

by Howard M. Cohn

PATENT ATTORNEY

*This third of a four-part story is designed to cover the basics of the Patent Process.*

The outcome of the meeting between Julie and Rob, employees of the Millennium Bicycle Company, their boss Ted, the owner of the Millennium Bicycle Co. and Michael Jones, a patent attorney, was that Julie and Rob would assign their rights to the adjustable bike rack to Millennium, and Attorney Jones would proceed with preparing and filing a Patent Application. Before the meeting was over, Attorney Jones suggested to Ted that Millennium would be well advised to consider protecting other intellectual property rights, such as trademarks, copyrights, and the aesthetic design of the bike rack.

The decision as to how to proceed is a business decision because of the costs for acquiring intellectual property rights. Since there is a strong possibility that a large sporting goods company will license the bike rack, a well-considered strategy seems appropriate. Ted, the company president, decided that Julie, being Millennium's legal counsel and marketing manager, should work closely with Attorney Jones as to the property rights, including the preparation and filing of all patent applications.

Julie and Attorney Jones meet immediately to map out a strategy to protect Millennium's intellectual property. During the meeting, Attorney Jones explained that a patent is a grant of an exclusive property

right by the government to the inventor to *exclude others* from making, using, or selling the invention for the duration of the patent. However, the patent does always not give the inventor the right to make, use, or sell their own invention, because doing so might sometimes infringe upon the intellectual property rights of others, especially if the invention is an improvement of someone else's earlier invention that still has patent protection.

Attorney Jones suggests that the inventors of the bike rack prepare an "invention disclosure form," which describes the prior art (i.e., prior documents such as patents or published articles), the differences between the prior art and the new invention. The invention disclosure form also describes the novelty of the new invention and its advantages over existing apparatus and/or methods; it also includes drawings and a listing of the contributions of each inventor. Over the following several days, Attorney Jones drafts an invention disclosure form, which he forwards to Julie for her examination. (See [www.ncpto.com/form/idf](http://www.ncpto.com/form/idf) for a sample invention disclosure form.)

Attorney Jones recommends to Julie that a preliminary patent search be conducted among the patents previously granted, and possibly of printed publications, to make sure that the bike rack has not already been patented or disclosed in a published document. Attorney Jones tells Julie that the results of the search will give him the information to provide proper guidance and counsel as to proceeding with a patent ap-

plication.

Six million patents have already been issued. Therefore a preliminary patentability search can prevent the needless expense of a patent application, especially if the search turns up prior patents that might prevent the invention from issuing as a patent. At the least, any prior art that is uncovered will restrict the scope of patent protection, and may dictate certain design choices.

The most common type of patent is a "utility patent" which remains in force for 20 years from the application filing date. Utility patents cover new and useful processes or machines, as with the bike rack. Utility patents also cover improvements to things that already exist, whether they are patented or not.

Another type of patent application is the "provisional patent application," which can be a low-cost way to establish a priority date while also providing one full year of worldwide protection for a new idea.

Attorney Jones also suggested the possibility of filing a "design patent" application. Design patents provide 14 years of protection for ornamental features (e.g., overall appearance) of the bike rack.

Next month we will examine the results from the preliminary patent search, and the main details in preparation of a utility patent application and also the things that Attorney Jones has to anticipate in his "prosecuting the patent application" in the Patent Office.

*Disclaimer: This article is intended to be educational, and does not constitute legal advice, nor does it create or constitute any attorney-client relationship.*

Howard M. Cohn

Patent Attorney

Beachwood, Ohio 44122

216-752-0955

[howard.cohn@ncpto.com](mailto:howard.cohn@ncpto.com)

[www.ncpto.com](http://www.ncpto.com)

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**Middough Consulting**



The Middough Building  
1801 East 13th Street • Cleveland, Ohio 44114  
Phone: (216) 367-6800 • Fax: (216) 367-6820  
[www.middough.com](http://www.middough.com)

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