



Patenting inventions in the U.S.

Have you made an invention or developed a product which you would like to profit from? Your invention is your property since you have invested time and money in making it. The invention is therefore worth protecting so that your competitor cannot collect the fruit of your labor.

Protecting inventions can be compared to protecting material property such as factory areas by having fencing, locking building doors or taking out insurance. Patenting is an integral part of corporate strategy. The aim is to protect your company against imitators, increase market share and convince potential investors.

Immaterial rights: one product — many IP rights

Patents

- technical components
- data processing methods
- details of operating system
- user interface functionality
- applications

Trademarks

- company name
- name of product, application or service
- Logo, image
- start-up tone or ringtone



Design rights

- overall design of product
- position and shape of display

Copyright

- software code
- user manual
- music
- images

Trade secrets

- technical solutions and know-how that can be kept secret

Patents protect technical solutions

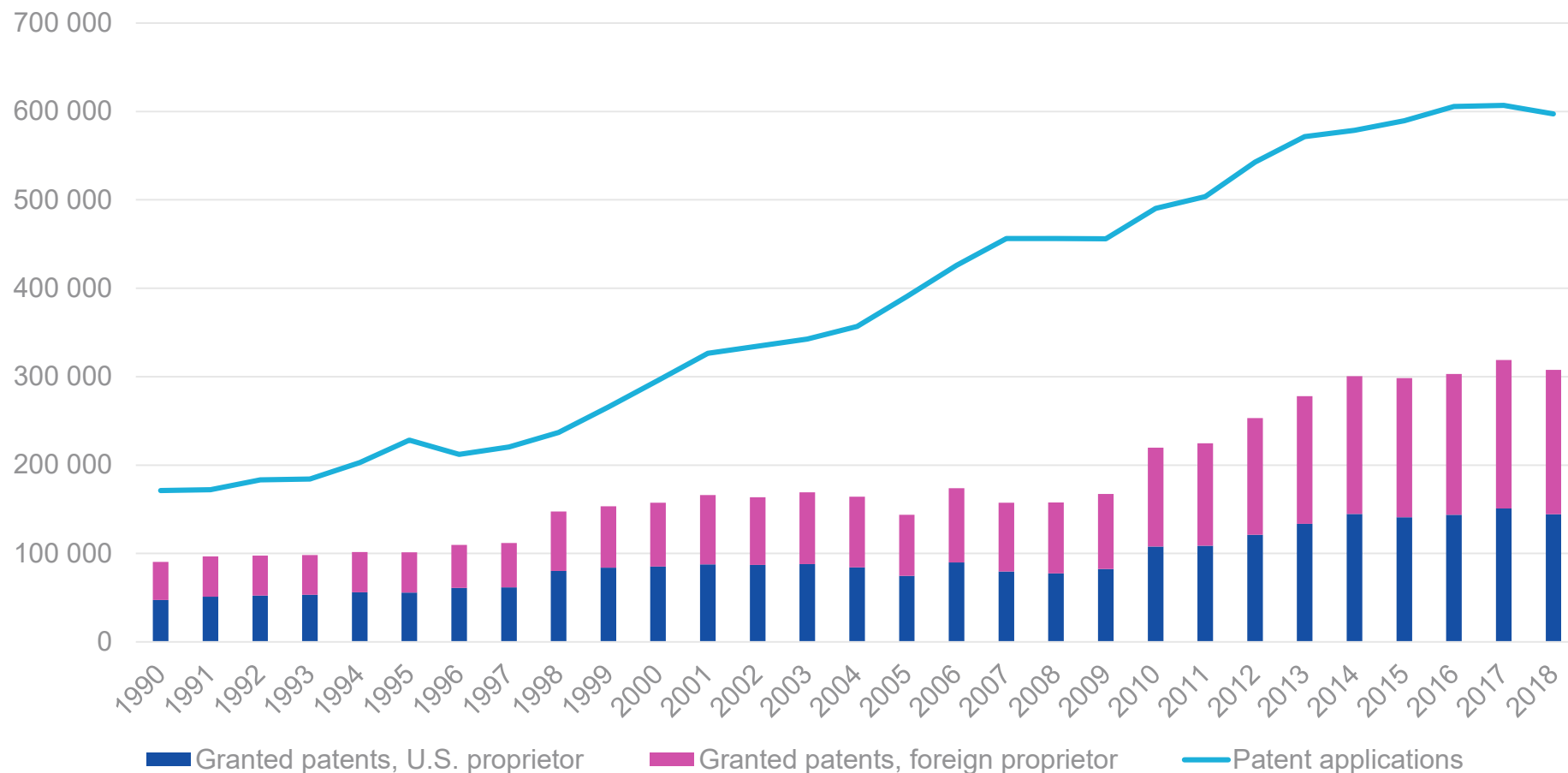
- A patent is a right to exclude others from using an invention professionally.
 - A company must be vigilant in making sure that its patents are not infringed.
- Requirements for getting a patent vary from one country to another. In Europe and the U.S., for instance, the legislations and office practices are different.
- A granted patent remains in force for a limited time – the patent is maintained by paying maintenance fees during its lifetime.
- A patent application is initially secret but it becomes available to the public after 18 months from the filing date.
 - During this time, the patent authority conducts a novelty search on the invention. The search also provides useful information for product development.
 - The application will remain secret if it is abandoned before publication.
- The invention must not be made public before a patent application is filed because the publication will become a bar to patentability – you can disclose the invention in public once you have filed a patent application.

Benefits of patenting

- A patent is an **investment** – it costs money but its owner will benefit from it.
- Patents are part of the **IPR strategy** of companies together with other IP rights such as design rights and trademarks.
- Benefits of patenting:
 - Patents have a positive effect on the market value of the company.
 - Protected products attract investors and promote financing opportunities.
 - Advantage in marketing – active patenting enhances the innovative image of a company.
 - Patents themselves have monetary value.
 - Exclusive rights strengthen the position of a company in business negotiations.
 - Licensing fees can be a significant source of income.

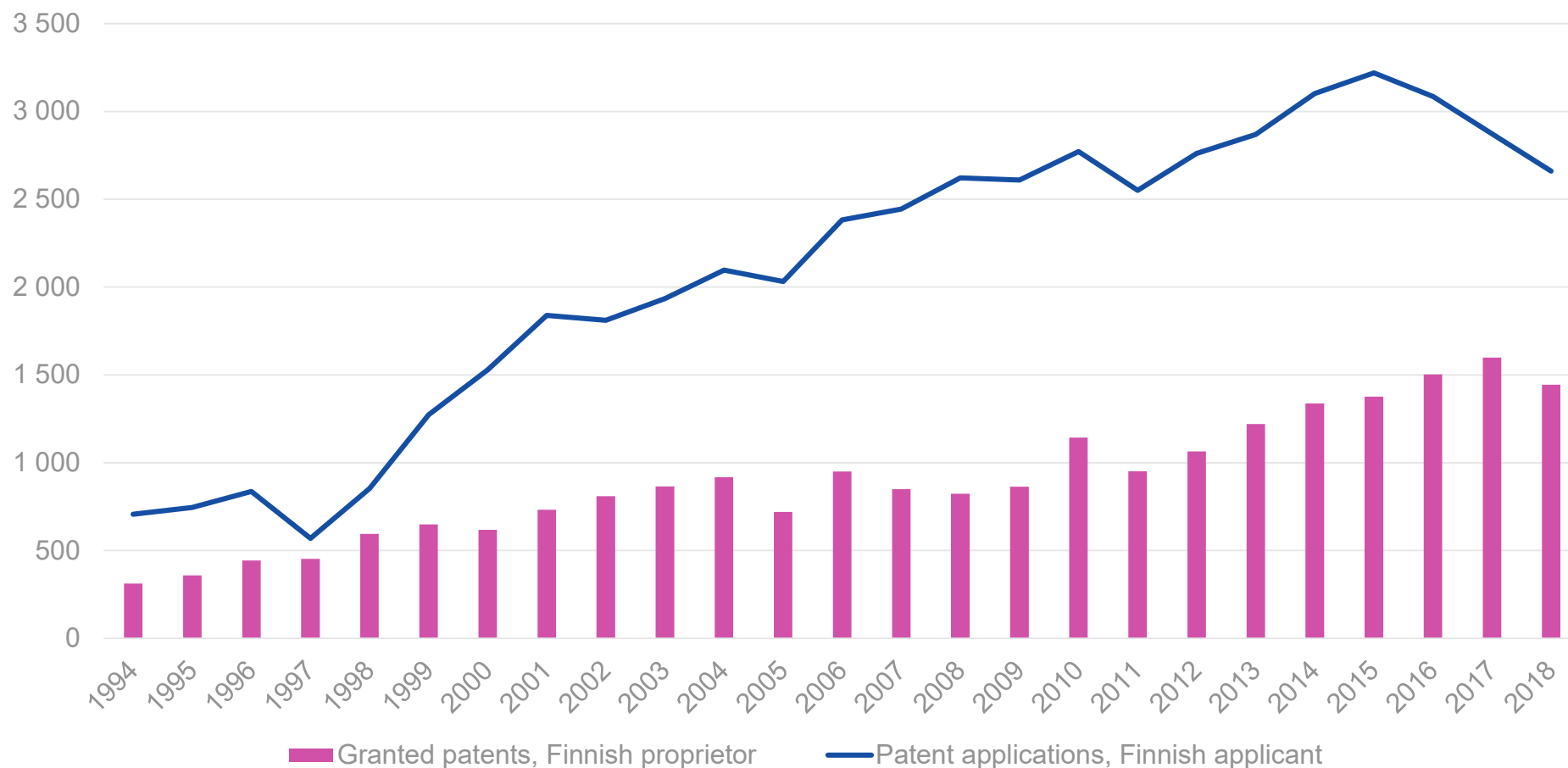
Increasing importance of patenting in the U.S.

Granted patents and patent applications in the U.S.
(Source: WIPO)



Increasing importance of patenting in the U.S. 2

Granted patents and applications in the U.S. for Finnish applicants
(Source: WIPO)



Basics of patenting

- A patent is applied for at a national or regional patent office.
 - The patent is valid in those countries where the patent has been applied for and it has been granted.
 - In Finland, patents are granted by the [Finnish Patent and Registration Office \(PRH\)](#).
 - The European Patent Office (EPO) also has a right to grant [European patents](#) that can be validated in Finland.
 - U.S. patents are granted by the United States Patent and Trademark Office, USPTO
 - The application procedures can be started at PRH even when the aim is to obtain a patent in another jurisdiction.
- Other IP rights:
 - Design right and trademark
 - Finland: Finnish Patent and Registration Office (PRH)
 - EU: European Union Intellectual Property Office, EUIPO
 - U.S.: international registration at WIPO ([design right](#), [trademark](#)) or United States Patent and Trademark Office, USPTO
 - Copyright (legal right to a literary or artistic work) is valid without any application procedures.
 - *in the U.S., it is also possible to register copyright in the [U.S. Copyright Office](#).*

Many paths towards international patenting

- **There is no such a thing as a “global patent”.**
- Alternative ways to apply for a patent in the U.S.:
 - 1) Direct patent application to the USPTO
 - *U.S. Patent and Trademark Office (USPTO) examines the application and eventually either grants a patent or rejects the application*
 - 2) [Patent co-operation treaty \(PCT\)](#): patent application to a PCT authority which examines the application
 - *PRH is a PCT authority; therefore, a Finnish applicant can start the process from PRH.*
 - *Thereafter continuation is possible in the U.S. up to 30 months from the priority date.*
 - 3) [Using priority](#): national Finnish patent application, PRH examines.
 - *After this, possible continuation with a US application or PCT application within 12 months.*
 - *You get information on the likelihood of obtaining a patent in the U.S. before filing at the USPTO – PRH takes into consideration the characteristics of the U.S. patenting system.*
- *A Finnish priority or a PCT application enables a company to postpone a significant part of its patenting costs until later when the value of an eventual patent can be better estimated.*
- *It is possible to expedite the application process in the U.S. with [PPH agreements](#) – ask more from the [PRH Advisory Service](#).*

Granting patents in USA

- Patentability requirements in Europe and in U.S. differ from each other. For example in:
 - What kinds of inventions are patent-eligible at all (therapeutic methods, business methods, for instance)
 - Assessment of inventiveness (inventive step, non-obviousness)
- PRH can provide information on patenting your invention in Europe as well as in the U.S. – you can also start the application process from the PRH
- Significant changes in U.S. patenting practices have taken place during the last few years:
 - U.S. patent law changed in 2013. The new law entitles patent protection to the first inventor who filed a patent application ("first-inventor-to-file").
 - In 2014, the US Supreme Court tightened patentability criteria for inventions related to business methods. The Federal Court of Appeals CAFC and the USPTO have subsequently clarified these criteria. The latest update is from 2019.
 - you can get information on the effects of the changes from the PRH Advisory Service
- U.S. terminology: a "utility patent" is called simply a "patent" in Europe, whereas a "design patent" is a "registered industrial design"

Selecting a patent attorney

- Applying for a patent, managing fees and correspondence, and defending rights is complicated and requires experience
- A patent attorney must understand the applicant's line of business: what kind of a patent would be useful for the client's line of business?
- Selecting a patent attorney
 - European Patent Attorney –title (EQE exam passed and practical experience)
 - How many patent attorneys are at the patent agency?
 - What are the fields of expertise of the attorneys?
 - Co-operation partners in the U.S.
 - Find out from a website or ask directly!
- A list of Finnish patent attorneys and patent agencies is on [the website of The association of Finnish Patent Attorneys](#) or on the [PRH attorney register website](#)
 - Patent agencies might also conduct other IPR-matters such as litigations
 - Also some law firms conduct IPR-litigations

PRH provides services for US patenting

- National proceedings
 - ISO 9001 certified quality system
 - Reliable and fast search and examination
 - *Extensive First Opinion from PRH in less than 8 months*
 - *May take several years to get the First Opinion from USPTO*
 - Easy to co-operate with PRH
 - The assessment is based on the national regulation, but US legislation and practice are also taken into consideration in the opinion
 - Possibility to use English as the process language
 - Possible to fast-track processing and use of the PPH system
 - *Expedited processing also at the USPTO*
- Examination in accordance with the international PCT system
 - ISO 9001-certified quality system
 - Possibility to exploit the PPH-system

PRH provides services for US patenting 2

In addition to patent prosecution, PRH also offers specialized [search services](#) to support product development.

- *Novelty search*
- *Patentability report*
- *Report on the state of the art*
- *Freedom to operate review*
- *Patent validity search*

Advisory services

- Includes international patenting

Training services

- Basic training and training tailored to suit the individual needs of companies

Ask more from the [Patent Advisory Service of PRH](#).

- Novelty searches can also be carried out online (with a screen sharing application).
- All search services are strictly confidential.
- PRH technical experts master a large number of technology areas.

Patenting checklist for the U.S.

- Is your invention novel?
 - Instead of performing a prior art search yourself, you can outsource the search to the PRH, for example.
- Is your invention patent-eligible in the U.S.?
 - Does a patent provide the right type of protection?
- Use a patent attorney familiar with U.S. legislation and USPTO practices
 - A prerequisite for a useful granted patent is a well-drafted application.
- Choose the most suitable path for obtaining a US patent
 - A direct US application, PCT route, or a priority from a Finnish patent application.
- PRH Advisory Service helps you in all patenting matters

Useful links:



Ask for more information from the
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