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Bold Ideas: The Inventor's Guide to Patents
2nd Edition

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SMOOTH SAILING

Congratulations! By reading this, you've already taken the first step toward protecting and monetizing your **bold** ideas. As you probably know, there is an absolute sea of information out there about Patents on the internet. Like so many other inquiries made online, the question becomes not whether there is any information on the subject, but "which source of information can I trust?" and "who can I talk to about *my* specific invention?" and even more, "why do I have to pay an attorney $500/hour to get some simple questions answered?"

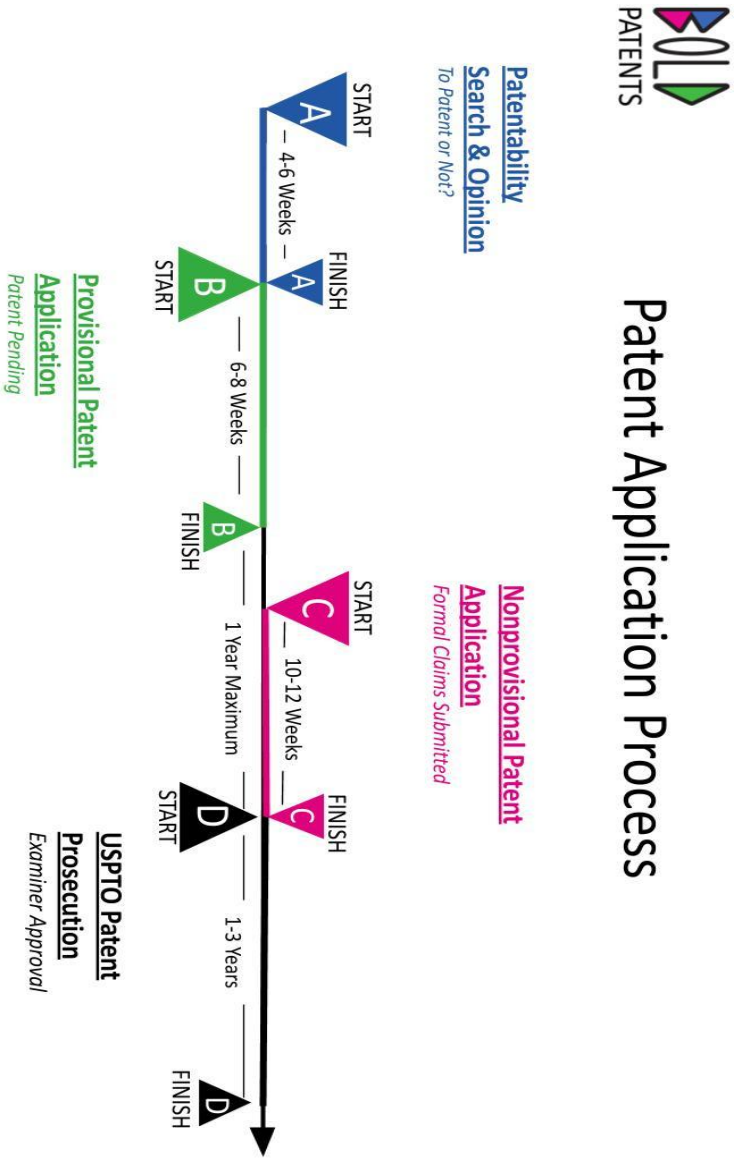
Well, let me take up the last question first. Quite simply, many attorneys justify charging clients for educating them on the patent process. And while I get it, some people are willing to pay that kind of money, the majority are not. And the majority of solo inventors that I have come across in my practice are not either. What this means is that inventors will try to save money by trying to learn on their own before approaching an attorney. They will seek out blogs, online journals, and articles and read through case law or other legal books. Because there is so much misinformation, opinion-based articles, these inventors either become confused or form an incorrect understanding of the law. By the time I get to speak with some of these clients, there is quite a bit of

unraveling, clarifying and de-mystifying what they attempted to learn and do on their own.

I've found that once I'm able to give the client the straightforward answers they've been looking for, calm them down, and show them the process and path forward, it's smooth sailing. Teaching clients is something that comes with the job, but my passion is practicing the law and helping clients navigate their case through the USPTO. This means that the less time I spend teaching them about the basics, the better job I can do.

If a client came in with a clear understanding of the patent process, had clear expectations and knew how they could help, the stronger the potential for both invention and creator. When the client is on the same page as I am in the process, I am able to focus on what counts and they get the most out of my time, so it costs less! It's a true win-win. So, it is my goal that through this book, more inventors *and* attorneys will sail smoothly through their Patenting process.

BOLD PATENT PROCESS



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Section 1

"US Patents: Definitions & Patentability"

Chapter 1

What is a Patent?

A patent is the core legal protection for inventors and their inventions. The purpose of this protection is to provide you with the necessary time and space to make, use and sell his or her invention without the threat of competition. In essence, it is the right to exclude others, for a specified time period, from simultaneously building, using or selling that particular invention in the healthcare marketplace.

In exchange, the government—specifically the United States Patent and Trademark Office or (USPTO), requires that the inventor, using written descriptions, or through pictures, diagrams, figures, and drawings, disclose in intricate detail the precise way to make and use the invention he or she wishes to patent.

The patent office then "tests" the invention using the disclosed instructions and information. They recruit a hypothetical Person of Ordinary Skill in the Art POSTIA for short.

To illustrate, let's say there is an invention currently under review for a medical device for oral surgery. The chosen POSITA would be an oral surgeon. Not a brand new surgeon, nor a board certified one - just an

average oral surgeon. For the invention to qualify, the hypothetical oral surgeon would need to be able to read through that patent application, review the drawings, and know exactly how to go build and put it to use.

As the owner of a US patent, one can exclude others from copying, recreating, or offering to sell their invention in the United States. It's almost as though one were granted a temporary monopoly. Not only is the inventor guaranteed to be the only one legally allowed to use that particular invention—whether publicly or privately—they are also the only one that is able to sell the invention in the United States.

Other Types of Intellectual Property

While the scope of this book focuses on patents, there are actually four (4) main types of Intellectual Property (IP) protection.

1. Patent
2. Trademark
3. Copyright
4. Trade Secret

To better understand patents, we will first need to understand the difference between it and the three other types of IP protection.

Trademark

A trademark is a designation of a good, or service, used to notify a customer (or patient in your case), or potential customer, of precisely what good, or service they can expect to receive when they see that mark associated with its sale or advertisement.

A good example of a famous trademark is the Nike Swoosh. If that mark, the swoosh, appears on an article or clothing or a pair of shoes, for example, that product is immediately recognized as part of the Nike brand.

Trademarks can be powerful symbols in the marketplace, as it both instantly represents the manufacturer (and its reputation) as well as informs the consumer. Therefore, the very essence of trademark law is to help prevent confusion in the marketplace. If someone were to open up a Steakhouse and use two golden arches as part of its logo or on any advertising, the public may erroneously construe that this restaurant might be affiliated with McDonald's Restaurants.

Not that the owners of this Steakhouse necessarily intended to steal McDonald's already built up customer traction, but that it could. If a consumer cannot trust that a logo or mark is legally protected, the less the value of the mark.

Copyright

The tenets of copyright law are designed to protect creative works. "Creative work" is a broad category indeed. This is the artist's domain.

Paintings, drawings, sketches, sculptures, books, be they fiction or nonfiction, and music, are all basic examples of IP that can be protected by a copyright.

To obtain a copyright, however, the work has to be "fixed in a tangible means." In short, it has to be published somehow. If the work is virtual, it could be "fixed" in an MP3 file. It could be a .wav file, or it could be more traditional, such as a film reel, or a VHS tape, cassette, CD, book, etc. This recording or publication and its concomitant rights in the marketplace are then protected by the copyright designation.

Trade Secret

Trade secret law, though enforced under state, rather than federal law, protects any proprietary methods or formulae of a company or an individual that have immediate, economic value to competitors.

For instance, a well-known trade secret is the Coca-Cola recipe. The formula for the popular beverage, how to get its precise flavor, the chemicals used, the mixture, the heats, the treatments, etc. are all protected under a trade secret designation. Even the delivery and packaging can be considered part of a trade secret. Value brands, such as RC or Safeway would love to know Coke's formula. This is an important protection, preventing companies from potentially stealing another's method and undercutting or destroying the value of the company that it was stolen from.

Bright & Bold Dental Office Example

I'll use this example of a fictional dental office called *Bright & Bold Dental* office, to add color and application to each chapter.

So, our little dental office has 4 chairs, one seasoned dentist, Dr. Bright, 4 hygienists and one office manager. Here are the ways they can (and in many cases should) secure intellectual property protection:

- **Patents**: Any new device, system, process or method they use/discover which may be unique in their industry should be explored for patentability and if warranted, file for patent protection

- **Trademark**: Their brand "Bright & Bold Dental Office" should be protected by both state and federal trademark registration so they can secure the name, and not allow similar/same named dental offices use their goodwill/name without permission

- **Copyright**: Any original publications whether in print or electronic should be clearly labeled as "Copyright, Bright & Bold Dental Office All Rights Reserved" to put parties on notice that they own that written work. This would include any informational or demonstrative videos for patients or staff

- **Trade Secrets**: These are any innovative devices, processes, systems, or methods/processes that after patentability analysis, determined that detectability and enforcement would be too challenging, and keeping information confidential is best.