for 2009 and 2010. If you underpay any fee, the PTO imposes a stiff surcharge. The second column identifies the purpose of the fee and the first column identifies the pertinent PTO Rule. The third column indicates the fee for a large entity and the fourth column indicates the fee for a small entity. If there is no entry in the fourth column the fee in the third column also applies to a small entity.

37 CFR	Description	Fee	Small Entity Fee
Patent Application Filing Fees			
1.16(a)(1)	Basic filing fee—Utility *	330	165
1.16(a)(1)	Basic filing fee—Utility (electronic filing for small entities) *	n/a	82
1.16(h)	Independent claims in excess of three	220	110
1.16(i)	Claims in excess of 20	52	26
1.16(j)	Multiple dependent claim	390	195
1.16(f)	Surcharge—Late filing fee, search fee, exam fee, or oath/ declaration	130	65
1.16(s)	Utility Application Size Fee—for each additional 50 sheets that exceed 100 sheets	270	135
1.16(b)(1)	Basic filing fee—Design *	220	110
1.16(c)(1)	Basic filing fee—Plant *	220	110
1.16(e)(1)	Basic filing fee—Reissue *	330	165
1.16(h)	Reissue independent claims in excess of three	220	110
1.16(i)	Reissue claims in excess of 20	52	26
1.16(s)	Reissue Application Size Fee—for each additional 50 sheets that exceed 100 sheets	270	135
1.16(d)	Provisional application filing fee	220	110
1.16(s)	Provisional Application Size Fee—for each additional 50 sheets that exceed 100 sheets	270	135
1.16(g)	Surcharge—Late provisional filing fee or cover sheet	50	25
1.17(i)	Non-English specification	130	

* Basic filing fee, search fee, and examination fees for Utility, Design, Plant, and Reissue applications must all be paid in one lump sum.

37 CFR	Description	Fee	Small Entity Fee
1.16(k)	Utility Search Fee *	540	270
1.16(l)	Design Search Fee *	100	50
1.16(m)	Plant Search Fee *	330	165
1.16(n)	Reissue Search Fee *	540	270
1.16(o)	Utility Examination Fee *	220	110
1.16(p)	Design Examination Fee *	140	70
1.16(q)	Plant Examination Fee *	170	85
1.16(r)	Reissue Examination Fee *	650	325
Patent Post-Allowance Fees			
1.18(a)	Utility issue fee	1,510	755
1.18(b)	Design issue fee	860	430
1.18(c)	Plant issue fee	1,190	595
1.18(a)	Reissue issue fee	1,510	755
1.18(d)	Publication fee for early, voluntary, or normal publication	300	
1.18(d)	Publication fee for republication	300	
Patent Maintenance Fees			
1.20(e)	Due at 3.5 years	980	490
1.20(f)	Due at 7.5 years	2,480	1,240
1.20(g)	Due at 11.5 years	4,110	2,055
1.20(h)	Surcharge—year 3.5—Late payment within 6-month grace period	130	65
1.20(h)	Surcharge—year 7.5—Late payment within 6-month grace period	130	65
1.20(h)	Surcharge—year 11.5—Late payment within 6-month grace period	130	65
1.20(i)(1)	Surcharge after expiration—Late payment is unavoidable	700	
1.20(i)(2)	Surcharge after expiration—Late payment is unintentional	1,640	
Miscellaneous Patent Fees			
1.17(e)	Request for Continued Examination (RCE) (see 37 CFR 1.114)	810	405
1.17(i)	Processing fee, except in provisional applications	130	
1.17(i)	Request for voluntary publication or republication	130	
1.17(k)	Request for expedited examination of a design application	900	
1.17(n)	Request for publication of SIR—Prior to examiner's action	920 °	
1.17(o)	Request for publication of SIR—After examiner's action	1,840 °	
1.17(p)	Submission of an Information Disclosure Statement	180	
* Basic filing fee, search fee, and examination fees for Utility, Design, Plant, and Reissue applications must all be paid in one lump sum.			
° Reduced by basic filing fee paid.			

37 CFR	Description	Fee	Small Entity Fee
1.17(q)	Processing fee to correct error in provisional applications	50	
1.17(r)	Filing a submission after final rejection under special transitional procedure (see 37 CFR 1.129(a))	810	405
1.17(s)	For each additional invention to be examined (see 37 CFR 1.129(b))	810	405
1.20(d)	Statutory disclaimer	140	70
Post-Issuance Fees			
1.20(a)	Certificate of correction	100	
1.20(c)(1)	Request for ex parte reexamination	2,520	
1.20(c)(2)	Request for inter partes reexamination	8,800	
1.20(c)(4)	Reexamination claims in excess of 20 and also in excess of the number of claims in the patent under reexamination	52	26
1.20(d)	Statutory disclaimer	140	70
Extension-of-Time Fees			
1.17(a)(1)	Extension for response within first month	130	65
1.17(a)(2)	Extension for response within second month	490	245
1.17(a)(3)	Extension for response within third month	1,110	555
1.17(a)(4)	Extension for response within fourth month	1,730	865
1.17(a)(5)	Extension for response within fifth month	2,350	1,175
Patent Appeal Fees			
41.20(b)(1)	Notice of appeal	540	270
41.20(b)(2)	Filing a brief in support of an appeal	540	270
41.20(b)(3)	Request for oral hearing	1,080	540
Patent Petition Fees			
1.17(f)	Petitions requiring the petition fee set forth in 37 CFR 1.17(f) (Group I)	400	
1.17(g)	Petitions requiring the petition fee set forth in 37 CFR 1.17(g) (Group II)	200	
1.17(h)	Petitions requiring the petition fee set forth in 37 CFR 1.17(h) (Group III)	130	
1.17(l)	Petition to revive unavoidably abandoned application	540	270
1.17(m)	Petition to revive unintentionally abandoned application	1,620	810
1.17(t)	Acceptance of an unintentionally delayed claim for priority, or for filing a request for the restoration of the right of priority	1,410	
1.18(e)	Filing an application for patent term adjustment	200	
1.18(f)	Request for reinstatement of term reduced	400	
1.20(j)(1)	Extension of term of patent	1,120	
1.20(j)(2)	Initial application for interim extension (see 37 CFR 1.790)	420	
1.20(j)(3)	Subsequent application for interim extension (see 37 CFR 1.790)	220	

37 CFR	Description	Fee	Small Entity Fee
PCT Fees			
1.492(a)	Basic National Stage Fee	330	165
1.492(b)(1)	National Stage Search Fee—U.S. was the ISA or IPEA and all claims satisfy PCT Article 33(1)-(4)	0	0
1.492(b)(2)	National Stage Search Fee—U.S. was the ISA	100	50
1.492(b)(3)	National Stage Search Fee—search report prepared and provided to USPTO	430	215
1.492(b)(4)	National Stage Search Fee—all other situations	540	270
1.492(c)(1)	National Stage Examination Fee—U.S. was the ISA or IPEA and all claims satisfy PCT Article 33(1)-(4)	0	0
1.492(c)(2)	National Stage Examination Fee—all other situations	220	110
1.492(d)	Claims—extra independent (over three)	220	110
1.492(e)	Claims—extra total (over 20)	52	26
1.492(f)	Claims—multiple dependent	390	195
1.492(j)	National Stage Application Size Fee—for each additional 50 sheets that exceed 100 sheets	270	135
1.492(h)	Search fee, examination fee, or oath or declaration after 30 months from priority date	130	65
1.445(a)(1)	Transmittal fee	240	
1.445(a)(2)	Search fee—regardless of whether there is a corresponding application (see 35 USC 361(d) and PCT Rule 16)	2,080	
1.445(a)(3)	Supplemental search fee when required, per additional invention	2,080	
1.482(a)(1)	Preliminary examination fee—U.S. was the ISA	600	
1.482(a)(1)	Preliminary examination fee—U.S. was not the ISA	750	
1.482(a)(2)	Supplemental examination fee per additional invention	600	
	Late payment fee	variable	
1.445(a)(4)	Transmitting application to Intl. Bureau to act as receiving office	240	
	International filing fee (first 30 pages—filed in paper with PCT EASY zip file or electronically without PCT EASY zip file)	1,181	
	International filing fee (first 30 pages)—filed electronically with PCT Easy zip file	1,085	
	International filing fee (first 30 pages)	1,277	
	Supplemental fee (for each page over 30)	14	
	International search (EPO)	2,185	
	International search (IPAU)	1,605	
	International search (KIPO)	1,092	
	Handling fee	195	
	Handling Fee—90% reduction, if applicants meet criteria specified at: www.wipo.int/pct/en/fees/fee_reduction.pdf	19.50	

37 CFR	Description	Fee	Small Entity Fee
Patent Service Fees			
1.19(a)(1)	Printed copy of patent w/o color, delivery by USPS, USPTO Box, or electronic means	0	
1.19(a)(2)	Printed copy of plant patent in color	15	
1.19(a)(3)	Color copy of patent (other than plant patent) or SIR containing a color drawing	25	
1.19(a)(1)	Patent Application Publication (PAP)	3	
1.19(b)(1)(i)(A)	Copy of patent application as filed	20	
1.19(b)(1)(i)(B)	Copy of patent-related file wrapper and contents of 400 or fewer pages, if provided on paper	200	
1.19(b)(1)(i)(C)	Additional fee for each additional 100 pages of patent-related file wrapper and (paper) contents, or portion thereof	40	
1.19(b)(1)(i)(D)	Individual application documents, other than application as filed, per document	25	
1.19(b)(1)(ii)(B)	Copy of patent-related file wrapper and contents if provided electronically or on a physical electronic medium as specified in 1.19(b)(1)(ii)	55	
1.19(b)(1)(ii)(C)	Additional fee for each continuing physical electronic medium in single order of 1.19(b)(1)(ii)(B)	15	
1.19(b)(2)(i)(A)	Copy of patent-related file wrapper contents that were submitted and are stored on compact disk or other electronic form (e.g., compact disks stored in Artifact folder), other than as available in 1.19(b)(1); first physical electronic medium in a single order	55	
1.19(b)(2)(i)(B)	Additional fee for each continuing copy of patent-related file wrapper contents as specified in 1.19(b)(2)(i)(A)	15	
1.19(b)(2)(ii)	Copy of patent-related file wrapper contents that were submitted and are stored on compact disk, or other electronic form, other than as available in 1.19(b)(1); if provided electronically other than on a physical electronic medium, per order	55	
1.19(b)(3)	Copy of office records, except copies of applications as filed	25	
1.19(b)(4)	For assignment records, abstract of title, and certification, per patent	25	
1.19(c)	Library service	50	
1.19(d)	List of U.S. patents and SIRs in subclass	3	
1.19(e)	Uncertified statement re status of maintenance fee payments	10	
1.19(f)	Copy of non-U.S. document	25	
1.19(g)	Petitions for documents in form other than that provided by this part, or in form other than that generally provided by Director, to be decided in accordance with merits	at cost	
1.21(d)	Local delivery box rental, annually	50	
1.21(e)	International type search report	40	
1.21(g)	Self-service copy charge, per page	25¢	
1.21(h)	Recording each patent assignment, agreement, or other paper, per property	40	

37 CFR	Description	Fee	Small Entity Fee
1.21(i)	Publication in <i>Official Gazette</i>	25	
1.21(j)	Labor charges for services, per hour or fraction thereof	40	
1.21(k)	Unspecified other services, excluding labor	at cost	
1.21(l)	Retaining abandoned application	130	
1.21(n)	Handling fee for incomplete or improper application	130	
1.296	Handling fee for withdrawal of SIR	130	
Trademark Fees			
2.6(a)(1)(i)	Application for registration, per international class (paper filing)	375	
2.6(a)(1)(ii)	Application for registration, per international class (electronic filing, TEAS application)	325	
2.6(a)(1)(iii)	Application for registration, per international class (electronic filing, TEAS Plus application)	275	
2.6(a)(2)	Filing an Amendment to Allege Use under § 1(c), per class	100	
2.6(a)(3)	Filing a Statement of Use under § 1(d)(1), per class	100	
2.6(a)(4)	Filing a Request for a Six-month Extension of Time for Filing a Statement of Use under § 1(d)(1), per class	150	
2.6(a)(15)	Petitions to the Director	100	
2.6(a)(19)	Dividing an application, per new application (file wrapper) created	100	
2.6(a)(1)(iv)	Additional fee for application that doesn't meet TEAS Plus filing requirements, per class	50	
2.6(a)(5)	Application for renewal, per class	400	
2.6(a)(6)	Additional fee for filing renewal application during grace period, per class	100	
2.6(a)(21)	Correcting a deficiency in a renewal application	100	
2.6(a)(12)	Filing § 8 affidavit, per class	100	
2.6(a)(14)	Additional fee for filing § 8 affidavit during grace period, per class	100	
2.6(a)(20)	Correcting a deficiency in a § 8 affidavit	100	
2.6(a)(13)	Filing § 15 affidavit, per class	200	
2.6(a)(7)	Publication of mark under § 12(c), per class	100	
2.6(a)(8)	Issuing new certificate of registration	100	
2.6(a)(9)	Certificate of correction, registrant's error	100	
2.6(a)(10)	Filing disclaimer to registration	100	
2.6(a)(11)	Filing amendment to registration	100	
2.6(a)(16)	Petition for cancellation, per class	300	
2.6(a)(17)	Notice of opposition, per class	300	
2.6(a)(18)	Ex parte appeal, per class	100	

37 CFR	Description	Fee	Small Entity Fee
7.6(a)(1)	Certifying an International application based on single application or registration, per class	100	
7.6(a)(2)	Certifying an International application based on more than one basic application or registration, per class	150	
7.6(a)(3)	Transmitting a Request to Record an Assignment or restriction under 7.23 or 7.24	100	
7.6(a)(4)	Filing a Notice of Replacement, per class	100	
7.6(a)(5)	Filing an affidavit under § 71 of the Act, per class	100	
7.6(a)(6)	Surcharge for filing affidavit under § 71 of the Act during grace period, per class	100	
7.6(a)(7)	Transmitting a subsequent designation	100	
7.7(1)	International application fee	Reference CFR 7.7 for payment of fees to International Bureau (IB) and IB calculator at: www.wipo.int/madrid/en	
7.14(c)	Correcting irregularities in an International application		
7.21	Subsequent designation fee		
7.23	Recording of an assignment of an international registration under § 7.23		
2.6(b)(1)	Printed copy of registered mark, delivery by USPS, USPTO Box, or electronic means	3	
2.6(b)(7)	For assignment records, abstracts of title, and certification per registration	25	
2.6(b)(9)	Self-service copy charge, per page	25¢	
2.6(b)(6)	Recording trademark assignment, agreement, or other paper, first mark per document	40	
2.6(b)(6)	For second and subsequent marks in the same document	25	

Mail, Telephone, Fax, and Email Communications With the PTO

A. Patent and Trademark Office Mail Addresses.....	482
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A. Patent and Trademark Office Mail Addresses

Special Boxes for Patent Mail

If you are sending mail in any of the “Type of Mail” categories below to the PTO, add the appropriate Mail Stop below as the first line of your address as indicated. If your mail does not fall into one of these categories, e.g., an amendment with a fee for extra claims, simply address it using just the last three lines of the address below.

Mail Stop _____
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Mail Stop	Type of Mail
Mail Stop AF	Amendments and other responses after final rejection, other than an appeal brief.
Mail Stop Amendment	Information Disclosure Statements, drawings, Notices of Appeal, and replies to Office Actions in patent applications.
Mail Stop Appeal Brief—Patents	Appeal briefs.
Mail Stop Assignment Recordation Services	Assignments (with cover sheets).
Mail Stop Post Issue	Requests for Certificates of Correction and changes in patent files.
Mail Stop EBC	Mail for the Electronic Business Center.
Mail Stop Expedited Design	Initial filing of design applications accompanied by a request for expedited examination (“Rocket Docket”).
Mail Stop Express Abandonment	Requests for abandonment of a patent application.
Mail Stop Issue Fee	All communications following the receipt of a Notice of Allowance and Fee(s) Due, and prior to the issuance of a patent.

Mail Stop	Type of Mail
Mail Stop PCT	Mail related to international applications filed under the Patent Cooperation Treaty.
Mail Stop Petition	Petitions to be decided by the Office of Petitions including petitions to revive and petitions to accept late payment of issue or maintenance fees.
Mail Stop PGPUB	Correspondence regarding publication of patent applications, including request for early publication and rescission of nonpublication request.
Mail Stop RCE	Requests for continued examination under 37 CFR 1.114.
Mail Stop Ex Parte Reexam	Requests for Reexamination for original request papers only.
Mail Stop Inter Partes Reexam	Requests for Inter Partes Reexamination.
Mail Stop Reissue	All new and continuing reissue application filings.
Mail Stop Sequence	Submission of computer-readable form (CRF) for applications with sequence listings, when the CRF is not being filed with the application.

Maintenance Fee Payments. Maintenance fee payments should preferably be submitted over the Internet: go to www.uspto.gov and click Maintain/Pay Fees. Otherwise mail the payment form and fee to:

United States Patent and Trademark Office
P.O. Box 979070
St. Louis, MO 63197-9000

PTO Is Closed for Ten Holidays. The PTO is closed on weekends and the following holidays: New Year’s Day, Martin Luther King, Jr. Day, Presidents’ Day, Memorial Day, Independence Day, Labor Day, Columbus Day, Veterans’ Day, Thanksgiving, and Christmas. If any action falls due on a holiday or weekend, it is due on the next open-for-business day. If there is a disaster or service interruption, such as 9/11, Hurricane Katrina, or a mail strike, the PTO will publish a notice postponing the due dates for everyone (or just those in a particular geographical area if applicable).

B. Patent and Trademark Office Telephones and Faxes

PTO phones and fax numbers change frequently. For that reason I have not provided a complete listing. Generally, PTO telephone numbers can be located by the following methods:

- A complete current listing of all PTO phones and faxes can be found by going to www.uspto.gov and searching for “telephone directory” in the search box and then clicking “Alphabetical List of PTO Organizations.”
- Alternatively, to reach a specific person or department, call the PTO’s main number, 800-786-9199.
- If you have received an Office Action, the examiner’s phone number will be listed at the end.
- To send a fax to the PTO, all faxed communications should be sent to the PTO’s central fax number, 571-273-8300, except for (a) corrected filing receipt papers, (b) responses to a requirement to file missing parts of a patent application, (c) PCT papers, (d) issue fee transmittals, (e) express abandonments, (f) electronic business center communications, (g) assignments, (h) reexamination and interference papers, (i) communications to the PTO’s general counsel and solicitor, (j) communications to Licensing and Review, and (k) Petitions to withdraw an application from issue.
- If you need help with electronic filing, call the PTO’s Electronic Business Center at 866-217-9197 from 6 a.m. to midnight Eastern time.

Quick-Reference Timing Chart

The following is a summary of some of the more important timing intervals that apply in intangible property law. This list is not intended to be comprehensive, and certain exceptions may be applicable, so check the pertinent parts of this book, or with a patent attorney, if you have a special situation or need more precise advice.

From the date of first publication, offer of sale, sale, or public or commercial use (excluding experimental use) of anything embodying an invention, one must file a U.S. utility, design, or plant patent application within **1 year**.

From the date of filing a PPA, to get the benefit of its filing date, one must file a utility patent application and corresponding foreign applications within **1 year**.

To preserve foreign-filing rights in Convention Countries, one must not sell or publicly disclose details of an invention until **after U.S. filing date**.

To preserve foreign-filing rights in Non-Convention Countries (NCCs), one must not publicly disclose or sell invention until **after filing date in NCC**.

From the PTO's mailing date, unless an extension is purchased, or unless a shorter date is set, one must file a response to most Office Actions within **3 months**.

From the PTO's mailing date of a Notice of Allowance, one must pay the issue fee within a nonextendable period of **3 months**.

The maximum statutory time to reply to an Office Action, provided extensions are bought, is **6 months**.

Unless a Nonpublication Request has been filed, or unless it has issued or is abandoned, every patent application is published **18 months after filing**.

The full term of a utility or plant patent is measured from the filing date of its patent application, or from any earlier domestic nonprovisional (regular) application from which it claims priority, and is **20 years, plus any adjustment (extension) granted by the PTO**.

The full term of a design patent is measured from the issue date and is **14 years**.

From the date of issue (grant) the issue fee will keep a utility patent in force for the first **4 years**.

From the issue date of a patent, the patentee must file a reissue application that attempts to broaden the claims within **2 years**.

From the issue date of a patent, an applicant in a pending application who wants to get into interference with the patent must copy the patent's claims in their application within **1 year**.

Timely payment of Maintenance Fee I (between year 3.0 and 3.5, or 3.5 and 4.0 with late charge) will keep a utility patent in force for another **4 years**.

Timely payment of Maintenance Fee II (between year 7.0 and 7.5, or 7.5 and 8.0 with late charge) will keep a utility patent in force for another **4 years**.

Timely payment of Maintenance Fee III (between year 11.0 and 11.5, or 11.5 and 12.0 with late charge) will keep a utility patent in force until expiration, which occurs **20 years after filing**.

For works not made for hire, the copyright term is **author's life + 70 years**.

For works made for hire, the copyright term is the shorter of **95 years from publication or 120 years from creation**.

To get statutory damages and attorney fees, one must apply to register a copyright before infringement begins or within **3 months of publication**.

A California state trademark registration lasts for **10 years**.

A U.S. (federal) trademark registration lasts for **10 years**.

State and U.S. trademark registrations can be renewed in **perpetuity**.

If kept secret, and provided it's not discovered independently, a trade secret will be enforceable against those who discover it illegally **in perpetuity**.

Unless a foreign filing license has been granted on your filing receipt, after filing a U.S. patent application, before foreign filing a patent application, you must wait **6 months**.

From the U.S. filing date (priority date), to obtain priority of a utility patent application, one must file a foreign Convention application (PCT, EPO, or industrial countries) within **1 year**.

From the U.S. filing date (priority date), to obtain priority of a design patent application, one must file a foreign

Convention application (PCT, EPO, or industrial countries) within **6 months**.

One must file a foreign Non-Convention application (most nonindustrial countries) **before invention becomes publicly known**.

From the U.S. filing date, after filing a PCT application, if a patent in a foreign jurisdiction is desired, one must file abroad within **30 months**.

From the U.S. filing date, after filing a PCT application, if examination in the USPTO or the European Patent Office is desired (Chapter II), one must file a request within **22 months or 3 months from search report**.



Tear-Out Forms

Nondisclosure Agreement	Form 3-1
Invention Disclosure.....	Form 3-2
Provisional Patent Application Cover Letter	Form 3-3
Application Data Sheet—PTO SB/14	Form 3-4
Positive and Negative Factors Evaluation.....	Form 4-1
Positive and Negative Factors Summary.....	Form 4-2
Consultant’s Work Agreement	Form 4-3
Searcher’s Worksheet.....	Form 6-1
Drawing Reference Numerals Worksheet.....	Form 8-1
Declaration for Utility or Design Patent Application.....	Form 10-1A
Patent Application Declaration (Supplemental Sheet)	Form 10-1B
Utility Patent Application Transmittal	Form 10-2
Fee Transmittal.....	Form 10-3
Credit Card Payment Form	Form 10-4
Information Disclosure Statement Cover Letter	Form 10-5
Information Disclosure Statement by Applicant.....	Form 10-6 (A and B)
Nonpublication Request	Form 10-7
Request Under MPEP 707.07(j).....	Form 10-8
Petition to Make Special.....	Form 10-9
Design Patent Application.....	Form 10-10



TIP

Form numbers indicate the chapters in which the forms are discussed; for example, Form 10-7 is discussed in Chapter 10. Some of these forms differ from the corresponding PTO versions due to the fact that I have simplified them and added warnings. However, both versions are perfectly acceptable. The PTO forms also have a Burden-Hour Statement, which you need not include on any forms you send to the PTO. The tear-out versions of these forms are 8" wide but may be used for PTO purposes if you copy them on to 8.5"-wide paper. (Place a white backing over the form to avoid a black edge on the side.) All papers submitted to the PTO should have writing on one side of the sheet only.

Design Patent Application Transmittal.....	Form 10-11
Request for Expedited Examination of a Design Application.....	Form 10-12
Amendment	Form 13-1
Submission of Corrected Drawings.....	Form 13-2
Supplemental Declaration.....	Form 13-3
Petition for Extension of Time.....	Form 13-4
Pre-Appeal Brief Request for Review	Form 13-5
Request for Continued Examination (RCE) Transmittal.....	Form 14-1
Request for Certificate of Correction	Form 15-1
Certificate of Correction	Form 15-2
Maintenance Fee Reminder Sheet	Form 15-3
Submission of Maintenance Fee.....	Form 15-4
Joint Applicants—Statement of Respective Contributions	Form 16-1
Joint Owners' Agreement	Form 16-2
Assignment of Invention and Patent Application	Form 16-3
Recordation Form Cover Sheet	Form 16-4
Universal License Agreement.....	Form 16-5

Nondisclosure Agreement

1. **Parties.** This Disclosure Agreement (the "Agreement") is entered into by and between _____ ("Disclosing Party"), and _____ ("Receiving Party"), for the purpose of preventing the unauthorized disclosure of Confidential Information (as defined below).

The parties agree to enter into a confidential relationship with respect to the disclosure of certain proprietary and confidential information ("Confidential Information").

2. **Definition of Confidential Information.** For purposes of this Agreement, "Confidential Information" shall include the following: _____
- _____
- _____
- _____
- _____
- _____
- _____

"Confidential Information" shall also include all information or material, written or oral, that has or could have commercial value or other utility in the business in which Disclosing Party is engaged.

[Receiving Party should check the box and initial the appropriate choice, below.]

Receiving Party:

- has received the above Confidential Information from Disclosing Party (_____).
- understands that Disclosing Party will immediately send the above Confidential Information to Receiving Party upon Disclosing Party's receipt, from Receiving Party, of a signed copy of this Agreement (_____).
- will show the above materials to Receiving Party on _____ (date) but will keep such Confidential Information in Disclosing Party's possession (_____).

3. **Loan of Tangible Copies of Confidential Information.** In the event that Disclosing Party furnishes physical or tangible copies of any of the Confidential Information to Receiving Party, Receiving Party acknowledges and agrees that these materials are furnished under the following conditions: (a) these materials are loaned to Receiving Party solely for purposes of evaluation and review; (b) these materials shall be treated consistent with the Receiving Party's obligation for Confidential Information under this Agreement; (c) Receiving Party may not copy or otherwise duplicate these materials; and (d) Receiving Party shall return to Disclosing Party any and all such material (including but not limited to records, notes, and other written, printed, or tangible materials) in its possession pertaining to Confidential Information immediately if Disclosing Party requests it in writing.
4. **Exclusions From Confidential Information.** Receiving Party's obligations under this Agreement do not extend to information that Receiving Party can show was: (a) publicly known at the time of disclosure or subsequently becomes publicly known through no fault of the Receiving Party; (b) discovered or created by the Receiving Party before disclosure by Disclosing Party; (c) learned by the Receiving Party through legitimate means other than from the Disclosing Party or Disclosing Party's representatives; or (d) disclosed by Receiving Party with Disclosing Party's prior written approval.
5. **Obligations of Receiving Party.** Receiving Party shall hold and maintain the Confidential Information in strictest confidence for the sole and exclusive benefit of the Disclosing Party. Receiving Party shall carefully restrict access to Confidential Information to employees, contractors, and third parties as is reasonably required and shall require those persons to sign nondisclosure restrictions at least as protective as those in this Agreement. Receiving Party shall not, without prior written approval of Disclosing Party, use for

Receiving Party's own benefit, publish, copy, or otherwise disclose to others, or permit the use by others for their benefit or to the detriment of Disclosing Party, any Confidential Information.

- 6. **Time Periods.** The nondisclosure provisions of this Agreement shall survive the termination of this Agreement and Receiving Party's duty to hold Confidential Information in confidence shall remain in effect until the Confidential Information no longer qualifies as a trade secret or until Disclosing Party sends Receiving Party written notice releasing Receiving Party from this Agreement, whichever occurs first.
- 7. **Miscellaneous.** Nothing contained in this Agreement shall be deemed to constitute either party a partner, joint venturer, or employee of the other party for any purpose. If a court finds any provision of this Agreement invalid or unenforceable, the remainder of this Agreement shall be interpreted so as best to effect the intent of the parties. This Agreement expresses the complete understanding of the parties with respect to the subject matter and supersedes all prior proposals, agreements, representations, and understandings. This Agreement may not be amended except in a writing signed by both parties. The failure to exercise any right provided in this Agreement shall not be a waiver of prior or subsequent rights. This Agreement and each party's obligations shall be binding on the representatives, assigns, and successors of such party. Each party has signed this Agreement through its authorized representative.

Receiving Party: _____
(Print Name of Organization or Individual)

By: _____ Date: ____/____/____
(Signature)

(Print Name and Title, if any)

Disclosing Party: _____
(Print Name of Organization or Individual)

By: _____ Date: ____/____/____
(Signature)

(Print Name and Title, if any)

OTHER PERSONS WITHIN RECEIVING PARTY'S ORGANIZATION OBTAINING ACCESS TO CONFIDENTIAL INFORMATION:

Signature: _____ Date: ____/____/____

Print Name: _____

Signature: _____ Date: ____/____/____

Print Name: _____

Signature: _____ Date: ____/____/____

Print Name: _____

Invention Disclosure

Sheet _____ of _____

Inventor(s): _____

Address(es): _____

Title of Invention: _____

To record **Conception**, describe: 1. Circumstances of conception, 2. Purposes and advantages of invention, 3. Description, 4. Sketches, 5. Operation, 6. Ramifications, 7. Possible novel features, and 8. Closest known prior art. To record **Building and Testing**, describe: 1. Any previous disclosure of conception, 2. Construction, 3. Ramifications, 4. Operation and Tests, and 5. Test results. Include sketches and photos, where possible. Continue on additional identical copies of this sheet if necessary; inventors and witnesses should sign all sheets.

A large grid area for writing and sketching.

Inventor(s): _____ Date: _____ / _____ / _____

_____ Date: _____ / _____ / _____

The following understand, have witnessed, and agree not to disclose the above confidential information:

_____ Date: _____ / _____ / _____

_____ Date: _____ / _____ / _____

In the United States Patent and Trademark Office

Mail Stop Provisional Patent Application
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Mailed 20_____

Sir:

Please file the enclosed Provisional Patent Application (PPA) papers listed below under 37 C.F.R. § 1.53(b)(2).

Each of the undersigned understands:

- A. This PPA is not a substitute for a Regular Patent Application (RPA), cannot get into interference with an RPA of another person, cannot be amended, will not be published, cannot claim any foreign priority, and will not mature into a patent;
- B. If an RPA referring to this PPA is not filed within one year of the filing date of this PPA, this PPA will be worthless and will be destroyed;
- C. Any desired foreign Convention applications (including PCT applications) based upon this PPA *must* be filed within one year of the filing date of this PPA in order to obtain benefit of the filing date of such PPA.
- D. This PPA *must* contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. 35 U.S.C. § 112, ¶ 1. Otherwise this PPA will be worthless.
- E. Any RPA will be entitled to claim the benefit of this PPA only if such RPA names at least one inventor of this PPA and this PPA discloses such inventor's invention, as claimed in at least one claim of the RPA, in the matter provided in Item D above.

Inventor # 1, Name: _____

Legal Residence: _____

Inventor # 2, Name: _____

Legal Residence: _____

Title of Invention: _____

Specification, sheets: _____ Drawing(s), sheets: _____

Check or Credit Card Payment (use PTO-2038) for \$ _____ for

small entity large entity filing fee

Return Receipt Postcard Addressed to Inventor # 1

Return Receipt Postcard Addressed to Inventor # 2.

Application Data Sheet (optional).

Very respectfully,

Signature of Inventor # 1

Signature of Inventor # 2

Print Name of Inventor # 1

Print Name of Inventor # 2

Telephone Number of Inventor # 1

Telephone Number of Inventor # 2

Address (Send Correspondence Here)

Address

Express Mail Label #



; Date of Deposit 20_____

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Application Data Sheet 37 CFR 1.76	Attorney Docket Number	
	Application Number	
Title of Invention		
<p>The application data sheet is part of the provisional or nonprovisional application for which it is being submitted. The following form contains the bibliographic data arranged in a format specified by the United States Patent and Trademark Office as outlined in 37 CFR 1.76.</p> <p>This document may be completed electronically and submitted to the Office in electronic format using the Electronic Filing System (EFS) or the document may be printed and included in a paper filed application.</p>		

Secrecy Order 37 CFR 5.2

<input type="checkbox"/>	Portions or all of the application associated with this Application Data Sheet may fall under a Secrecy Order pursuant to 37 CFR 5.2 (Paper filers only. Applications that fall under Secrecy Order may not be filed electronically.)
--------------------------	---

Applicant Information:

Applicant					<input type="button" value="Remove"/>
Applicant Authority		<input checked="" type="radio"/> Inventor	<input type="radio"/> Legal Representative under 35 U.S.C. 117	<input type="radio"/> Party of Interest under 35 U.S.C. 118	
If applicant is not an inventor, indicate the authority to file for the patent on behalf of the inventor, the inventor is:					
Prefix	Given Name	Middle Name	Family Name	Suffix	
Residence Information (Select One) <input checked="" type="radio"/> US Residency <input type="radio"/> Non US Residency <input type="radio"/> Active US Military Service					
City		State/Province		Country of Residence	
City		Country Of Residenceⁱ			
Active Military Service in					
Citizenship under 37 CFR 1.41(b)					
Mailing Address of Applicant:					
Address 1					
Address 2					
City		State/Province			
Postal Code		Country			
If the representative for the inventor is an Organization check here. <input type="checkbox"/>					
Organization Name					
Prefix	Given Name	Middle Name	Family Name	Suffix	
Residence Information of the Inventor's Representative:					
Residence Information (Select One) <input checked="" type="radio"/> US Residency <input type="radio"/> Non US Residency <input type="radio"/> Active US Military Service					
City		State/Province		Country of Residence	
City		Country Of Residenceⁱ			
Active Military Service in					
Citizenship under 37 CFR 1.41(b)i					
Mailing Address of the Inventor's Representative:					
Address 1					
Address 2					

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Application Data Sheet 37 CFR 1.76	Attorney Docket Number	
	Application Number	
Title of Invention		
City		State/Province
Postal Code		Country
All Inventors Must Be Listed - Additional Inventor Information blocks may be generated within this form by selecting the Add button.		<input type="button" value="Add"/>

Correspondence Information:

Enter either Customer Number or complete the Correspondence Information section below. For further information see 37 CFR 1.33(a).			
<input type="checkbox"/> An Address is being provided for the correspondence information of this application.			
Customer Number			
Name 1		Name 2	
Address 1			
Address 2			
City		State/Province	
Country ⁱ		Postal Code	
Phone Number		Fax Number	
Email Address			<input type="button" value="Add Email"/> <input type="button" value="Remove Email"/>

Application Information:

Title of the Invention			
Attorney Docket Number		Small Entity Status Claimed	<input type="checkbox"/>
Application Type			
Subject Matter			
Suggested Class (if any)		Sub Class (if any)	
Suggested Technology Center (if any)			
Total Number of Drawing Sheets (if any)		Suggested Figure for Publication (if any)	
Plant Submissions Only:			
Latin Name		Variety Denomination Name	

Publication Information:

<input type="checkbox"/> Request Early Publication (Fee required at time of Request 37 CFR 1.219)
<input type="checkbox"/> Request Not to Publish. I hereby request that the attached application not be published under 35 U.S.C. 122(b) and certify that the invention disclosed in the attached application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing.

Representative Information:

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Application Data Sheet 37 CFR 1.76	Attorney Docket Number	
	Application Number	
Title of Invention		

Representative information should be provided for all practitioners having a power of attorney in the application. Providing this information in the Application Data Sheet does not constitute a power of attorney in the application (see 37 CFR 1.32). Enter either Customer Number or complete the Representative Name section below. If both sections are completed the Customer Number will be used for the Representative Information during processing.

Please Select One:	<input checked="" type="radio"/> Customer Number	<input type="radio"/> US Patent Practitioner	<input type="radio"/> Limited Recognition (37 CFR 11.9)		
Customer Number					
Prefix	Given Name	Middle Name	Family Name	Suffix	<input type="button" value="Remove"/>
Registration Number					
Prefix	Given Name	Middle Name	Family Name	Suffix	<input type="button" value="Remove"/>
Registration Number					
Additional Representative Information blocks may be generated within this form by selecting the Add button.					<input type="button" value="Add"/>

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78(a)(2) or CFR 1.78(a)(4), and need not otherwise be made part of the specification.

Prior Application Status		<input type="button" value="Remove"/>			
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)		
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)	Patent Number	Issue Date (YYYY-MM-DD)
Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the Add button.					<input type="button" value="Add"/>

Foreign Priority Information:

This section allows for the applicant to claim benefit of foreign priority and to identify any prior foreign application for which priority is not claimed. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and 37 CFR 1.55(a).

<input type="button" value="Remove"/>			
Application Number	Country ⁱ	Parent Filing Date (YYYY-MM-DD)	Priority Claimed
			<input checked="" type="radio"/> Yes <input type="radio"/> No
Additional Foreign Priority Data may be generated within this form by selecting the Add button.			<input type="button" value="Add"/>

Assignee Information:

Providing this information in the application data sheet does not substitute for compliance with any requirement of part 3 of Title 37 of the CFR to have an assignment recorded in the Office.

Assignee	<input type="button" value="Remove"/>
----------	---------------------------------------

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Application Data Sheet 37 CFR 1.76		Attorney Docket Number		
		Application Number		
Title of Invention				
If the Assignee is an Organization check here. <input type="checkbox"/>				
Organization Name				
Prefix	Given Name	Middle Name	Family Name	Suffix
Mailing Address Information:				
Address 1				
Address 2				
City		State/Province		
Country			Postal Code	
Phone Number		Fax Number		
Email Address				
Additional Assignee Data may be generated within this form by selecting the Add button.				<input type="button" value="Add"/>

Signature:

A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature.				
Signature			Date (YYYY-MM-DD)	
First Name		Last Name	Registration Number	

This collection of information is required by 37 CFR 1.76. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 23 minutes to complete, including gathering, preparing, and submitting the completed application data sheet form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

Positive and Negative Factors Evaluation

Inventor(s): _____

Invention: _____

Factor	Weight (-100 to +100)	Factor	Weight (-100 to +100)
1. Cost	_____	33. Related Product Addability	_____
2. Weight	_____	34. Satisfies Existing Need	_____
3. Size	_____	35. Legality	_____
4. Safety/Health	_____	36. Operability	_____
5. Speed	_____	37. Development	_____
6. Ease of Use	_____	38. Profitability	_____
7. Ease of Production	_____	39. Obsolescence	_____
8. Durability	_____	40. Incompatibility	_____
9. Repairability	_____	41. Product Liability Risk	_____
10. Novelty	_____	42. Market Dependence	_____
11. Convenience/Social Benefit/ Mechanization	_____	43. Difficulty of Distribution	_____
12. Reliability	_____	44. Service Requirements	_____
13. Ecology	_____	45. New Tooling Required	_____
14. Salability	_____	46. Inertia Must Be Overcome	_____
15. Appearance	_____	47. Too Advanced Technically	_____
16. Viewability	_____	48. Substantial Learning Required	_____
17. Precision	_____	49. Difficult to Promote	_____
18. Noise	_____	50. Lack of Market	_____
19. Odor	_____	51. Crowded Field	_____
20. Taste	_____	52. Commodities	_____
21. Market Size	_____	53. Combination Products	_____
22. Trend of Demand	_____	54. Entrenched Competition	_____
23. Seasonal Demand	_____	55. Instant Anachronism	_____
24. Difficulty of Market Penetration	_____	56. Prototype Availability	_____
25. Potential Competition	_____	57. Broad Patent Coverage Available	_____
26. Quality	_____	58. High Sales Anticipated	_____
27. Excitement	_____	59. Visibility of Invention in Final Product	_____
28. Markup	_____	60. Ease of Packaging	_____
29. Inferior Performance	_____	61. Youth Market	_____
30. "Sexy" Packaging	_____	62. Part of a Current Fad	_____
31. Miscellaneous	_____	63. Will Contingent Fee Litigator Take Case?	_____
32. Long Life Cycle	_____		
		Total	_____

Signed: _____

Date: _____

Inventor(s)

Positive and Negative Factors Summary

Inventor(s): _____

Invention: _____

List Factors With Positive Values

Weight

List Factors With Negative Values

Weight

Positive Total _____

Negative Total _____

NET (Positive Total less Negative Total): _____

Signed: _____
Inventor(s)

Date: _____

Consultant's Work Agreement

1. **Parties:** This Work Agreement is made between the following parties:

Name(s): _____

Address(es): _____

(hereinafter Contractor), and

Name(s): _____

Address(es): _____

(hereinafter Consultant).

2. **Name of Project:** _____

3. **Work to Be Performed by Consultant:** _____

4. **Work/Payment Schedule:** _____

5. **Date:** This Agreement shall be effective as of the latter date below written.
6. **Recitals:** Contractor has one or more ideas relating to the above project and desires to have such project developed more completely, as specified in the above statement of Work. Consultant has certain skills desired by Contractor relating to performance of the above Work.
7. **Performance:** Consultant will perform the above work for Contractor, in accordance with the above-scheduled Work/Payment Schedule, and Contractor will make the above scheduled payments to Consultant. Any changes to the Work to Be Performed or the Work/Payment Schedule shall be described in a writing referring to this Agreement and signed and dated by both parties. Time is of the essence of this Agreement, and if Consultant fails to perform according to the above work schedule, Contractor may (a) void this agreement and pay Consultant 50% of what would otherwise be due, or (b) require that Consultant pay Contractor a penalty of \$_____ per day.
8. **Intellectual Property:** All intellectual property, including trademarks, writings, information, trade secrets, inventions, discoveries, or improvements, whether or not registrable or patentable, which are conceived, constructed, or written by Consultant and arise out of or are related to work and services performed under this agreement, are, or shall become and remain, the sole and exclusive property of Contractor, whether or not such intellectual property is conceived during the time such work and services are performed or billed.
- 9A. **Protection of Intellectual Property:** Contractor and Consultant recognize that under U.S. patent laws, all patent applications must be filed in the name of the true and actual inventor(s) of the subject matter sought to be patented. Thus if Consultant makes any patentable inventions relating to the above project, Consultant agrees to be named as an applicant in any U.S. patent application(s) filed on such invention(s). Actual ownership of such patent applications shall be governed by clause 8.
- 9B. **Disclosure:** Consultant shall promptly disclose to Contractor in writing all information pertaining to any intellectual property generated or conceived by Consultant under this Agreement. Consultant hereby

assigns and agrees to assign all of Consultant's rights to such intellectual property, including patent rights and foreign priority rights. Consultant hereby expressly agrees, without further charge for time, to do all things and sign all documents deemed by Contractor to be necessary or appropriate to invest in intellectual property, including obtaining for and vesting in Contractor all U.S. and foreign patents and patent applications which Contractor desires to obtain to cover such intellectual property, provided that Contractor shall bear all expenses relating thereto. All reasonable local travel time and expenses shall be borne by Consultant.

- 10. Trade Secrets:** Consultant recognizes that all information relating to the above Project disclosed to Consultant by Contractor, and all information generated by Consultant in the performance of the above Work, is a valuable trade secret of Contractor and Consultant shall treat all such information as strictly confidential, during and after the performance of Work under this Agreement. Specifically Consultant shall not reveal, publish, or communicate any such information to anyone other than Contractor, and shall safeguard all such information from access to anyone other than Contractor, except upon the express written authorization of Contractor. This clause shall not apply to any information which Consultant can document in writing is presently in or enters the public domain from a bona fide source other than Consultant.
- 11. Return of Property:** Consultant agrees to return all written materials and objects received from Contractor, to deliver to Contractor all objects and a copy (and all copies and originals if requested by Contractor) of all written materials resulting from or relating to work performed under this Agreement, and not to deliver to any person, organization, or publisher, or cause to be published, any such written material without prior written authorization.
- 12. Conflicts of Interest:** Consultant recognizes a fiduciary obligation to Contractor arising out of the work and services performed under this agreement. Accordingly, Consultant will not offer services to or perform services for any competitor, potential or actual, of Contractor for the above Project. Consultant will not perform any other acts which may result in any conflict of interest by Consultant, during and after the term of this Agreement.
- [Check one]
- Consultant represents to Contractor that prior to this agreement, Consultant has not made and does not own any inventions relating to the above Project.
 - Consultant has made or does own inventions relating to this Project and has provided a list of such inventions on a separate sheet incorporated in this Agreement by reference.
- 13. Mediation and Arbitration:** If any dispute arises under this Agreement, the parties shall negotiate in good faith to settle such dispute. If the parties cannot resolve such dispute themselves, then either party may submit the dispute to mediation by a mediator approved by both parties. If the parties cannot agree to any mediator, or if either party does not wish to abide by any decision of the mediator, they shall submit the dispute to arbitration by any mutually acceptable arbitrator, or the American Arbitration Association (AAA). If the AAA is selected, the arbitration shall take place under the auspices of the nearest branch of such to both parties. The costs of the arbitration proceeding shall be borne according to the decision of the arbitrator, who may apportion costs equally, or in accordance with any finding of fault or lack of good faith of either party. The arbitrator's award shall be nonappealable and enforceable in any court of competent jurisdiction.
- 14. Governing Law:** This Agreement shall be governed by and interpreted under and according to the laws of the State of _____.
- 15. Signatures:** The parties have indicated their agreement to all of the above terms by signing this Agreement on the respective dates below indicated. Each party has received an original signed copy hereof.

Contractor: _____ Date: _____
Consultant: _____ Date: _____

Searcher's Worksheet

Sheet _____ of _____

Inventor(s): _____

Invention Description (use keywords and variations): _____

Selected Search Classifications

<u>Class/Sub</u>	<u>Description</u>	<u>Checked</u>	<u>Comments</u>
_____	_____	_____	_____
_____	_____	_____	_____
_____	_____	_____	_____
_____	_____	_____	_____
_____	_____	_____	_____
_____	_____	_____	_____
_____	_____	_____	_____
_____	_____	_____	_____
_____	_____	_____	_____

Patents (and Other References) Thought Relevant

<u>Patent # or Title</u>	<u>Name or Country</u>	<u>Date</u>	<u>Class/Sub</u>	<u>Comment</u>
_____	_____	_____	_____	_____
_____	_____	_____	_____	_____
_____	_____	_____	_____	_____
_____	_____	_____	_____	_____
_____	_____	_____	_____	_____
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_____	_____	_____	_____	_____
_____	_____	_____	_____	_____
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_____	_____	_____	_____	_____
_____	_____	_____	_____	_____
_____	_____	_____	_____	_____
_____	_____	_____	_____	_____
_____	_____	_____	_____	_____

Searcher: _____ Date: _____

Drawing Reference Numerals Worksheet

PART NAME

PART NAME

10 _____	84 _____
12 _____	86 _____
14 _____	88 _____
16 _____	90 _____
18 _____	92 _____
20 _____	94 _____
22 _____	96 _____
24 _____	98 _____
26 _____	100 _____
28 _____	102 _____
30 _____	104 _____
32 _____	106 _____
34 _____	108 _____
36 _____	110 _____
38 _____	112 _____
40 _____	114 _____
42 _____	116 _____
44 _____	118 _____
46 _____	120 _____
48 _____	122 _____
50 _____	124 _____
52 _____	126 _____
54 _____	128 _____
56 _____	130 _____
58 _____	132 _____
60 _____	134 _____
62 _____	136 _____
64 _____	138 _____
66 _____	140 _____
68 _____	142 _____
70 _____	144 _____
72 _____	146 _____
74 _____	148 _____
76 _____	150 _____
78 _____	152 _____
80 _____	154 _____
82 _____	156 _____

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

DECLARATION FOR UTILITY OR DESIGN PATENT APPLICATION (37 CFR 1.63) <input type="checkbox"/> Declaration Submitted With Initial Filing OR <input type="checkbox"/> Declaration Submitted After Initial Filing (surcharge (37 CFR 1.16(f) required)	Attorney Docket Number	
	First Named Inventor	
	<i>COMPLETE IF KNOWN</i>	
	Application Number	
	Filing Date	
	Art Unit	
	Examiner Name	

I hereby declare that: (1) Each inventor's residence, mailing address, and citizenship are as stated below next to their name; and (2) I believe the inventor(s) named below to be the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought on the invention titled:

(Title of the Invention)

the application of which

is attached hereto

OR

was filed on (MM/DD/YYYY) _____ as United States Application Number or PCT International Application Number _____ and was amended on (MM/DD/YYYY) _____ (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified application, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

Authorization To Permit Access To Application by Participating Offices

If checked, the undersigned hereby grants the USPTO authority to provide the European Patent Office (EPO), the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the World Intellectual Property Office (WIPO), and any other intellectual property offices in which a foreign application claiming priority to the above-identified patent application is filed access to the above-identified patent application. See 37 CFR 1.14(c) and (h). This box should not be checked if the applicant does not wish the EPO, JPO, KIPO, WIPO, or other intellectual property office in which a foreign application claiming priority to the above-identified patent application is filed to have access to the above-identified patent application.

In accordance with 37 CFR 1.14(h)(3), access will be provided to a copy of the above-identified patent application with respect to: 1) the above-identified patent application-as-filed; 2) any foreign application to which the above-identified patent application claims priority under 35 U.S.C. 119(a)-(d) if a copy of the foreign application that satisfies the certified copy requirement of 37 CFR 1.55 has been filed in the above-identified patent application; and 3) any U.S. application-as-filed from which benefit is sought in the above-identified patent application.

In accordance with 37 CFR 1.14(c), access may be provided to information concerning the date of filing the Authorization to Permit Access to Application by Participating Offices.

[Page 1 of 3]

This collection of information is required by 35 U.S.C. 115 and 37 CFR 1.63. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

DECLARATION — Utility or Design Patent Application

Claim of Foreign Priority Benefits

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b) of any foreign application(s) for patent, inventor's or plant breeder's rights certificate(s), or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent, inventor's or plant breeder's rights certificate(s), or any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Not Claimed	Certified Copy Attached?	
				YES	NO
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

Additional foreign application number(s) are listed on a supplemental priority data sheet PTO/SB/02B attached hereto.

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DECLARATION — Utility or Design Patent Application

Direct all correspondence to:	<input type="checkbox"/>	The address associated with Customer Number:	<input style="width: 100%;" type="text"/>	OR	<input type="checkbox"/>	Correspondence address below
Name						
Address						
City			State		Zip	
Country		Telephone		Email		
WARNING:						
<p>Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available. Petitioner/applicant is advised that documents which form the record of a patent application (such as the PTO/SB/01) are placed into the Privacy Act system of records DEPARTMENT OF COMMERCE, COMMERCE-PAT-7, System name: <i>Patent Application Files</i>. Documents not retained in an application file (such as the PTO-2038) are placed into the Privacy Act system of COMMERCE/PAT-TM-10, System name: <i>Deposit Accounts and Electronic Funds Transfer Profiles</i>.</p> <p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.</p>						
NAME OF SOLE OR FIRST INVENTOR:			<input type="checkbox"/> A petition has been filed for this unsigned inventor			
Given Name (first and middle [if any])			Family Name or Surname			
Inventor's Signature					Date	
Residence: City		State		Country		Citizenship
Mailing Address						
City		State		Zip		Country
<input type="checkbox"/> Additional inventors or a legal representative are being named on the _____ supplemental sheet(s) PTO/SB/02A or 02LR attached hereto						

DECLARATION**ADDITIONAL INVENTOR(S)
Supplemental Sheet**

Page _____ of _____

Name of Additional Joint Inventor, if any:		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle (if any))		Family Name or Surname	
Inventor's Signature		Date	
Residence: City	State	Country	Citizenship
Mailing Address			
City	State	Zip	Country
Name of Additional Joint Inventor, if any:		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle (if any))		Family Name or Surname	
Inventor's Signature		Date	
Residence: City	State	Country	Citizenship
Mailing Address			
City	State	Zip	Country
Name of Additional Joint Inventor, if any:		<input type="checkbox"/> A petition has been filed for this unsigned inventor	
Given Name (first and middle (if any))		Family Name or Surname	
Inventor's Signature		Date	
Residence: City	State	Country	Citizenship
Mailing Address			
City	State	Zip	Country

This collection of information is required by 35 U.S.C. 115 and 37 CFR 1.63. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

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UTILITY PATENT APPLICATION TRANSMITTAL

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Attorney Docket No.	
First Inventor	
Title	
Express Mail Label No.	

APPLICATION ELEMENTS See MPEP chapter 600 concerning utility patent application contents.	ADDRESS TO: Commissioner for Patents P.O. Box 1450 Alexandria VA 22313-1450
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1. **Fee Transmittal Form** (e.g., PTO/SB/17)
2. **Applicant claims small entity status.**
See 37 CFR 1.27.
3. **Specification** [Total Pages _____]
Both the claims and abstract must start on a new page
(For information on the preferred arrangement, see MPEP 608.01(a))
4. **Drawing(s)** (35 U.S.C. 113) [Total Sheets _____]
5. **Oath or Declaration** [Total Sheets _____]
 - a. Newly executed (original or copy)
 - b. A copy from a prior application (37 CFR 1.63(d))
(for continuation/divisional with Box 18 completed)
 - i. **DELETION OF INVENTOR(S)**
Signed statement attached deleting inventor(s)
name in the prior application, see 37 CFR
1.63(d)(2) and 1.33(b).
6. **Application Data Sheet.** See 37 CFR 1.76
7. **CD-ROM or CD-R** in duplicate, large table or
Computer Program (Appendix)
 - Landscape Table on CD
8. **Nucleotide and/or Amino Acid Sequence Submission**
(if applicable, items a. – c. are required)
 - a. Computer Readable Form (CRF)
 - b. Specification Sequence Listing on:
 - i. CD-ROM or CD-R (2 copies); or
 - ii. Paper
 - c. Statements verifying identity of above copies

ACCOMPANYING APPLICATION PARTS

9. **Assignment Papers** (cover sheet & document(s))
Name of Assignee _____
10. **37 CFR 3.73(b) Statement** **Power of Attorney**
(when there is an assignee)
11. **English Translation Document** (if applicable)
12. **Information Disclosure Statement** (PTO/SB/08 or PTO-1449)
 Copies of citations attached
13. **Preliminary Amendment**
14. **Return Receipt Postcard** (MPEP 503)
(Should be specifically itemized)
15. **Certified Copy of Priority Document(s)**
(if foreign priority is claimed)
16. **Nonpublication Request** under 35 U.S.C. 122(b)(2)(B)(i).
Applicant must attach form PTO/SB/35 or equivalent.
17. Other: _____

18. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in the first sentence of the specification following the title, or in an Application Data Sheet under 37 CFR 1.76:

Continuation
 Divisional
 Continuation-in-part (CIP)
 of prior application No.: _____

Prior application information: Examiner: _____ Art Unit: _____

19. CORRESPONDENCE ADDRESS

The address associated with Customer Number: OR Correspondence address below

Name			
Address			
City	State	Zip Code	
Country	Telephone	Email	

Signature	Date
Name (Print/Type)	Registration No. (Attorney/Agent)

This collection of information is required by 37 CFR 1.53(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**
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Effective on 12/08/2004.
 Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL

For FY 2009

Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)

Complete if Known

Application Number _____
 Filing Date _____
 First Named Inventor _____
 Examiner Name _____
 Art Unit _____
 Attorney Docket No. _____

METHOD OF PAYMENT (check all that apply)

Check Credit Card Money Order None Other (please identify): _____

Deposit Account Deposit Account Number: _____ Deposit Account Name: _____

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

Charge fee(s) indicated below Charge fee(s) indicated below, **except for the filing fee**
 Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	330	165	540	270	220	110	_____
Design	220	110	100	50	140	70	_____
Plant	220	110	330	165	170	85	_____
Reissue	330	165	540	270	650	325	_____
Provisional	220	110	0	0	0	0	_____

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	52	26
Each independent claim over 3 (including Reissues)	220	110
Multiple dependent claims	390	195

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims
_____ - 20 or HP = _____	x _____	= _____	_____	_____
HP = highest number of total claims paid for, if greater than 20.				
Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	
_____ - 3 or HP = _____	x _____	= _____	_____	_____
HP = highest number of independent claims paid for, if greater than 3.				

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$270 (\$135 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets - 100 = Extra Sheets / 50 = Number of each additional 50 or fraction thereof x Fee (\$) = Fee Paid (\$)

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount) _____
 Other (e.g., late filing surcharge): _____

SUBMITTED BY

Signature	Registration No. (Attorney/Agent)	Telephone
Name (Print/Type)		Date

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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United States Patent and Trademark Office

Instructions for Completing the Credit Card Payment Form

Credit Card Information

- Enter all credit card information including the payment amount to be charged to your credit card and remember to sign the form. The United States Patent and Trademark Office (USPTO) cannot process credit card payments without an authorized signature.
- The USPTO does **not** accept a general authorization to charge any payment deficiency or any additional fees to a credit card.
- The USPTO does **not** accept debit cards or check cards that require use of a personal identification number as a method of payment.

Credit Card Billing Address

- Address information is required for credit card payment as a means of verification. Failure to complete the address information, including zip/postal code, may result in the payment not being accepted by your credit card institution.

Request and Payment Information

- Provide a description of your request based on the payment amount. For example, indicate the item as “basic filing fee” (patent) *or* “first maintenance fee” (patent maintenance fee) or “application for registration” (trademark) *or* “certified copy of a patent” (other fee).
- Indicate the nature of your request by the type of fee you wish to pay: Patent Fee, Patent Maintenance Fee, Trademark Fee or Other Fee. Complete information for each type of fee as applicable to identify the nature of your request. Indicate only one type of fee per form.
- If you are requesting and paying a fee based on a previously filed patent or trademark application, indicate the application/serial number, patent number or registration number that is associated with your request. “Other Fee” is used to request copies of patent and trademark documents, certified copies, assignments, and other information products.
- IDON numbers are assigned by the USPTO for customers ordering patent and trademark information and products specified as “Other Fee” on the order form. If you have been assigned an IDON number from a previous customer order, include it with your request.
- For more information on USPTO fees and amounts, refer to the current fee schedule at www.uspto.gov (click on the “Site Index” link, “Fees, USPTO” link). To request a copy by mail, call the USPTO Contact Center at (800) 786-9199 or (571) 272-1000. Information on mailing addresses is also available at www.uspto.gov (click on the “Site Index” link, “Mailing Addresses” link).

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- The USPTO strongly recommends using this form for credit card payments submitted by mail, facsimile, or by hand-delivery. To protect your credit card information use only this form and do not include credit card information on any other form or document.
- To protect your credit card information, **do not submit this form electronically** through “EFS-Web” or any other USPTO Internet site. Credit card information for electronic credit card payments should be entered exclusively on the USPTO Internet site providing electronic payment capability.

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Credit Card Payment Form
(Do not submit this form electronically via EFS-Web)
Please Read Instructions before Completing this Form

Credit Card Information

Credit Card Type: Visa MasterCard American Express Discover

Credit Card Account #:

Credit Card Expiration Date (mm/yyyy):

Name as it Appears on Credit Card:

Payment Amount (US Dollars): \$

Cardholder Signature:

Date (mm/dd/yyyy):

Refund Policy: The USPTO may refund a fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee will not entitle a party to a refund of such fee. The USPTO will not refund amounts of \$25.00 or less unless a refund is specifically requested and will not notify the payor of such amounts (37 CFR 1.26). Refund of a fee paid by credit card will be issued as a credit to the credit card account to which the fee was charged.

Service Charge: There is a \$50.00 service charge for processing each payment refused (including a check returned "unpaid") or charged back by a financial institution (37 CFR 1.21 (m)).

Credit Card Billing Address

Street Address 1:

Street Address 2:

City:

State/Province:

Zip/Postal Code:

Country:

Daytime Phone #:

Fax #:

Request and Payment Information

Description of Request and Payment Information:

Patent Fee

Patent Maintenance Fee

Trademark Fee

Other Fee

Application No.

Application No.

Application No.

IDON Customer No.

Patent No.

Patent No.

Registration No.

Attorney Docket No.

Identify or Describe Mark

If the cardholder includes a credit card number on any form or document other than the Credit Card Payment Form or submits this form electronically via EFS-Web, the United States Patent and Trademark Office will not be liable in the event that the credit card number becomes public knowledge.

In the United States Patent and Trademark Office

Serial Number: _____

Appn. Filed: _____

Applicant(s): _____

Appn. Title: _____

Examiner/GAU: _____

Mailed: _____

At: _____

Information Disclosure Statement Cover Letter

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Attached is a completed Form PTO/SB/08(A&B) and copies of any non-U.S. patent references cited thereon. Following are comments on any non-English-language references pursuant to Rule 98:

Very respectfully,

Applicant(s): _____

Enc.: PTO/SB/08(A&B)

c/o: _____

Telephone: _____

Certificate of Mailing

I certify that this correspondence will be deposited with the United States Postal Service as first class mail with proper postage affixed in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date: 20_____, Applicant

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Substitute for form 1449/PTO <h2 style="text-align: center; margin: 0;">INFORMATION DISCLOSURE STATEMENT BY APPLICANT</h2> <p style="text-align: center; font-size: small;">(Use as many sheets as necessary)</p>		Complete if Known	
Application Number		Filing Date	
First Named Inventor		Art Unit	
Examiner Name		Attorney Docket Number	
Sheet	of		

U. S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code ² (if known)			
		US-			
		US-			
		US-			
		US-			
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FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear	T ⁶
		Country Code ³ -Number ⁴ -Kind Code ⁵ (if known)				

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

¹EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ² Applicant's unique citation designation number (optional). ³ See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ⁴ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁵ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁶ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁷ Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

Substitute for form 1449/PTO		Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>		Application Number	
		Filing Date	
		First Named Inventor	
		Art Unit	
		Examiner Name	
		Attorney Docket Number	
Sheet		of	

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Applicant's unique citation designation number (optional). ² Applicant is to place a check mark here if English language Translation is attached. This collection of information is required by 37 CFR 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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**NONPUBLICATION REQUEST
UNDER
35 U.S.C. 122(b)(2)(B)(i)**

First Named Inventor

Title

Attorney Docket Number

I hereby certify that the invention disclosed in the attached application **has not and will not be** the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing.

I hereby request that the attached application not be published under 35 U.S.C. 122(b).

Signature

Date

Typed or printed name

Registration Number, if applicable

Telephone Number

This request must be signed in compliance with 37 CFR 1.33(b) and submitted with the application **upon filing**.

Applicant may rescind this nonpublication request at any time. If applicant rescinds a request that an application not be published under 35 U.S.C. 122(b), the application will be scheduled for publication at eighteen months from the earliest claimed filing date for which a benefit is claimed.

If applicant subsequently files an application directed to the invention disclosed in the attached application in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, the applicant **must** notify the United States Patent and Trademark Office of such filing within forty-five (45) days after the date of the filing of such foreign or international application. **Failure to do so will result in abandonment of this application (35 U.S.C. 122(b)(2)(B)(iii)).**

This collection of information is required by 37 CFR 1.213(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 6 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

In the United States Patent and Trademark Office

Serial Number: _____

Appn. Filed: _____

Applicant(s): _____

Appn. Title: _____

Examiner/GAU: _____

Mailed: _____

At: _____

Request Under MPEP 707.07(j)

Mail Stop Non-Fee Amendments

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

The undersigned pro se applicant(s) respectfully requests that if the Examiner finds patentable subject matter disclosed in this application, but feels that Applicant's present claims are not entirely suitable, the Examiner draft one or more allowable claims for applicant, pursuant to MPEP 707.07(j).

Very respectfully,

Signature of Inventor # 1

Signature of Inventor # 2

Address

Address

Telephone

Telephone

In the United States Patent and Trademark Office

Serial Number: _____

Appn. Filed: _____

Applicant(s): _____

Appn. Title: _____

Examiner/GAU: _____

Mailed: _____

At: _____

Petition to Make Special

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby respectfully petitions that the above application be made special under MPEP Sec. 708.02 for the following reason; attached is a declaration in support thereof:

- Applicant's state of health is such that he or she might not be available to assist in the prosecution of the application if it were to run its normal course
- Applicant's age is 65 or greater
- The subject matter of this application will materially enhance the quality of the environment
- The subject matter of this application will materially contribute to the development or conservation of energy resources
- The subject matter of this application will materially contribute to countering terrorism

Very respectfully,

Applicant(s): _____

Attachment(s): Supporting Declaration.

Applicant(s): _____

c/o: _____

Telephone: _____

Certificate of Mailing

I certify that this correspondence will be deposited with the United States Postal Service as first class mail with proper postage affixed in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date: 20_____, Applicant

Design Patent Application—Preamble, Specification, and Claim

Mail Stop Design
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PREAMBLE:

The petitioner(s) whose signature(s) appear on the declaration attached respectfully request that Letters Patent be granted to such petitioner(s) for the new and original design set forth in the following specification. The filing fee of \$ _____, _____ sheets of drawings, a patent application declaration, fee transmittal, a credit card payment form or check, and a return receipt postcard are attached.

SPECIFICATION:

The undersigned has (have) invented a new, original, and ornamental design entitled “ _____ ” of which the following is a specification. Reference is made to the accompanying drawings which form a part hereof, the figures of which are described as follows:

CROSS-REFERENCE TO RELATED APPLICATIONS:

STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH:

DRAWING FIGURES:

CLAIM: I (We) Claim:

The ornamental design for a _____, as shown.

Express Mail Label #



; Date of Deposit 20 _____



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<h1 style="margin: 0;">DESIGN PATENT APPLICATION TRANSMITTAL</h1> <p style="font-size: small; margin-top: 5px;">(Only for new nonprovisional applications under 37 CFR 1.53(b))</p>	Attorney Docket No.	
	First Named Inventor	
	Title	
	Express Mail Label No.	

ADDRESS TO: Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	DESIGN V. UTILITY: A "design patent" protects an article's ornamental appearance (e.g., the way an article looks) (35 U.S.C. 171), while a "utility patent" protects the way an article is used and works (35 U.S.C. 101). The ornamental appearance of an article includes its shape/configuration or surface ornamentation upon the article, or both. Both a design and a utility patent may be obtained on an article if invention resides both in its ornamental appearance and its utility. For more information, see MPEP 1502.01.
---	---

APPLICATION ELEMENTS <i>See MPEP 1500 concerning design patent application contents.</i>	ACCOMPANYING APPLICATION PARTS
1. <input type="checkbox"/> Fee Transmittal Form (e.g., PTO/SB/17) 2. <input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. 3. <input type="checkbox"/> Specification [Total Pages _____] (preferred arrangement set forth below, MPEP 1503.01) - Preamble - Cross References to Related Applications - Statement Regarding Fed sponsored R & D - Description of the figure(s) of the drawings - Feature description - Claim (only one (1) claim permitted, MPEP 1503.03) 4. <input type="checkbox"/> Drawing(s) (37 CFR 1.152) [Total Sheets _____] 5. Oath or Declaration [Total Pages _____] a. <input type="checkbox"/> Newly executed (original or copy) b. <input type="checkbox"/> A copy from a prior application (37 CFR 1.63(d)) (for continuation/divisional with Box 16 completed) i. <input type="checkbox"/> <u>DELETION OF INVENTOR(S)</u> Signed statement attached deleting inventor(s) named in the prior application, see 37 CFR 1.63(d)(2) and 1.33(b) 6. <input type="checkbox"/> Application Data Sheet. See 37 CFR 1.76	7. <input type="checkbox"/> Assignment Papers (cover sheet & document(s)) 8. <input type="checkbox"/> 37 CFR 3.73(b) Statement <input type="checkbox"/> Power of Attorney (when there is an assignee) 9. <input type="checkbox"/> English Translation Document (if applicable) 10. <input type="checkbox"/> Information Disclosure Statement (IDS) PTO/SB/08 or PTO-1449 <input type="checkbox"/> Copies of foreign patent documents, publications, & other information 11. <input type="checkbox"/> Preliminary Amendment 12. <input type="checkbox"/> Return Receipt Postcard (MPEP 503) (Should be specifically itemized) 13. <input type="checkbox"/> Certified Copy of Priority Document(s) (if foreign priority is claimed) 14. <input type="checkbox"/> Request for Expedited Examination of a Design Application (37 CFR 1.155) (NOTE: Use "Mail Stop Expedited Design") 15. <input type="checkbox"/> Other:

16. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in the first sentence of the specification following the title, or in an Application Data Sheet under 37 CFR 1.76:

Continuation
 Divisional
 Continuation-in-part (CIP) of prior application No.: _____

Prior application information: Examiner _____ Art Unit: _____

17. CORRESPONDENCE ADDRESS

The address associated with Customer Number: _____ OR Correspondence address below

Name			
Address			
City	State	Zip Code	
Country	Telephone	Email	

Signature	Date
Name (Print/Type)	Registration No. (Attorney/Agent)

This collection of information is required by 37 CFR 1.53(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**
 If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Under the Paperwork Reduction ACT of 1995, no persons are required to respond to collection of information unless it displays a valid OMB control number.

REQUEST FOR EXPEDITED EXAMINATION OF A DESIGN APPLICATION (37 CFR 1.155)

Application Number	
Filing Date	
First Named Inventor	
Title	
Atty Docket Number	

ADDRESS TO:

**MAIL STOP EXPEDITED DESIGN
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450**

This is a request for expedited examination of a design application under 37 CFR 1.155.

NOTE: If the Request made by this form accompanies original application papers, include form PTO/SB/18 "Design Patent Application Transmittal" or its equivalent.

A preexamination search was conducted. The field of search was:

Related applications: _____

If not previously filed for the above-identified application, the following items required by 37 CFR 1.155 are enclosed:

- Formal drawings (see 37 CFR 1.84).
- The fee set forth in 37 CFR 1.17(k).
- An information disclosure statement in compliance with 37 CFR 1.98.

Signature

Date

Typed or printed name

Registration Number, if applicable

Telephone Number

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.155. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 6 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

In the United States Patent and Trademark Office

Serial Number: _____

Appn. Filed: _____

Applicant(s): _____

Appn. Title: _____

Examiner/GAU: _____

Mailed: _____

At: _____

Amendment _____

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Letter mailed _____, 20_____, please amend the above application as follows:

- SPECIFICATION: Amendments to the specification begin on page _____ of this amendment.
- DRAWINGS: Amendments to the drawings are discussed on page _____ of this amendment.
- CLAIMS: Amendments to the claims begin on page _____ of this amendment.
- REMARKS begin on page _____ of this amendment.

In the United States Patent and Trademark Office

Serial Number: _____

Appn. Filed: _____

Applicant(s): _____

Appn. Title: _____

Examiner/GAU: _____

Mailed: _____

At: _____

Submission of Corrected Drawings

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Attn: Chief Draftsperson

Sir:

New drawing sheet(s) (_____) for the above application is/are enclosed, corrected as necessary. Please substitute this/these for the corresponding sheet(s) on file.

A copy of sheet(s) _____ is attached and is marked in red to indicate the changes being made.

Very respectfully,

Applicant(s):

c/o: _____

Telephone: _____

Certificate of Mailing

I certify that this correspondence will be deposited with the United States Postal Service as first class mail with proper postage affixed in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450."

Date: 20 _____, Applicant

In the United States Patent and Trademark Office

Serial Number: _____

Appn. Filed: _____

Applicant(s): _____

Appn. Title: _____

Examiner/GAU: _____

Mailed: _____

At: _____

Supplemental Declaration

(for Use After Close of Prosecution or With Continuation-in-Part Application)

As an applicant in the above-identified application, I declare as follows:

1. If only one inventor is named below, I am a sole inventor, and if more than one inventor is named below, I am a joint inventor with the inventor(s) named below of the subject matter of the above-identified application.
2. I have reviewed and understand the contents of the specification and claims, as originally filed, and as amended by the amendment(s) dated _____.
3. I believe that I, and the other inventor(s) named below if more than one inventor is named below, am the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.
4. I acknowledge the duty to disclose information which is material to the examination of the application in accordance with 37 C.F.R. Section 1.56(a), and if this oath accompanies or refers to a continuation-in-part application, I acknowledge the duty to disclose material information as defined in 37 C.F.R. Section 1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.
5. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

Signature of Inventor

Signature of Joint Inventor

Printed Name of Inventor

Printed Name of Joint Inventor

Date

Date

Under the paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a) FY 2009 <i>(Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).)</i>		Docket Number (Optional)	
Application Number		Filed	
For			
Art Unit		Examiner	
This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application.			
The requested extension and fee are as follows (check time period desired and enter the appropriate fee below):			
		<u>Fee</u>	<u>Small Entity Fee</u>
<input type="checkbox"/>	One month (37 CFR 1.17(a)(1))	\$130	\$65 \$ _____
<input type="checkbox"/>	Two months (37 CFR 1.17(a)(2))	\$490	\$245 \$ _____
<input type="checkbox"/>	Three months (37 CFR 1.17(a)(3))	\$1110	\$555 \$ _____
<input type="checkbox"/>	Four months (37 CFR 1.17(a)(4))	\$1730	\$865 \$ _____
<input type="checkbox"/>	Five months (37 CFR 1.17(a)(5))	\$2350	\$1175 \$ _____
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27.			
<input type="checkbox"/> A check in the amount of the fee is enclosed.			
<input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.			
<input type="checkbox"/> The Director has already been authorized to charge fees in this application to a Deposit Account.			
<input type="checkbox"/> The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number _____.			
WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.			
I am the <input type="checkbox"/> applicant/inventor.			
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed (Form PTO/SB/96).			
<input type="checkbox"/> attorney or agent of record. Registration Number _____			
<input type="checkbox"/> attorney or agent under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
_____ Signature		_____ Date	
_____ Typed or printed name		_____ Telephone Number	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input type="checkbox"/> Total of _____ forms are submitted.			

This collection of information is required by 37 CFR 1.136(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 6 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional)
--	--------------------------

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 60%;">Application Number</td> <td style="width: 40%;">Filed</td> </tr> <tr> <td colspan="2">First Named Inventor</td> </tr> <tr> <td>Art Unit</td> <td>Examiner</td> </tr> </table>	Application Number	Filed	First Named Inventor		Art Unit	Examiner
Application Number	Filed						
First Named Inventor							
Art Unit	Examiner						

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
 Note: No more than five (5) pages may be provided.

I am the

<input type="checkbox"/> applicant/inventor.	_____
	Signature
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	_____
	Typed or printed name
<input type="checkbox"/> attorney or agent of record. Registration number _____	_____
	Telephone number
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	_____
	Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Request for Continued Examination (RCE) Transmittal

Address to:
 Mail Stop RCE
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Application Number	
Filing Date	
First Named Inventor	
Art Unit	
Examiner Name	
Attorney Docket Number	

This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application.

Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. **Submission required under 37 CFR 1.114** Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

- a. Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.
 - i. Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____
 - ii. Other _____
- b. Enclosed
 - i. Amendment/Reply
 - ii. Affidavit(s)/ Declaration(s)
 - iii. Information Disclosure Statement (IDS)
 - iv. Other _____

2. **Miscellaneous**

- a. Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)
- b. Other _____

3. **Fees**

- The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.
 The Director is hereby authorized to charge the following fees, any underpayment of fees, or credit any overpayments, to Deposit Account No. _____
- a.
 - i. RCE fee required under 37 CFR 1.17(e)
 - ii. Extension of time fee (37 CFR 1.136 and 1.17)
 - iii. Other _____
 - b. Check in the amount of \$ _____ enclosed
 - c. Payment by credit card (Form PTO-2038 enclosed)

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Signature	Date	
Name (Print/Type)	Registration No.	

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

Signature	Date	
Name (Print/Type)		

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Instruction Sheet for RCEs

(not to be submitted to the USPTO)

NOTES:

An RCE is not a new application, and filing an RCE will not result in an application being accorded a new filing date.

Filing Qualifications:

The application must be a utility or plant application filed on or after June 8, 1995. The application cannot be a provisional application, a utility or plant application filed before June 8, 1995, a design application, or a patent under reexamination. See 37 CFR 1.114(e).

Filing Requirements:

Prosecution in the application must be closed. Prosecution is closed if the application is under appeal, or the last Office action is a final action, a notice of allowance, or an action that otherwise closes prosecution in the application (e.g., an Office action under *Ex parte Quayle*). See 37 CFR 1.114(b).

A submission and a fee are required at the time the RCE is filed. If reply to an Office action under 35 U.S.C. 132 is outstanding (e.g., the application is under final rejection), the submission must meet the reply requirements of 37 CFR 1.111. If there is no outstanding Office action, the submission can be an information disclosure statement, an amendment, new arguments, or new evidence. See 37 CFR 1.114(c). The submission may be a previously filed amendment (e.g., an amendment after final rejection).

WARNINGS:

Request for Suspension of Action:

All RCE filing requirements must be met before suspension of action is granted. A request for a suspension of action under 37 CFR 1.103(c) does not satisfy the submission requirement and does not permit the filing of the required submission to be suspended.

Improper RCE will NOT toll Any Time Period:

Before Appeal - If the RCE is improper (e.g., prosecution in the application is not closed or the submission or fee has not been filed) and the application is not under appeal, the time period set forth in the last Office action will continue to run and the application will be abandoned after the statutory time period has expired if a reply to the Office action is not timely filed. No additional time will be given to correct the improper RCE.

Under Appeal - If the RCE is improper (e.g., the submission or the fee has not been filed) and the application is under appeal, the improper RCE is effective to withdraw the appeal. Withdrawal of the appeal results in the allowance or abandonment of the application depending on the status of the claims. If there are no allowed claims, the application is abandoned. If there is at least one allowed claim, the application will be passed to issue on the allowed claim(s). See MPEP 1215.01.

See MPEP 706.07(h) for further information on the RCE practice.

In the United States Patent and Trademark Office

Patent No.: _____

Issued: _____

Patentee(s): _____

Ser. Nr.: _____

Filed: _____

Request for Certificate of Correction

Date: _____

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

- 1. The above patent contains significant error, as indicated on the attached Certificate of Correction form (submitted in duplicate). These errors arose at the respective places in the application file indicated below.
- 2. Such error arose through the fault of the Patent and Trademark Office, therefore patentee requests that the Certificate be issued at no cost.
- 3. Such error arose through the fault of patentee(s). A check or CCPF for \$_____ for the fee is enclosed. Such error is of a clerical or minor nature and occurred in good faith and therefore patentee requests issuance of the Certificate of Correction.
- 4. Specifically,

Very respectfully,

Patentee

Copatentee

Encs.

Address

Phone



UNITED STATES PATENT AND TRADEMARK OFFICE CERTIFICATE OF CORRECTION

Page ____ of ____

PATENT NO. :

APPLICATION NO.:

ISSUE DATE :

INVENTOR(S) :

It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

MAILING ADDRESS OF SENDER (Please do not use customer number below):

This collection of information is required by 37 CFR 1.322, 1.323, and 1.324. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Attention Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Maintenance Fee Reminder

Next fee due: _____ / _____ / _____
yr mo date

(Write year in pencil and change after each payment)

Patent Nr.: _____ Issued: _____

Application Serial Nr.: _____ Filed: _____

Title: _____

Patentee(s) (Inventor[s]/Applicant[s]): _____

Assignee(s) (if any): _____

Expires _____ (if all three maintenance fees are paid).¹

Small entity status was filed in application or patent.
 (If not, large entity fees² must be paid.)

Maintenance Fee Number	Fee Due		Sent Form & Check ⁴	Amount	Received Receipt Statement
	From:	To:			
I. Due 3.0 - 3.5 YAI ³	/ /	/ /	/ /	\$	/ /
II. Due 7.0 - 7.5 YAI	/ /	/ /	/ /	\$	/ /
III. Due 11.0 - 11.5 YAI	/ /	/ /	/ /	\$	/ /

Notes: _____

¹ For applications filed after 1995 Jun 7, expiration is 20 years from filing date of application, or from any earlier domestic nonprovisional (regular) application from which it claims priority, plus any adjustment (extension) granted by the PTO.

² Please check all fee amounts before paying, since PTO fees change often.

³ YAI = Years After Issue date.

⁴ Send or make Internet payment at least a month before due date to allow time to take corrective action before entering grace (penalty) period in case PTO does not accept payment.

In the United States Patent and Trademark Office

Patent No.: _____

Issued: _____

Patentee(s): _____

Ser. Nr.: _____

Filed: _____

Submission of Maintenance Fee

United States Patent and Trademark Office

P.O. Box 979070

St. Louis, MO 63197-9000

Sir:

Enclosed is the following maintenance fee for the above patent: this fee is for a large entity small entity, since small-entity status was filed in connection with the above application and small-entity status is still proper.

- 3.5 year fee; \$ _____; due 3.0 to 3.5 years after issue; covers years 4.0 thru 8.0.
- 7.5 year fee; \$ _____; due 7.0 to 7.5 years after issue; covers years 8.0 thru 12.0.
- 11.5 year fee; \$ _____; due 11.0 to 11.5 years after issue; covers years 12.0 thru expiration.
- Also enclosed is a surcharge of \$ _____ (total enclosed \$ _____) since this fee is being filed in the six-month grace period after the above due period.

Very respectfully,

Either Patentee/Assignee

Address

Phone

Certificate of Mailing or Faxing

I certify that I will:

- mail this correspondence with the U.S. Postal Service as First Class Mail in an envelope together with a check or PTO-2038 (Credit Card Payment Form), addressed to "United States Patent and Trademark Office, P.O. Box 979070, St. Louis, MO 63197-9000"
- fax this correspondence together with a PTO-2038 (Credit Card Payment Form), to the U.S. Patent and Trademark Office, at 571-273-6500 on the date below.

Date: 20_____, Applicant

Joint Applicants—Statement of Respective Contributions

The parties to this statement are Joint Applicants (JAs) to the invention or patent application entitled:

“ _____ ”.

We understand that a patent application should be filed in the names of all persons who contributed to at least one claim and that any person who did not contribute to at least one claim should not be named as a JA.

We also recognize and agree that if the patent claims in any patent application based on the invention are altered so that the listing of any JA is inappropriate, that JA should be removed from the patent application.

In order to keep the contributions of the JAs in order and preserve them, we hereby record each JA's contributions as follows:

Joint Applicants

Print Name: _____ Date: _____

Signature: _____

Contributions: _____

Print Name: _____ Date: _____

Signature: _____

Contributions: _____

Joint Owners' Agreement

This agreement is made by and between the following parties who, by separate assignment or as joint applicants, own the following respective shares of the invention, patent application, or patent identified below:

_____ of _____, _____%,
_____ of _____, _____%,
_____ of _____, _____%.

Invention Title: _____

Patent Application Ser. Nr.: _____, Filed: _____

Patent Nr.: _____, Issued: _____

Applicants: _____

The above patent application data is to be filled in as soon as it becomes available if the application has not yet been filed.

The parties desire to stipulate the terms under which they will exploit this invention and patent application and therefore agree as follows:

- 1. No Action Without Everyone's Consent:** None of the parties to this agreement shall license, use, make, or sell the invention or application, or take any other action, other than normal prosecution, without the written consent and cooperation of the other party or parties (hereinafter "parties") to this agreement, except as provided below. Any action so taken shall be committed to a writing signed by all of the parties, or as many parties as consent, with copies to all other parties.
- 2. Decisions:** In case any decision must be made in connection with the invention or the patent application, including foreign filing, appealing from an adverse decision in the Patent and Trademark Office, or any opportunity to license, sell, make, or use the invention or application, the parties shall consult on such opportunity and a majority decision shall control. In the event the parties are equally divided, the matter shall be decided in accordance with Paragraph 5 below. After a decision is so made, all parties shall abide by the decision and shall cooperate fully by whatever means are necessary to implement and give full force to such decision. However, if an offer is involved and there is time for any parties to obtain a better or different offer, they shall be entitled to do so and the decision shall be postponed for up to one month to allow such other parties to act.
- 3. Proportionate Sharing:** The parties to this agreement shall share, in the percentages indicated above, in all income from, liabilities, and expenditures agreed to be made by any decision under Part 2 above in connection with the invention or patent application. In case a decision is made to make any expenditure, as for foreign patent application filing, exploitation, etc., and a minority or other parties opposes such expenditure or is unable to contribute his or her proportionate share, then the others shall advance the minority or other parties' share of the expenditure. Such others shall be reimbursed by the minority or other parties by double the amount so advanced from the minority or other parties' proportionate share of any income received, provided such income has some reasonable connection with the expenditure. No party shall be entitled to reimbursement or credit for any labor unless agreed to in advance by all of the parties hereto.
- 4. If Any Parties Desire to Manufacture, Etc.:** If any parties who do not constitute all of the parties to this agreement desire to manufacture, distribute, or sell any product or service embodying the above invention,

they may do so with the written consent of the other parties under Part 1 above. The cost of the product or service shall include, in addition to normal profit, labor, commission, and/or overhead, etc., provision for a reasonable royalty which shall be paid for the term of the above patent application and any patent which may issue thereon. Such royalty shall be determined before any action is taken under this part and as if a valid patent on the invention had been licensed to an unrelated exclusive licensee (or a nonexclusive licensee if the patent is licensed to others) in an arm's-length transaction. Such royalty shall be distributed to all of the parties hereto according to their proportionate shares and on a quarterly basis, accompanied by a written royalty report and sent within one month after the close of each calendar quarter.

- 5. In Case of Dispute:** In case any dispute, disagreement, or need for any decision arises out of this agreement or in connection with the invention or patent application, and the parties cannot settle the matter or come to a decision in accordance with Paragraph 2, above, the parties shall first confer as much as necessary to settle the disagreement; all parties shall act and compromise to at least the degree a reasonable person would act. If the parties cannot settle their differences or come to a decision on their own, they shall submit the dispute or matter to mediation by an impartial third party or professional mediator agreed to by all of the parties. If the parties cannot agree on a mediator, or cannot come to an agreement after mediation, then they shall submit the matter to binding arbitration with a mutually acceptable arbitrator or the American Arbitration Association. The arbitration shall take place in _____ (City and State) and the law of _____ (State) shall apply. The arbitrator shall settle the dispute in whatever manner he or she feels will do substantial justice, recognizing the rights of all parties and commercial realities of the marketplace. The parties shall abide by the terms of the arbitrator's decision and shall cooperate fully and do any acts necessary to implement such decision. The costs of the arbitrator shall be advanced by all of the parties or in accordance with Part 3 above and the arbitrator may make any allocation of arbitration costs he or she feels is reasonable. The arbitrator's award may be entered as a judgment by the prevailing party in any court of record.
- 6. Nonfrustration:** No party to this Agreement shall commit any act or take any action which frustrates or hampers the rights of another party under this Agreement. Each party shall act in good faith and engage in fair dealing when taking any action under or related to this Agreement.

Signature _____ Date _____

Signature _____ Date _____

Signature _____ Date _____

Assignment of Invention and Patent Application

For value received, _____,

of _____

(hereinafter ASSIGNOR), hereby sells, assigns, transfers, and sets over unto _____

of _____

and her or his successors or assigns (hereinafter ASSIGNEE) _____% of the following: (A) ASSIGNOR's right, title, and interest in and to the invention entitled " _____ "

invented by ASSIGNOR; (B) the application for United States patent therefor, signed by ASSIGNOR on _____,

U.S. Patent and Trademark Office Serial Number _____,

filed _____; (C) any patent or reissues of any patent that may be granted

thereon; and (D) any applications which are provisional patent applications which said application claims priority

of, or nonprovisional applications which claim priority of said application, or continuations, continuations-in-

part, substitutes, or divisions of said application. ASSIGNOR authorizes ASSIGNEE to enter the date of signature

and/or Serial Number and Filing Date in the spaces above. ASSIGNOR also authorizes and requests the Commis-

sioner for Patents to issue any resulting patent(s) as follows: _____% to ASSIGNOR and _____

% to ASSIGNEE. (The singular shall include the plural and vice versa herein.)

ASSIGNOR hereby further sells, assigns, transfers, and sets over unto ASSIGNEE, the above percentage of

ASSIGNOR's entire right, title, and interest in and to said invention in each and every country foreign to the

United States; and ASSIGNOR further conveys to ASSIGNEE the above percentage of all priority rights resulting

from the above-identified application for United States patent. ASSIGNOR agrees to execute all papers, give any

required testimony, and perform other lawful acts, at ASSIGNEE's expense, as ASSIGNEE may require to enable

ASSIGNEE to perfect ASSIGNEE's interest in any resulting patent of the United States and countries foreign

thereto, and to acquire, hold, enforce, convey, and uphold the validity of said patent and reissues and extensions

thereof, and ASSIGNEE's interest therein.

In testimony whereof ASSIGNOR has hereunto set its hand and seal on the date below.

Signature _____ Date _____

Signature _____ Date _____

Witnessed by:

Signature _____ Date _____

Signature _____ Date _____

RECORDATION FORM COVER SHEET PATENTS ONLY

To the Director of the U.S. Patent and Trademark Office: Please record the attached documents or the new address(es) below.

1. Name of conveying party(ies)

Additional name(s) of conveying party(ies) attached? Yes No

2. Name and address of receiving party(ies)

Name: _____
Internal Address: _____

Street Address: _____

City: _____
State: _____
Country: _____ Zip: _____
Additional name(s) & address(es) attached? Yes No

3. Nature of conveyance/Execution Date(s):

Execution Date(s) _____

Assignment Merger
 Security Agreement Change of Name
 Joint Research Agreement
 Government Interest Assignment
 Executive Order 9424, Confirmatory License
 Other _____

4. Application or patent number(s): This document is being filed together with a new application.

A. Patent Application No.(s) _____
B. Patent No.(s) _____

Additional numbers attached? Yes No

5. Name and address to whom correspondence concerning document should be mailed:

Name: _____
Internal Address: _____

Street Address: _____

City: _____
State: _____ Zip: _____
Phone Number: _____
Fax Number: _____
Email Address: _____

6. Total number of applications and patents involved: _____

7. Total fee (37 CFR 1.21(h) & 3.41) \$ _____

Authorized to be charged to deposit account
 Enclosed
 None required (government interest not affecting title)

8. Payment Information

Deposit Account Number _____
Authorized User Name _____

9. Signature: _____ Signature _____ Date _____

Name of Person Signing

Total number of pages including cover sheet, attachments, and documents:

Documents to be recorded (including cover sheet) should be faxed to (571) 273-0140, or mailed to:
Mail Stop Assignment Recordation Services, Director of the USPTO, P.O.Box 1450, Alexandria, V.A. 22313-1450

Guidelines for Completing Patents Cover Sheets (PTO-1595)

Cover Sheet information must be submitted with each document to be recorded. If the document to be recorded concerns both patents and trademarks separate patent and trademark cover sheets, including any attached pages for continuing information, must accompany the document. All pages of the cover sheet should be numbered consecutively, for example, if both a patent and trademark cover sheet is used, and information is continued on one additional page for both patents and trademarks, the pages of the cover sheet would be numbered from 1 to 4.

Item 1. Name of Conveying Party(ies).

Enter the full name of the party(ies) conveying the interest. If there is insufficient space, enter a check mark in the "Yes" box to indicate that additional information is attached. The name of the additional conveying party(ies) should be placed on an attached page clearly identified as a continuation of the information Item 1. Enter a check mark in the "No" box, if no information is contained on an attached page. If the document to be recorded is a joint research agreement, enter the name(s) of the party(ies) other than the owner of the patent or patent application as the conveying party(ies).

Item 2. Name and Address of Receiving Party(ies).

Enter the name and full address of the first party receiving the interest. If there is more than one party receiving the interest, enter a check mark in the "Yes" box to indicate that additional information is attached. Enter a check mark in the "No" box, if no information is contained on an attached page. If the document to be recorded is a joint research agreement, enter the name(s) of the patent or patent application owner(s) as the receiving party.

Item 3. Nature of Conveyance/Execution Date(s).

Enter the execution date(s) of the document. It is preferable to use the name of the month, or an abbreviation of that name, in order that confusion over dates is minimized. Place a check mark in the appropriate box describing the nature of the conveying document. If the "Other" box is checked, specify the nature of the conveyance.

Item 4. Application Number(s) or Patent Number(s).

Indicate the application number(s), and/or patent number(s) against which the document is to be recorded. National application numbers must include both the series code and a six-digit number (e.g., 07/123,456), and international application numbers must be complete (e.g., PCT/US91/12345).

Enter a check mark in the appropriate box: "Yes" or "No" if additional numbers appear on attached pages. Be sure to identify numbers included on attached pages as the continuation of Item 4. Also enter a check mark if this Assignment is being filed with a new application.

Item 5. Name and Address of Party to whom correspondence concerning the document should be mailed.

Enter the name and full address of the party to whom correspondence is to be mailed.

Item 6. Total Applications and Patents involved.

Enter the total number of applications and patents identified for recordation. Be sure to include all applications and patents identified on the cover sheet and on additional pages.

Block 7. Total Fee Enclosed.

Enter the total fee enclosed or authorized to be charged. A fee is required for each application and patent against which the document is recorded.

Item 8. Payment Information.

Enter the deposit account number and authorized user name to authorize charges.

Item 9. Signature.

Enter the name of the person submitting the document. The submitter must sign and date the cover sheet. Enter the total number of pages including the cover sheet, attachments, and document.

This collection of information is required by 35 USC 261 and 262 and 15 USC 1057 and 1060. The information is used by the public to submit (and by the USPTO to process) patent and trademark assignment requests. After the USPTO records the information, the records for patent and trademarks, assignments, and other associated documents can be inspected by the public. To view documents recorded under secrecy orders or documents recorded due to the interest of the federal government, a written authorization must be submitted. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the form to the USPTO. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Manager of the Assignment Division, USPTO, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Assignment Recordation Services, Director of the USPTO, P.O. Box 1450, Alexandria, VA 22313-1450.

Universal License Agreement

1. Parties and Summary of Terms:

Parties: This agreement is between:

Licensor: _____,
of _____.

Licensee: _____,
of _____.

Summary: Type of License: Exclusive Nonexclusive

Invention Title: _____.

Patent Application Ser. Nr.: _____, Filing Date: _____.

If Exclusive License, minimum number of units to be sold to compute Minimum Annual Royalty (MAR): _____.

MARs start first quarter of _____.

Option Granted: Premium \$ _____ For term of: _____ months

Patent Royalty Rate _____% Know-How Licensed: Know-How Royalty Rate: _____%

Total Royalty Rate (Patent Royalty Rate plus Know-How Royalty, if applicable): _____%.

Estimated 1st year's sales (units): _____ x Estimated Unit Price \$ _____

x Total Royalty Rate _____% = Licensing Fee \$ _____

2. Effective Date: This agreement shall be effective as of the latter of the signature dates below written and shall be referred to as the Agreement of such date.

3. Recitals:

A. LICENSOR has developed an invention having the above title and warrants that LICENSOR has filed a patent application on such invention in the U.S. Patent and Trademark Office, which patent application is identified by the above title, Serial Number, and Filing Date. LICENSOR warrants that LICENSOR has full and exclusive right to grant this license on this invention and LICENSOR's patent application. If the "Know-How Licensed" box above is checked, LICENSOR has also developed know-how in connection with said invention and warrants that LICENSOR owns and has the right to license said know-how.

B. LICENSEE desires, if the "Option Granted" box above is checked, to exclusively investigate LICENSOR's above invention for the term indicated. If said "Option Granted" box is not checked, or if said box is checked and LICENSEE investigates LICENSOR's invention for the term indicated and such investigation is favorable, LICENSEE desires to make, use, and sell the products embodying such invention and covered by the claims of LICENSOR's patent application and any patent(s) issuing thereon (hereinafter "Licensed Product").

4. If Option Granted: If the "Option Granted" box above is checked, then (A) the patent license grant of Part 5 below shall not take effect except as defined in this part, and (B) LICENSOR hereby grants LICENSEE, for the option premium stated above, an exclusive option to investigate LICENSOR's invention for the term indicated above, such term to commence from the date of this Agreement. LICENSOR will furnish LICENSEE with all information and know-how (if any) concerning LICENSOR's invention in LICENSOR's possession. LICENSEE will investigate LICENSOR's invention for operability, costing, marketing, etc. LICENSEE shall report the results of its investigation to LICENSOR at any time before the end of the option term. If LICENSEE's determination is favorable, it may thereupon exercise this option and the patent license grant of Part 5 below shall become effective. If LICENSEE's determination is unfavorable, then said option shall not be exercised and no patent license grant shall take effect, all rights hereunder shall revert to LICENSOR, LICENSEE shall deliver to LICENSOR all results of its investigations for LICENSOR's benefit, and LICENSEE shall promptly return to LICENSOR all know-how (papers and things) received from LICENSOR or generated by LICENSEE in its investigations.

5. **Patent License If Option Exercised or If Option Not Granted:** If the "Option Granted" box above is checked and LICENSEE has investigated LICENSOR's invention and such investigation is favorable and LICENSEE has exercised its option, or if said box is not checked, then LICENSOR hereby grants to LICENSEE, subject to the terms and conditions herein, a patent license of the type (Exclusive or Nonexclusive) checked above. Such patent license shall include the right to grant sublicenses, to make, have made, use, and sell the Licensed Product throughout the United States, its territories, and possessions. Such patent license shall be under LICENSOR's patent application, any continuations, divisions, continuations-in-part, substitutes, reissues of any patent from any of such applications (hereinafter and hereinbefore LICENSOR's patent application), any patent(s) issuing thereon, and if the "Know-How Licensed" box is checked above, any know-how transferred to LICENSEE.
6. **If Know-How Licensed:** If the "Know-How" box above is checked, LICENSOR shall communicate to LICENSEE all of LICENSOR's know-how in respect of LICENSOR's invention within one month after the date of this Agreement and shall be available to consult with LICENSEE, for up to 80 hours, with respect to the licensed invention and know-how. All travel and other expenses of LICENSOR for such consultation shall be reimbursed by LICENSEE within one month after LICENSOR submits its voucher therefor. LICENSOR makes no warranty regarding the value, suitability, or workability of such know-how. The royalty applicable for such know-how shall be paid, at the rate indicated above, for a minimum of three years from the date of this Agreement if no option is granted, or for three years from the date of exercise if an option is granted and exercised by LICENSOR, and thereafter for so long as LICENSEE makes, uses, or sells Licensed Products and has a share in the United States of at least 15% of the competitive market for Licensed Products.
7. **Royalties:**
- A. **Licensing Fee:** Unless the "Option Granted" box above is checked, LICENSEE shall pay to LICENSOR, upon execution of this Agreement, a nonrefundable Licensing Fee. This Licensing Fee shall also serve as an advance against future royalties. Such Licensing Fee shall be computed as follows: (A) Take the Total Royalty Rate in percent, as stated above. (B) Multiply by LICENSEE's Estimate of Its First Year's Sales, in units of Licensed Product, as stated above. (C) Multiply by LICENSEE's Estimated Unit Price of Licensed Product, in dollars, as stated above. (D) The combined product shall be the Licensing Fee, in dollars, as stated above. When LICENSEE begins actual sales of the Licensed Product, it shall certify its Actual Net Factory Sales Price of Licensed Product to LICENSOR in writing and shall either (1) simultaneously pay LICENSOR any difference due if the Actual Net Factory Sales Price of Licensed Product is more than the Estimated Unit Price, stated above, or (2) advise LICENSOR of any credit to which LICENSEE is entitled if the Actual Net Factory Sales Price of Licensed Product is less than the above Estimated Unit Price. In the latter case, LICENSEE may deduct such credit from its first royalty remittance to LICENSOR, under subpart B below. If an option is granted and exercised under Part 4 above, then LICENSEE shall pay this Licensing Fee to LICENSOR if and when LICENSEE exercises its option.
- B. **Royalty:** If the "Option Granted" box above is not checked, or if said box is checked and LICENSEE has exercised its option under Part 4, LICENSEE shall also pay to LICENSOR a Total Royalty, at the rate stated above. Such royalty shall be at the Patent Royalty Rate stated in Part 1 above, plus, if the "Know-How Licensed" box above is checked, a Know-How Royalty at the Know-How Royalty Rate stated above. Said Total Royalty shall be computed on LICENSEE's Net Factory Sales Price of Licensed Product. Such Total Royalty shall accrue when the Licensed Products are first sold or disposed of by LICENSEE, or by any sublicensee of LICENSEE. LICENSEE shall pay the Total Royalty due to LICENSOR within one month after the end of each calendar quarter, together with a written report to LICENSOR of the number of units, respective sales prices, and total sales made in such quarter, together with a full itemization of any adjustments made pursuant to subpart F below. LICENSEE's first report and payment shall be made within one month after the end of the first calendar quarter following the execution of this Agreement. No royalties shall be paid by LICENSEE to LICENSOR until after the Licensing Fee under subpart A above has been earned, but LICENSEE shall make a quarterly report hereunder for every calendar quarter after the execution hereof,

whether or not any royalty payment is due for such quarter, except that if an option is granted, LICENSEE shall not make any royalty reports until and if LICENSEE exercises its option.

- C. Minimum Annual Royalties:** If the “Exclusive” box above is checked, so that this is an exclusive license, then this subpart C and subpart D shall be applicable. But if the “Nonexclusive” box is checked above, then these subparts C and D shall be inapplicable. There shall be no minimum annual royalties due under this Agreement until the “Year Commencing,” as identified in Part 1 above. For the exclusivity privilege of the patent license grant under Part 5 above, a Minimum Annual Royalty shall be due beginning with such royalty year and for each royalty year ending on the anniversary of such royalty year thereafter. Such Minimum Annual Royalty shall be equal to the Patent Royalty which would have been due if the “Minimum Number of Units [of Licensed Product] to Be Sold to Compute Minimum Annual Royalty” identified in Part 1 above were sold during such royalty year. If less than such number of units of Licensed Product are sold in any royalty year, then the Patent Royalty payable for the fourth quarter of such year shall be increased so as to cause the Patent Royalties paid for such year to equal said Minimum Annual Royalty. If an option is granted under Parts 1 and 4, then no Minimum Annual Royalties shall be due in any case until and if LICENSEE exercises its option.
- D. If Minimum Not Paid:** If this part is applicable and if sales of Licensed Product in any royalty year do not equal or exceed the minimum number of units identified in Part 1 above, LICENSEE may choose not to pay the Minimum Annual Royalty under subpart C above. In this case, LICENSEE shall so notify LICENSOR by the date on which the last royalty for such year is due, i.e., within one month after any anniversary of the date identified in Part 1 above. Thereupon the license grant under Part 4 above shall be converted to a nonexclusive grant, and LICENSOR may immediately license others under the above patent.
- E. Most Favored Licensee:** If this license is nonexclusive, or if it becomes nonexclusive under subpart D above, then (a) LICENSOR shall not grant any other license under the above patent to any other party under any terms which are more favorable than those which LICENSEE pays or enjoys under this Agreement, and (b) LICENSOR shall promptly advise LICENSEE of any such other grant and the terms thereof.
- F. When No Royalties Due:** No Patent Royalties shall be due under this Agreement after the above patent expires or if it is declared invalid by a court of competent jurisdiction from which no appeal can be taken. Also, if LICENSOR’s patent application becomes finally abandoned without any patent issuing, then the Patent Royalty under this Agreement shall be terminated as of the date of abandonment. Any Know-How Royalties under Part 6 above shall continue after any Patent Royalties terminate, provided such Know-How Royalties are otherwise due under such Part 6.
- G. Late Payments:** If any payment due under this Agreement is not timely paid, then the unpaid balance shall bear interest until paid at an annual rate of 10% until the delinquent balance is paid. Such interest shall be compounded monthly.
- H. Net Factory Sales Price:** “Net Factory Sales Price” is defined as the gross factory selling price of Licensed Product, or the U.S. importer’s gross selling price if Licensed Product is made abroad, less usual trade discounts actually allowed, but not including advertising allowances or fees or commissions paid to employees or agents of LICENSEE. The Net Factory Sales Price shall not include (1) packing costs, if itemized separately, (2) import and export taxes, excise and other sales taxes, and customs duties, and (3) costs of insurance and transportation, if separately billed, from the place of manufacture if in the U.S., or from the place of importation if manufactured abroad, to the customer’s premises or next point of distribution or sale. Bona fide returns may be deducted from units shipped in computing the royalty payable after such returns are made.
- 8. Records:** LICENSEE and any of its sublicensees shall keep full, clear, and accurate records with respect to sales subject to royalty under this Agreement. The records shall be made in a manner such that the royalty reports made pursuant to Part 7B can be verified. LICENSOR, or its authorized agent, shall have the right to examine and audit such records upon reasonable notice during normal business hours, but not more than twice per year. In case of any dispute as to the sufficiency or accuracy of such records, LICENSOR may have

any independent auditor examine and certify such records. LICENSEE shall make prompt adjustment to compensate for any errors or omissions disclosed by any such examination and certification of LICENSEE's records. If LICENSOR does not examine LICENSEE's records or question any royalty report within two years from the date thereof, then such report shall be considered final and LICENSOR shall have no further right to contest such report.

9. **Sublicensees:** If LICENSEE grants any sublicenses hereunder, it shall notify LICENSOR within one month from any such grant and shall provide LICENSOR with a true copy of any sublicense agreement. Any sublicensee of LICENSEE under this Agreement shall be bound by all of the terms applying to LICENSEE hereunder and LICENSEE shall be responsible for the obligations and duties of any of its sublicensees.

10. Patent Prosecution:

- A. **Domestic:** LICENSOR shall, at LICENSOR's own expense, prosecute its above U.S. patent application, and any continuations, divisions, continuations-in-part, substitutes, and reissues of such patent application or any patent thereon, at its own expense, until all applicable patents issue or any patent application becomes finally abandoned. LICENSOR shall also pay any maintenance fees which are due on any patent(s) which issue on said patent application. If for any reason LICENSOR intends to abandon any patent application hereunder, it shall notify LICENSEE at least two months in advance of any such abandonment so as to give LICENSEE the opportunity to take over prosecution of any such application and maintenance of any patent. If LICENSEE takes over prosecution, LICENSOR shall cooperate with LICENSEE in any manner LICENSEE requires, at LICENSEE's expense.
- B. **Foreign:** LICENSOR shall have the opportunity, but not the obligation, to file corresponding foreign patent applications to any patent application under subpart A above. If LICENSOR files any such foreign patent applications, LICENSOR may license, sell, or otherwise exploit the invention, Licensed Product, or any such foreign application in any countries foreign to the United States as it chooses, provided that LICENSOR must give LICENSEE a right of first refusal and at least one month to exercise this right before undertaking any such foreign exploitation. If LICENSOR chooses not to file any corresponding foreign applications under this part, it shall notify LICENSEE at least one month prior to the first anniversary of the above patent application so as to give LICENSEE the opportunity to file corresponding foreign patent applications if it so chooses.
- C. **If Licensee Acts:** If LICENSEE takes over prosecution of any U.S. patent application under subpart A above, and LICENSEE is successful so that a patent issues, then LICENSEE shall pay LICENSOR royalties thereafter at a rate of 75% of the royalty rate and any applicable minimum under Part 7C above and LICENSEE shall be entitled to deduct prosecution and maintenance expenses from its royalty payments. If LICENSEE elects to prosecute any foreign patent applications under subpart B above, then LICENSEE shall pay LICENSOR royalties of 50% of the royalty rate under Part 7 above for any applicable foreign sales, less all foreign prosecution and maintenance expenses incurred by LICENSEE.

11. **Marking:** LICENSEE shall mark all units of Licensed Product, or its container if direct marking is not feasible, with the legend "Patent Pending" until any patent(s) issue from the above patent application. When any patent(s) issue, LICENSOR shall promptly notify LICENSEE and thereafter LICENSEE shall mark all units of Licensed Product which it sells with proper notice of patent marking under 35 U.S.C. Section 287.

12. **If Infringement Occurs:** If either party discovers that the above patent is infringed, it shall communicate the details to the other party. LICENSOR shall thereupon have the right, but not the obligation, to take whatever action it deems necessary, including the filing of lawsuits, to protect the rights of the parties to this Agreement and to terminate such infringement. LICENSEE shall cooperate with LICENSOR if LICENSOR takes any such action, but all expenses of LICENSOR shall be borne by LICENSOR. If LICENSOR recovers any damages or compensation for any action it takes hereunder, LICENSOR shall retain 100% of such damages. If LICENSOR does not wish to take any action hereunder, LICENSEE shall also have the right, but not the obligation, to take any such action, in which case LICENSOR shall cooperate with LICENSEE, but all of LICENSEE's expenses shall be borne by LICENSEE. LICENSEE shall receive 75% of any damages or

compensation it recovers for any such infringement and shall pay 25% of such damages or compensation to LICENSOR, after deducting its costs, including attorney fees.

13. Disclaimer and Hold Harmless:

A. Disclaimer of Warranty: Nothing herein shall be construed as a warranty or representation by LICENSOR as to the scope or validity of the above patent application or any patent issuing thereon.

B. Product Liability: LICENSEE shall hold LICENSOR harmless from any product liability actions involving Licensed Product.

14. Term: The term of this Agreement shall end with the expiration of the last of any patent(s) which issues on LICENSOR's patent application, unless terminated sooner for any reason provided herein, or unless know-how is licensed, in which case the terms of Part 6 shall cover the term of this Agreement.

15. Termination: This Agreement may be terminated under and according to any of the following contingencies:

A. Default: If LICENSEE fails to make any payment on the date such payment is due under this Agreement, or if LICENSEE makes any other default under or breach of this Agreement, LICENSOR shall have the right to terminate this Agreement upon giving three months' written Notice of Intent to Terminate, specifying such failure, breach, or default to LICENSEE. If LICENSEE fails to make any payment in arrears, or otherwise fails to cure the breach or default within such three-month period, then LICENSOR may then send a written Notice of Termination to LICENSEE, whereupon this Agreement shall terminate in one month from the date of such Notice of Termination. If this Agreement is terminated hereunder, LICENSEE shall not be relieved of any of its obligations to the date of termination and LICENSOR may act to enforce LICENSEE's obligations after any such termination.

B. Bankruptcy, Etc.: If LICENSEE shall go into receivership, bankruptcy, or insolvency, or make an assignment for the benefit of creditors, or go out of business, this Agreement shall be immediately terminable by LICENSOR by written notice, but without prejudice to any rights of LICENSOR hereunder. This paragraph shall not apply so long as LICENSEE continues to pay royalties on time under Part 7, subpart B or C.

C. Antishelving: If LICENSEE discontinues its sales or manufacture of Licensed Product without intent to resume, it shall so notify LICENSOR within one month of such discontinuance, whereupon LICENSOR shall have the right to terminate this Agreement upon one month's written notice, even if this Agreement has been converted to a nonexclusive grant under Part 7D above. If LICENSEE does not begin manufacture or sales of Licensed Product within one and one-half years from the date of this Agreement or the date of its option exercise if an option is granted, or, after commencing manufacture and sales of Licensed Product, discontinues its manufacture and sales of Licensed Product for one and one-half years, LICENSOR shall have the right to terminate this Agreement upon one month's written notice, unless LICENSEE can show that it in good faith intends and is actually working to resume or begin manufacture or sales, and has a reasonable basis to justify its delay. In such case LICENSEE shall advise LICENSOR in writing, before the end of such one-and-one-half-year period, of the circumstances involved and LICENSEE shall thereupon have up to an additional year to resume or begin manufacture or sales. It is the intent of the parties hereto that LICENSOR shall not be deprived of the opportunity, for an unreasonable length of time, to exclusively license its patent if LICENSEE has discontinued or has not commenced manufacture or sales of Licensed Product. In no case shall LICENSOR have the right to terminate this Agreement if and so long as LICENSEE is paying LICENSOR minimum annual royalties under Part 7C above.

16. Notices: All notices, payments, or statements under this Agreement shall be in writing and shall be sent by first-class certified mail, return receipt requested, postage prepaid, to the party concerned at the above address, or to any substituted address given by notice hereunder. Any such notice, payment, or statement shall be considered sent or made on the day deposited in the mails. Payments and statements may be sent by ordinary mail.

17. Mediation and Arbitration: If any dispute arises under this Agreement, the parties shall negotiate in good faith to settle such dispute. If the parties cannot resolve such dispute themselves, then either party may submit the dispute to mediation by a mediator approved by both parties. The parties shall both cooperate

with the mediator. If the parties cannot agree to any mediator, or if either party does not wish to abide by any decision of the mediator, then they shall submit the dispute to arbitration by any mutually acceptable arbitrator. If no arbitrator is mutually acceptable, then they shall submit the matter to arbitration under the rules of the American Arbitration Association (AAA). The arbitration shall take place in _____ (City and State) and the law of _____ (State) shall apply. Under any arbitration, both parties shall cooperate with and agree to abide finally by any decision of the arbitration proceeding. If the AAA is selected, the arbitration shall take place under the auspices of the nearest branch of the AAA to the other party. The costs of the arbitrator shall be advanced by all of the parties or in accordance with Part 3 above and the arbitrator may make any allocation of arbitration costs he or she feels is reasonable. The final costs of the arbitration proceeding shall be borne according to the decision of the arbitrator, who may apportion costs equally, or in accordance with any finding of fault or lack of good faith of either party. The arbitrator's award shall be nonappealable and may be entered as a judgment by the prevailing party in any court of record and shall be enforceable in any court of competent jurisdiction.

- 18. Assignment:** The rights of LICENSOR under this Agreement shall be assignable or otherwise transferrable, in whole or in part, by LICENSOR and shall vest LICENSOR's assigns or transferees with the same rights and obligations as were held by LICENSOR. This Agreement shall be assignable by LICENSEE to any entity that succeeds to the business of LICENSEE to which Licensed Products relate or to any other entity if LICENSOR's permission is first obtained in writing.
- 19. Jurisdiction and Venue:** This Agreement shall be interpreted under the laws of LICENSOR's state, as given in Part 1 above. Any action related to this Agreement shall be brought in the county of LICENSOR'S above address; LICENSEE hereby consents to such venue.
- 20. Nonfrustration:** Neither party to this Agreement shall commit any act or take any action which frustrates or hampers the rights of the other party under this Agreement. Each party shall act in good faith and engage in fair dealing when taking any action under or related to this Agreement.
- 21. No Challenge:** LICENSEE has investigated the validity of LICENSOR's patent and shall not challenge, contest, or impugn the validity of such patent.
- 22. Rectification:** In case of any mistake in this Agreement, including any error, ambiguity, illegality, contradiction, or omission, this Agreement shall be interpreted as if such mistake were rectified in a manner which implements the intent of the parties as nearly as possible and effects substantial fairness, considering all pertinent circumstances.
- 23. Entire Agreement:** This Agreement sets forth the entire understanding between the parties and supersedes any prior or contemporaneous oral understandings and any prior written agreements.
- 24. Signatures:** The parties, having carefully read this Agreement and having consulted or having been given an opportunity to consult counsel, have indicated their agreement to all of the above terms by signing this Agreement on the respective dates below indicated. LICENSEE and LICENSOR have each received a copy of this Agreement with both LICENSEE's and LICENSOR's original ink signatures thereon.

Licensor: _____ Date: _____

Print Licensor's Name: _____

Licensee: _____ Date: _____

Print Licensee's Name: _____

Forms Available at the PTO Website

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Assignment Recordation Cover Sheet	PTO-1595
Certificate of Correction Form to Correct Error In Patent	PTO/SB/44
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* Correspondence Address, Change of, Patent Application	PTO/SB/122
* Credit Card Payment Form (CCPF)	PTO-2038
* Customer Number, Request for	PTO/SB/125
* Customer Number, Request for Address Change in Existing	PTO/SB/124
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* Design Patent Application Transmittal	PTO/SB/18
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† Maintenance Fee Unintentionally Delayed—Petition to Accept Late	PTO/SB/66
† Maintenance Fee Unintentionally Delayed—Petition to Accept Late—to be filed by EFS-Web only	EFS-Web PTO/SB/66
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† Patent Application Data Sheet	PTO/SB/14
* Patent Application Declaration (Additional Inventors)	PTO/SB/02
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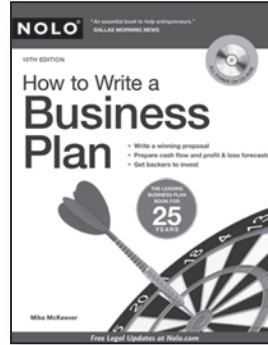
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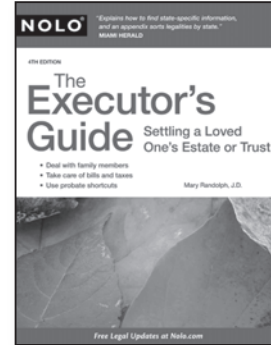
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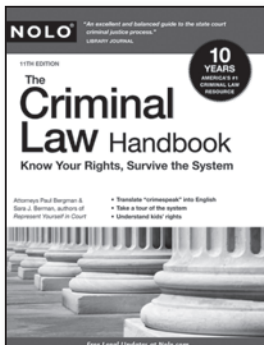
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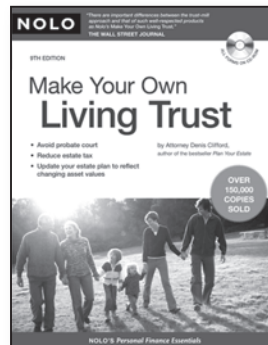
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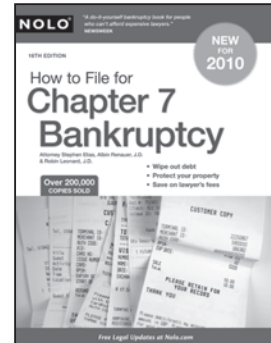
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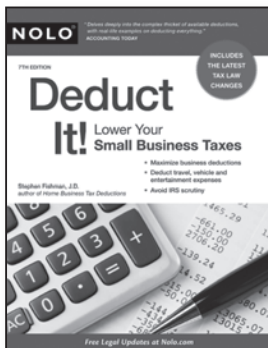
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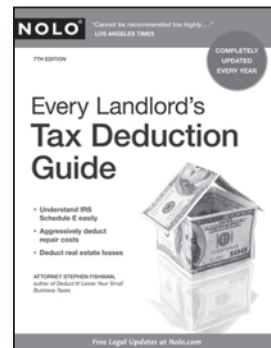
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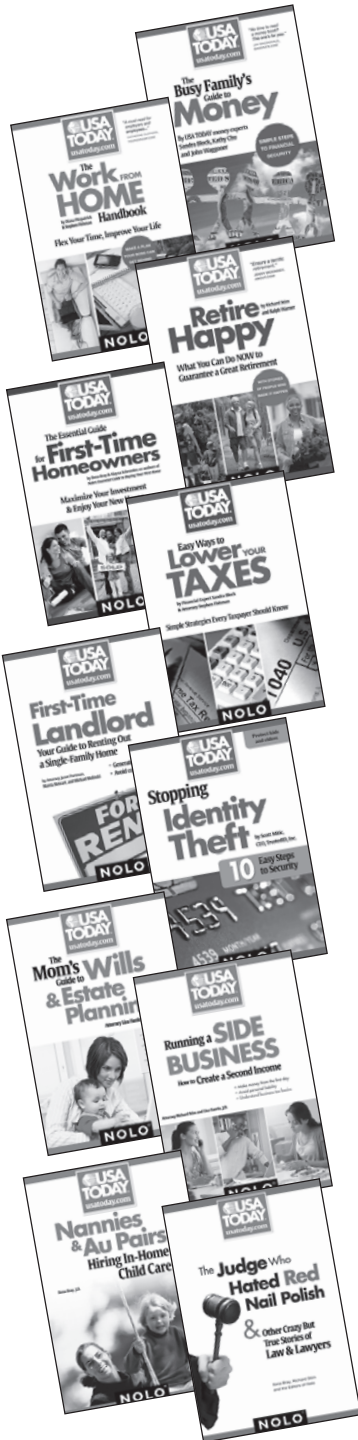
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About the Author

David Pressman is a member of the California and Patent and Trademark Office bars. He's had over 45 years' experience in the patent profession, as a patent examiner for the U.S. Patent Office, a patent attorney for Philco-Ford Corp., Elco Corp., and Varian Associates, as a columnist for *EDN Magazine* and *Entrepreneur.com*, and as an instructor at San Francisco State University. He contributed the Patent, Trademark and Copyright entries to the *World Book Encyclopedia*. He's also an inventor, with two patents issued. When not writing, dabbling in electronics, programming, inventing, or playing his trumpet, he practices as a patent lawyer in San Francisco. Originally from Philadelphia, he has a BS in Electrical Engineering from Pennsylvania State University. He spent his first year in law school at the University of Pennsylvania and completed his second and third years at George Washington University, where he served on the *Law Review* and received a Juris Doctor degree. He is also active in the general semantics and vegetarian movements. His mother, Mildred Phillips, was also a writer, having composed lyrics for numerous published songs, including Bill Haley's "Mambo Rock."

