

CES PROSPECTUS

(ISSN 1077-6192)

Published monthly for members and friends of:

The Cleveland Engineering Society

3100 Chester Avenue

Cleveland, Ohio 44114

(216) 361-3100

Fax: (216) 361-1660

Web site: <http://www.cesnet.org>

3rd Class postage paid at Cleveland, Ohio.

Postmaster: Send address changes to CES address listed above.

| | | |
|----------------|------------|------|
| Subscriptions: | Members | \$18 |
| | Nonmembers | \$28 |

Board of Directors

| | |
|---------------------------|---|
| Executive Director | Debra Mitchell |
| President | David W. Sminchak <i>R.E. Warner & Associates</i> |
| 1st Vice President | Rodger W. McKain <i>McDermott Technology, Inc.</i> |
| 2nd Vice President | Dorothy C. Baunach <i>Cleveland Tomorrow</i> |
| Secretary | Stephen J. Gage <i>CAMP, Inc.</i> |
| Treasurer | Eugene P. Baxendale <i>The Osborn Engineering Company</i> |
| Past President | Stephen A. Di Biase <i>The Lubrizol Corporation</i> |

| | |
|---|---|
| Donald J. Campbell <i>NASA Glenn Research Center</i> | Cyril J. Pontillo <i>Applied Technical Training Systems</i> |
| Dennis D. Crockett <i>The Lincoln Electric Company</i> | Michael Schwartz <i>Cleveland State University</i> |
| Susan Davis* <i>ESA Engineering Services, Inc.</i> | Daniel G. Stanowick <i>Edward Howard & Co.</i> |
| Dennis M. Lafferty <i>Jones, Day, Reavis & Pogue</i> | John J. Verdile <i>The Brewer-Garrett Company</i> |
| Lee J. Penkowski <i>Retired / Rockwell Automation / Reliance Electric</i> | James W. Wagner <i>Case Western Reserve University</i> |

Member Emeritus: **Glenn R. Brown**
The Generation Foundation

* (Ex Officio member)

CES STAFF

| | |
|--|--|
| Debra Mitchell <i>Executive Director</i> | Lisa Keil <i>Office Coordinator</i> |
| David Fearn <i>Membership Manager</i> | LeeAnn Stover <i>Development Associate</i> |
| Jill Kaplan <i>Program Coordinator</i> | |

Prospectus Editor

Shawn Foucher

PROSPECTUS
EDITORIAL



A COLUMN BY THE CES MOT COMMITTEE

The Saga of the Patented Bicycle Rack: Part 4

by Howard M. Cohn

PATENT ATTORNEY

This is the fourth of a four-part story illustrating the basics of the patent process.

The outcome of the meeting between Julie, who is the legal counsel and marketing manager for Millennium Bicycle Company, and Michael Jones, a Patent Attorney, was that Julie and her co-inventor, Rob, would prepare an invention disclosure form. A disclosure form contains a description of the invention including drawings (see www.ncpto.com/form/idf for a sample invention disclosure form). Julie prepared a draft of the disclosure form and sent it to Attorney Jones.

Attorney Jones ordered a preliminary patent search to ensure that someone else had not already patented the same bicycle rack invention. He contacted a professional patent searcher and sent her Julie's draft of the disclosure form.

The patent searcher used the invention disclosure form to guide her search for patents of related inventions. The searcher then examined all the patents within the technology category relating to bicycle racks. She also met with the patent examiner (in Crystal City, Virginia) whose specialty is bicycle rack art, so that the Examiner could guide the searcher to related technology categories that the Examiner might just happen to know contains similar patents. The searcher then sent the results of the search, along with copies of patents of similar bicycle racks, to Attorney Jones.

When Jones studied the related patents, he saw there was a wide range of prior art relating to bike racks spanning over 75 years. Still, the novel invention that originated with Julie, and which was expanded on by Rob, was not found to be covered by other patents, so Jones wrote a patentability opinion recommending that Millennium proceed with a patent application.

Shortly thereafter, Julie called Jones and told him to proceed with the patent application. She explained that Ted, the owner of Millennium Bicycle Company, had just told her that he was showing the bike rack at a sporting equipment trade show being held in Las Vegas the next day.

Jones advised Julie that if the new rack was shown publicly, the Millennium would have one year from that date to file a patent application in the United States, but the company would lose the right to file patent applications in almost all foreign countries. Julie wanted to know if there was there any way to preserve their foreign intellectual property rights, so Jones recommended filing a provisional patent application the very next day based on the information and drawings from the invention disclosure. He explained that a provisional patent application provides a "date of priority" for whatever is the invention it describes.

The next day, Attorney Jones used the patent disclosure document to prepare a provisional patent application which he filed that same day. Provi-

sional patent applications protect the invention's date of priority for one year from the date of filing.

When Ted returned from the trade show, he had a large order for the bike racks. Since the bike racks were being sold, Julie asked Attorney Jones about protecting other intellectual property relating to the bike rack, such as the retro design, that cannot be covered in a regular patent.

Jones suggested that Millennium file a design patent application along with a regular or non-provisional patent application. Design patents, unlike regular utility patents, protect such ideas as the unique appearance of an invention or a unique shape or surface finish of an otherwise old idea. The non-provisional utility patent application would protect the bike rack invention, while the design patent application would protect its ornamental design features. As soon as Julie gave the authorization, Jones prepared and immediately filed both applications with the Patent Office.

Attorney Jones further suggested that Millennium develop a trademark, that is, a word, name or symbol for the bike rack, to indicate that Millennium is the manufacturer of the rack.

Julie met with Ted and Rob and they came up with the name "Rack-it," and sent the name to Jones.

Attorney Jones did a quick trademark search on the U.S. Patent and Trademark Office website and did not find any conflicting trademarks. However, he recommended a more thorough search since the bike rack was showing great promise as a new product line for Millennium. Based on the searches, Jones found that the mark was available for registration. He prepared and filed a trademark application with the U.S. Trademark Office to obtain exclusive rights to the use of the mark throughout the United States.

Within a year or so, a patent examiner from the Patent Office and a trademark attorney from the Trademark Office begin the initial examination of the applications and issue an Office Action setting forth their findings.

The analysis of the Office Actions and preparing and filing a response thereto (called prosecution) is a topic that will be covered in a future article.

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
www.ncpto.com*

© 2002 by Howard Cohn All rights reserved.
CES/patent sagaIV 121102