

MTIP Innovators' Guide

Steps and Resources to Help You with the Innovation Process



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GREETINGS

Do you have an innovative concept or product?

Are you trying to achieve commercial success for it?

Montana state service providers get many requests for assistance from independent inventors and small businesses with new concepts they hope will succeed in the marketplace. Service resources are very limited, and each organization can assist only in their area of primary focus.

Therefore, before you can expect others to invest time or money in your concept, it is critically important that you take steps to:

- protect and develop your concept or product
- educate yourself about the innovation process
- learn if your innovation is feasible to achieve sales in the proposed market

This simple Innovators' Guide is in no way comprehensive, and you will want to dig more deeply into the resources referenced. Please understand clearly that Montana service organizations are NOT in the business of helping companies to find investors. At times, they can connect you to financial opportunities; however, be prepared – the application processes are highly competitive and require excellent writing skills.

Yours may well be among the small percentage of ideas that become successful. Or, your invention may be nothing more than a fun and satisfying hobby. In either case, the information provided here will guide you in critical steps of innovation and commercialization.

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GENERAL CONTENTS

- Confidentiality
- Invention Records
- Invention Evaluation
- Patenting Basics
- Obtaining a Patent
- Montana References
- Pamphlets and Books
- Online Resources
- Patent Counsel

CONFIDENTIALITY

It is important that you don't share details about your invention publicly before your patent is filed.

When you “disclose” your invention, or make it “public,” the announcement starts a grace period of one year to file a patent application, or you lose your right to monopolize the idea. Making an invention public might be something obvious like telling a crowd of friends at the coffee shop how to build and use your product or describing these details in your blog. Or, it might be less obvious like making a prototype and using it for your work on a commercial job.

At times, it is necessary to discuss details of the invention to market it or advance the development process. In those situations, ask the other party to sign a Confidentiality Agreement (also known as a Non-Disclosure Agreement). You can find sample agreements by searching online or by requesting a template from your patent attorney (a patent agent may not provide you with legal agreements).

The best behavior is to share the ‘enabling’ details (those details that would allow someone moderately skilled in the field to practice your invention) ONLY with those parties who absolutely must have that information to interact with you. It is not necessary to reveal enabling details to provide significant information to another party. Non-confidential information can include the type of product, the problem to be solved, the industry and market sectors, and the benefits of your invention.

Learn how to talk about your invention non-confidentially while keeping patentable information to yourself until the patent is filed. Develop a simple one-page technology brief to identify what you can reveal non-confidentially. It should state the problem being solved and the benefits of your solution. Add a graphic that will allow the reader to understand your field of interest without seeing your invention, and don't forget to include your name and contact information. In addition to disciplining yourself in how to speak about your innovation, this print piece will allow you to quickly introduce your concept to service providers and potential partners. Since selling or offering to sell your invention starts the one-year patentability clock ticking, you should never offer to sell, conduct pre-sales, or sell your product before filing your patent application.

Public use of your invention can be as troublesome as conducting pre-sales or sales. If you use the invention publicly (using it alone in your garage with the doors closed is okay), you have only a year to file a patent application.

INVENTION RECORDS

If you ever expect to make money from your innovation, you need to think and act like a business person.

In March 2013, the United States joined most other countries in giving credit for an invention to the first inventor filing a patent on it. This changed the importance of maintaining an invention logbook from earlier times when inventorship was based on documentation of being the first-to-invent. Nonetheless, your cumulative logbook or journal can be an important augmentation to memory when filing and prosecuting your patent. It should include all the details of your invention reduction to practice which is an essential requirement of patenting and which can be valuable in a patent interference proceeding. An invention log contains notes describing the development of your invention, including sketches, changes, test results, observations, materials used – everything! Future collaborators, investors, and licensing interests also may benefit from the insight into your invention development process.

Other vital records include a master file of all confidentiality and non-disclosure agreements you execute, material supply records and correspondence, as well as proper documentation of contacts you make and what information is provided to each. This recordkeeping ensures impeccable follow-up with prospective licensees and others. It will also permit you to follow through if confidentiality provisions have been violated.

INVENTION EVALUATION

It is highly recommended that you collect abundant information before incurring the costs of prototyping, patenting, and marketing your innovation.

It is critical that you make every effort to evaluate the feasibility of your invention from many different perspectives.

Your invention evaluation process should examine the following variables:

- Legality
- Safety
- Impact on society
- Performance
- Profitability
- Market demand
- Size of market
- Product-line potential
- Manufacturing feasibility
- Distribution channels
- Competition and bordering products
- Competitive advantages and disadvantages
- Consumer appeal
- Licensing potential
- Major barriers toward market or manufacturer acceptance

Be aware that the results you get from evaluations by service providers are only as good as the input you provide. If you don't have a strong basis for an answer, collect more information before requesting feedback. You are likely to invest vast quantities of personal time and thousands of dollars in your invention. Therefore, it is vital that you approach the process knowledgeably and with high-quality outside feedback

PATENTING BASICS

A patent is granted by the government and given only to the inventor or discoverer of a new and useful process, machine, article of manufacture, or composition of matter.

Each patent grants the owner a monopoly on one invention, with rights to exclude all others from making, using, selling or offering for sale the invention for approximately 20 years from the date of the patent application.

To be patentable, an invention must be:

- Novel (not previously known or described in public disclosure, e.g., a publication);
- Useful (incorporates a useful purpose and is not frivolous or immoral); and
- Non-obvious (not obvious to a person with ordinary skill in the relevant area of knowledge)

The invention must be outlined in all the detail that would allow it to be duplicated by a person with ordinary skill in that field. A patent will not be granted if (among other things) the invention was already patented, if it was described in a

printed publication anywhere else in the world, if the invention was made available for public use or sale in the U.S. prior to the 12 months before filing, or if the inventor's application for a patent in another country was granted before the filing date of the U.S. application. A patent cannot be obtained on an abstract idea, a law of nature, or a natural phenomenon.

A preliminary patentability search is essential in determining whether an invention is novel and in aiding you and your patent counsel in drafting the patent application. The government thoroughly examines for patentability. Present backlogs in the U.S. Patent and Trademark Office (USPTO) may prevent examination of a new patent application for 24 to 30 months. Therefore, it may take several years before a patent is issued.

A Provisional Patent Application (PPA) allows an inventor to claim "patent pending" status for the invention for 12 months and can involve less work and cost than a Regular Patent Application (also referenced as a Non-Provisional Patent Application). A PPA allows the inventor a year to further develop and market the invention under a patent-pending status. Before the end of the year, the U.S. Regular Patent Application must be filed to continue the uninterrupted first-to-file patent rights on whatever you disclosed in the PPA filing.

The U.S. Patent & Trademark Office (USPTO) has an excellent resource section for inventors and entrepreneurs: <https://www.uspto.gov/learning-and-resources/support-centers/inventors-assistance-center-iac>. General information may be requested by calling the USPTO at (800) 786-9199.

OBTAINING A PATENT

Steps to a Patent Application

The World Intellectual Property Organization distributes a FREE handbook about the patenting process. "Inventing the Future" is written in easy-to-read language and is at www.wipo.int/freepublications/en/sme/917/wipo_pub_917.pdf.

Following are the typical steps in pursuing a patent:

1. Look for similar products in stores and on the Internet to develop an understanding of the market opportunity or need for your invention.
2. Review publications, articles, and technical literature to find out how the problem you have identified is currently being solved. Become knowledgeable about the problem and the estimated costs of your solution as opposed to those already available.
3. Do an initial search online or hire a qualified search agent (most easily located through a patent attorney or agent). A preliminary approach to patent searching is well-described in the USPTO slide-show tutorial: <https://www.uspto.gov/video/cbt/ptrcsearching/>.
4. Arrange a first consultation with a patent attorney or a patent agent qualified in your field of inventing and with whom you can communicate well. This individual must be registered with the USPTO, which you can verify by searching at <https://www.uspto.gov/learning-and-resources/patent-and-trademark-practitioners/finding-patent-practitioner>.
5. Clearly understand the costs and expectations of patent counsel before deciding on a patent strategy and making a deposit for services.
6. Prepare an invention disclosure and patent application interactively with patent counsel.
7. Cooperate with your patent counsel on a professional patent search (if needed), forms completion, and the creation of patent-ready illustrations.
8. File the application – getting a patent application number makes your invention "patent pending."
9. Work with your patent counsel to respond to the patent examiner's 'Office Action' in which your claims are allowed, disallowed, or challenged.
10. Be patient - today's patent process moves slowly and may require two years or more before an examiner looks at your application. There may be more than one Office Action until the patent is in a form that can be allowed for issuance.

MONTANA REFERENCES



THE LIBRARY AT MONTANA STATE UNIVERSITY-BOZEMAN

Reference personnel at Renne Library, MSU-Bozeman will help you initiate a patent search. Library personnel also have search access to over 450 electronic databases, including patent databases, as well as access to other commercial online systems. For more search information, call (406) 994-3171 or look online at <http://guides.lib.montana.edu/c.php?g=198221&p=1303091>. Handouts that explain the service and fees are available at the library. Ask the library staff about patent and trademark books available for checkout.



THE LIBRARY AT UNIVERSITY OF MONTANA, MISSOULA

The Maureen and Mike Mansfield Library offers patent-search features similar to those at MSU-Bozeman. This library also carries the Official Gazette, which contains abstracts of patents. For more information contact the Document Division at (406) 243-6866 or (800) 240-4939, or online at www.lib.umt.edu.

PAMPHLETS & BOOKS

Nolo.com publishes a how-to patent, copyright, and trademark guides available online at <https://store.nolo.com/products/intellectual-property>. Nolo began publishing a self-service legal guide in 1971. Over the past four decades, technology advancements paved the way for Nolo's do-it-yourself software such as "Getting Permission, Patent It Yourself, and Trademark. While MTIP doesn't endorse any product or product line, it's useful for inventors to be aware that such software exists from companies like Nolo, and many more.

ONLINE RESOURCES

INTELLECTUAL PROPERTY

U.S. Copyright Office	https://www.copyright.gov/help/faq/index.html
World Intellectual Patent Organization	https://www.wipo.int/portal/en/
U.S. Patent & Trademark Office	www.uspto.gov

INVENTOR ORGANIZATIONS

United Inventor's Association of America	www.uiausa.org
American Society of Inventors	aso.org

OTHER INVENTOR INFORMATION

Inventor's Digest	www.inventorsdigest.com
License Marketing Firms (Good Guys™)	www.inventorfraud.com
About Invention Promotion Firms	www.consumer.ftc.gov/articles/0184-invention-promotion-firms
Scam Prevention	www.uspto.gov/patents-getting-started/using-legal-services/scam-prevention

MONTANA INNOVATION PARTNERSHIP (MTIP) powered by MSU TechLink Center

MTIP provides free counseling from consultants knowledgeable and well-experienced with the process of moving innovation into the marketplace. MTIP's program staff and consultants will help you determine the needs of the company and assist by offering technical assistance to guide you through the innovation process. For more information visit montanainnovationpartnership.org or email techlinksbir@montana.edu.



SMALL BUSINESS DEVELOPMENT CENTER NETWORK

The Montana Small Business Development Center network supports ten centers around the state, focusing on counseling in areas such as financial analysis, business planning, training and workshops and loan packaging assistance to help small businesses achieve their goals of growth, expansion, innovation, and success. Call (406) 841-2747 or visit the network website at <https://sfdc.mt.gov/> to find the center nearest to you.



PATENT COUNSEL

Patent attorneys and patent agents have both taken and passed the rigorous examination for registration before the USPTO, and both may have a similar technical education. The difference between patent attorneys and patent agents relates to their capacity to practice law. Patent agents can be very capable of preparing excellent patents. However, only a lawyer can provide legal advice, draft contracts or non-disclosure agreements, or represent you in legal proceedings involving state or Federal court. Visit the Patent Practitioner Home Page (<https://oedci.uspto.gov/OEDCI/>) to search for attorneys and agents with licenses to practice before the US Patent and Trademark Office.
