

Patent Pending Guide

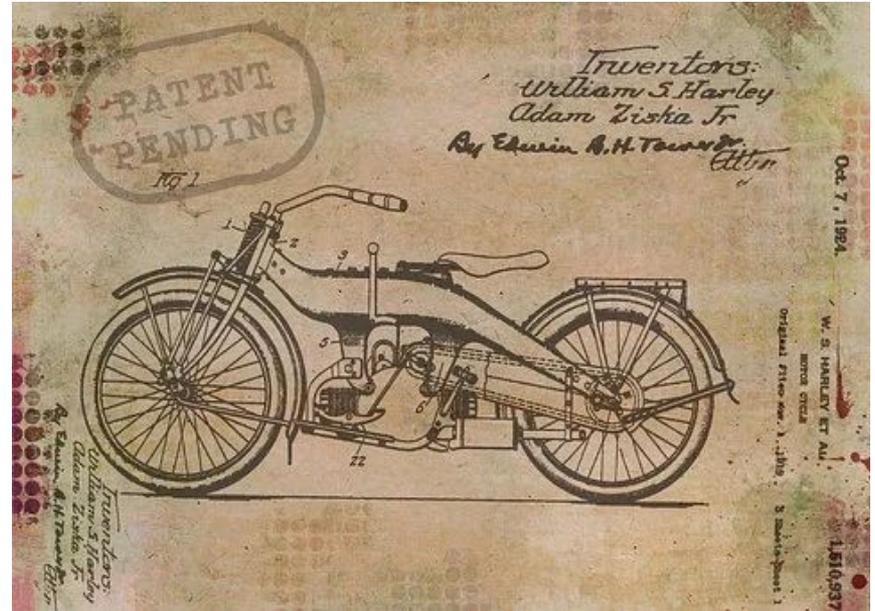
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Congratulations!

Don't forget to Congratulate yourself!!! Job well done, you've locked in your invention and are officially "*Patent Pending*". Congrats!

...I'm serious. Take a break, and celebrate a little!!!

This is the start of something big...



What's Next?

So, you're *patent pending*. Now what? Ok, glad you asked:

- 1) Provisional to Nonprovisional: How can I best prepare?
- 2) Confidentiality: Can I publish/sell my invention now?
- 3) Protection: What does patent pending mean and what rights do I have now?
- 4) Development: Do I need a market-ready prototype?
- 5) Monetization: Can I license or sell a pending patent?
- 6) International Rights: How can I secure patent rights overseas?
- 7) Expediting Process: How can I get my patent granted ASAP?

Provisional (PPA) vs. Nonprovisional (NPA)

- **Know the Diff:** I lay out the key differences between PPA and NPA [HERE](#):
 - Specification: We will rewrite in more detail about the invention at the NPA phase
 - Figures: The drawings will need to be formalized and professional drafted
 - Claims: Your Patent Attorney will focus their effort on carefully drafting the language here
 - Documents: Required documents such as ADS, IDS, Priority Claims, etc must be file
- **Timing:** You have just one (1) year from filing the PPA to file the NPA, no exceptions
 - The Bold Patents team will set up a meeting at the 9 month mark to begin working on the NPA
- **Communicate:** Stay in contact with your Patent Attorney throughout process
- **Document:** Detail all improvements, modifications/changes, or versions, and send them to your patent Attorney to give you advice on how best to incorporate them into the NPA

Confidentiality: Can I publish/sell my invention?

The answer is **YES, but**, be careful. Follow the below points to assure you'll be safe:

- **Limit Disclosure:** Discuss/sell only what was covered in the PPA, otherwise, you stand to begin statutory period on potentially novel improvements/versions of your core invention
- **Use NDAs:** When possible, work with local (State-licensed) attorney to draft a custom nondisclosure agreement (also called confidentiality agreement) to use with 3rd parties when discussing particulars of your invention. They should also draft an IP assignment contract (especially when working with manufacturers/designers/prototypers that may co-invent)
- **Label “Patent Pending”:** This puts customers/users/3rd parties on notice that you have patent rights pending and they better not rip your product off

Protection: What rights/protections do I have?

None. I know... not what you wanted to hear, right? Here are the most important things to know about your *prospective rights* as a patent pending holder:

- **No Legal Right:** Because your rights are “pending” you do not have a legal right to exclude others from making, using, or selling your invention yet
- **Priority Date Locked:** You **DO** have the priority date locked in, meaning any inventor that files an invention like yours after you filed, you will WIN in a priority battle, and the date of invention has been set as your PPA filing date
- **Constructive Notice:** By properly putting 3rd party infringers on notice of your pending rights you may gain additional litigation benefit through treble damages

Check out a podcast on point [HERE](#), or a full-length blog article [HERE](#)

Development: Do I need a Prototype?

No. This was a welcome no, right? Hah! It's true, that a prototype can certainly help many inventors with fully appreciating the utility or the overall functionality, but it is not a requirement to getting a patent. Here are some tips on development:

- **Learn about Design:** Speak with a product designer, who specializes in prototyping, market research, and business planning
 - Get clear on a plan for what it will take to design and manufacture your product
- **Seeking Investment:** 3rd party investors or crowdfunding can be an exciting prospect - be sure to consider all aspects prior to bringing on an investor
- **Business Counsel:** As your company grows, we will introduce you to one of our affiliate business law firms, depending on the city/state you are located in to help with corporate governance, contracts, investors, and state-law matters

Monetization: How do I License or Sell?

The traditional way to make money with a patent is to enforce the claims, and exclude competitors from making, using, or selling your invention and enjoying that limited monopoly. There are however ways to license/sell your invention:

- **Learn about Licensing:** Contact a patent/IP licensing business consultant who can help coach you along the process
- **Know when to License:** The biggest decision about licensing, if you have a willing licensee is whether to license while its pending or after grant, if you can wait until after grant, royalty rates will be higher
- **Portfolios Sell Better:** In my discussions with patent brokers, portfolios of patents sell faster than single patents. So, work with your Bold Patent Attorney to file at least one child patent app. for every parent patent application

International Rights: Patenting outside the US

Does your invention have a market overseas? For most all products, the answer is a resounding YES! It's not always true for systems/methods/processes though, so it will be a case-by-case business decision. Here are the key considerations:

- **PCT:** At the time of filing your NPA, you can file a [Patent Cooperation Treaty \(PCT\)](#) application ([timeline](#)), which will allow you the *ability* to file into [over a 150 member countries](#). There is a parallel for design patents (see *Hague*)
- **Prepare to File:** Your Bold Patent Attorney will prepare the application and be sure to claim priority back to any PPA that was filed
- **Additional Cost/Opportunity:** Along with the opportunity to have rights in several countries around the world, comes the cost to prosecute the patents, acquire them, and most of all *enforce them*. So plan accordingly.