



BULLETIN

› THE U.S. PATENT PROCESS: FROM FILING THE PATENT APPLICATION TO MAINTAINING AN ISSUED PATENT

Contact Us:

For CU-Boulder and CU-Colorado Springs inventors
Kate Tallman
kate.tallman@colorado.edu
phone: 303-735-1109
fax: 303-492-2128

For CU-Denver/Health Sciences Center inventors
Rick Silva
rick.silva@uchsc.edu
phone: 303-724-0221
fax: 303-724-0816

For information about licensing to start-up companies
Tom Smerdon
tom.smerdon@cu.edu
phone: 303-735-1085
fax: 303-735-3831

For general information and CU System office
David Allen
david.allen@cu.edu
phone: 303-735-3711
fax: 303-735-3831

General Address for correspondence:
CU System Technology Transfer Office
4740 Walnut St., Suite 100
588 SYS
Boulder, CO 80309-0588

Web site:
www.cu.edu/techtransfer

4740 Walnut St., Suite 100
588 SYS

Boulder, CO 80309-0588 **I. FILING A PATENT APPLICATION**

STEP 1-THE PROVISIONAL PATENT APPLICATION

Once a Licensing Officer determines that a certain technology is probably patentable and has a potential commercial market, we hire a patent attorney or patent agent to file a Provisional Patent Application. The Provisional Patent Application need only contain a fully enabling written description of the invention—that is, a description that teaches the invention so that others in the same field would be able to make and use it—and a correct list of inventors. Once the Provisional Patent Application is filed, we have one year to file a Utility Patent Application based on it.

STEP 2-THE UTILITY PATENT APPLICATION

If it commercially feasible to do so, one year after we filed the Provisional Patent Application, we will file a Utility Patent Application.

At this stage, claims must be written that define what the invention is, and the information contained in the Provisional Patent Application must be modified to meet the formal requirements of a Utility Patent Application; the basic elements of a Utility Patent Application are described in the box below.

Further, the inventors must sign a Declaration by which they declare that they are the sole inventors of the invention described in the patent application, that they understand the contents of the patent application, including the claims, and that they

WHY DO WE FILE PROVISIONAL PATENT APPLICATIONS?

By filing a Provisional Patent Application, we receive the benefit of an early filing date and delay the patent prosecution process and its attendant costs by one year. Additionally, because the Provisional Patent Application has fewer formal requirements than a Utility Patent Application—for example, claims do not have to be filed with a Provisional Patent Application—the filing fees are smaller. We, therefore, gain one year to find a commercial partner willing to pay for a full Utility Patent Application and/or foreign patents without sacrificing our patent rights.

have properly declared their residence, mailing address, and citizenship. By signing the Declaration, the inventors also acknowledge their ongoing duty to disclose information that may be relevant to the patentability of the invention, such as published articles or issued patents.

We will also file an Assignment, by which the inventors assign their rights in the patent application to the University.

THE UTILITY PATENT APPLICATION GENERALLY CONTAINS:

1) A title; 2) a statement regarding federally sponsored research or development; 3) a brief description of the background of the invention; 4) a brief summary of the invention; 5) a brief description of any accompanying figures; 6) a detailed description of the invention that is fully enabling; 7) a listing of the claims; 8) an abstract; and 9) figures/drawings.

KNOWLEDGE | INNOVATION | TECHNOLOGY

THE PATENTING PROCESS: FROM FILING THE PATENT APPLICATION TO MAINTAINING AN ISSUED PATENT (CONT.)

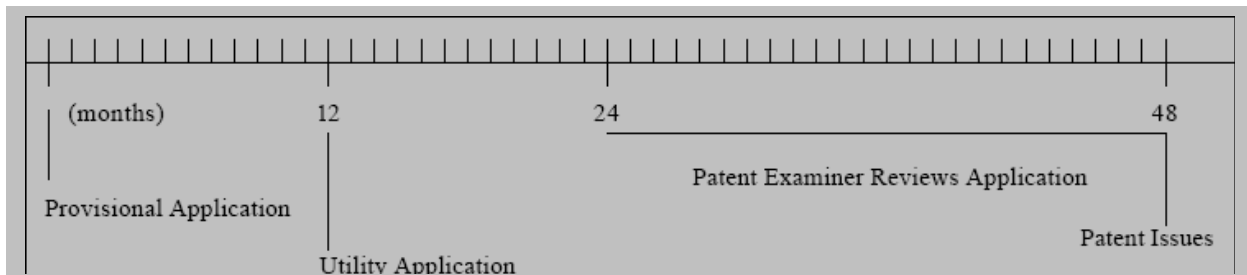
II. PATENT PROSECUTION

After a Utility Patent Application is filed, a Patent Application Serial Number, Filing Date, and a patent Examiner are assigned. Generally one year after the filing date, the Examiner will begin the review process.

First, the Examiner will usually issue a Restriction Requirement, by which the Examiner will separate the different inventions disclosed in the patent application. Only one invention can be examined per patent application. For example, many patent applications will contain a device, a method to make that device, and a method for using that device. These are three separate inventions, and the Examiner will issue a Restriction Requirement that requires us to choose only one invention to prosecute in this patent application. The other inventions can be prosecuted in separate patent applications that can be filed at any time before the first patent application issues and will receive the benefit of the earlier filing date.

During the review process, the Examiner may also issue one or more Office Actions, by which the Examiner substantively reviews the patentability of the application, accepting or rejecting claims based on the novelty, nonobviousness, and enablement requirements. We will file written responses to Office Actions and may even have one or more telephone interviews with the Examiner to argue against the Examiner's rejections and convince the Examiner that the claims describe a novel, nonobvious invention that is fully described in the application. We can also amend the claims to get around the rejections.

Once the Examiner is convinced that the patent application claims a novel, nonobvious invention that the written description fully describes, the Examiner will issue a Notice of Allowance, by which we are given a 3-month deadline to pay the issue fee. Once the issue fee is paid, a patent will issue.



III. PATENT MAINTENANCE

A patent expires twenty years after the filing date of the patent application. However, during the twenty-year period, maintenance fees must be paid to the Patent Office in order to maintain the patent. If a maintenance fee is not paid on time, the patent will be deemed to be abandoned.

A patent maintenance fee is due to be paid 1) 3-1/2 years after the issue date, 2) 7-1/2 years after the issue date, and 3) 11-1/2 years after the issue date. The fee gets larger as the patent gets older.

To download forms: <http://www.cusys.edu/techtransfer/disclose/index.html>

To submit a disclosure, send emails to your campus TTO contacts.