



## Got a Great Idea for an Invention?

### What's Next? Experts Offer Advice on How to Patent an Invention

By Sibylla Nash

Calvin Flowers walked around for years with an idea for a product in his head. In 1999, he had raised enough money to manufacture 10,000 units of his invention, the Security Jack. Within months the Security Jack, a tamper-resistant device that controls phone usage with a key, was in select Walgreen stores in Illinois. By 2001, the chain sold them nationwide.

But a year later, Flowers discovered a giant corporation was mass-producing a cheaper version of his invention. Fortunately, he had a patent.



"Patents are supposed to protect you. It gives you the right to sue," says Flowers, head of Tel-Lock, Inc. and chairman of the Chicago 1st Black Inventors/Entrepreneurs. Because of his patent, Flowers says he was able to force the company to stop production of the Security Jack look alike. He has a lawsuit pending in federal court.

For many inventors, acquiring a patent can be like winning the lottery. According to officials at the United States Patent and Trademark Office (USPTO), they received 355,418 patent applications in 2003, but only issued 189,597 patents. It takes an average of two years for a patent to be issued.

Inventors must follow the USPTO's directions in preparing their application, including detailed sketches or models of their proposed invention. Applications are frequently rejected or sent back for amendments.

"We'd always have to correct them and tell them about the presentations, what to put into the applications, how to follow the prescribed format," says Pat Sluby, former USPTO patent examiner and author of "The Inventive Spirit of African Americans: Patented Ingenuity."

#### Understanding the Legal Terms

Experts say inventors need to first understand the differences in the laws governing patents, trademarks, and copyrights. They are all intellectual property protections.

Patents protect inventions, and improvements to existing inventions. Trademarks include any word, name, symbol, or device used to distinguish the goods of a manufacturer. Copyrights protect literary, artistic, and musical works.

Specifically, patents grant inventors the right to exclude or prevent others from "making, using, offering for sale, or selling" the invention. There are three types of patents: a utility patent, the most common and most expensive, may be granted to anyone who invents or discovers any new and useful product; a design patent may be granted to anyone who invents a new, original, and an ornamental design for an article of manufacture; and a plant patent may be granted to anyone who invents or discovers and asexually reproduces any distinct and new variety of plant.

#### Resources Available

The patent application process is complex, lengthy and costly. But there are many resources available to assist an inventor in the journey from idea to patentable invention.

The United States Patent and Trademark Office should be the first stop in an inventors' journey to secure property rights for a product. The USPTO has Inventors Assistance Centers and an extensive web site that provides advice on issues ranging from how to get help marketing an invention to how to discern what kind of application to file.

Officials with the USPTO recommend that inventors consult with a professional inventors organization, a patent agent or attorney. They maintain a nationwide register of attorneys and



agents who meet their "legal, scientific and technical requirements." However, experts say inventors should be leery of invention promotion and marketing companies.

"Invention promotion firms have the tendency to tell you exactly what you want to hear," says Ruth Nybold, a public affairs specialist with the USPTO. Many promotion companies are unable to fulfill their promise of landing a patent or even making money for the inventor. But Nybold says inventors are protected by the American Inventors Protection Act of 1999. The act requires invention promoters to disclose to a client "in writing" the number of positive and negative evaluations of inventions they have given over a five-year period. It also requires them to disclose their record of success in receiving net financial profit and license agreements.

### Research is Critical

Nothing replaces research. Experts say inventors need to do their homework to make sure an invention is commercially viable.

"Many new inventors believe that a good idea and a patent automatically have a million dollar check attached to it," Nybold says. A patent does not guarantee success, she adds.

Janet Curry, creator of the Digithong, a functional and fashionable cell phone holder, spent months conducting on-line research and subscribing to a variety of newsletters that targeted the wireless industry. She also purchased market research reports to learn more about the industry.

"I did the research to find out if there was a market for it (Digithong)," says Curry, owner of a Los Angeles-based public relations and advertising firm. "I needed to make sure that the accessory market had growth."

Sluby recommends inventors develop a business and marketing plan before getting a patent.

"Do as much background work as you can. You have to know where you are going to go and what the risks are," she says.

In addition to doing research to develop a business and marketing plan, inventors also need to know if someone else already has a patent on their invention.

It's free to search the USPTO's database for patents granted after 1976. To do a search on older patents, an inventor has to visit one of the many patent depositories. Once an inventor applies for a patent, the USPTO will also do a search. If the agency finds similar claims, they will reject the application.

### Filling Out the Application

If an inventor needs time to complete their research and raise money, they can file a Provisional Patent Application (PPA). Experts say it is a cost-saving option inventors can use to obtain "Patent Pending" status.

Fatima Sokera used a PPA while she refined the formula for Takedown, a hair product that helps take out braids, weaves and locks.

"If you got a product that you aren't really sure about, it's good to test it regionally or locally, get the kinks out," says Sokera, an Atlanta-based inventor. "Make the product better before you even go for the patent."

Once you file a PPA, you must file a patent application within one year.

"It's just an early recordation, not a patent," warns David Pressman, a San Francisco patent attorney and author of "Patent It Yourself." He says the PPA does not give the inventor any rights against "infringers." But he says a PPA does give an inventor some advantage over competition.

But former patent examiner Sluby says the claim is the most important part of the application.

"You have to tailor it to a kind of protection where it will disclose what your invention is but not be too broad where other concepts will infringe on it to be novel and different," Sluby adds.

### The Process Can be Expensive

Raising the funds to apply for a patent can be challenging. The filing fee for individual inventors is \$395 and the issue fee is \$685. A patent attorney typically charges between \$2,000 and \$5,000 to prepare an application.

If an inventor decides to hire an attorney, Pressman recommends asking if the attorney is experienced with their type of invention. He recommends inventors find out an attorney's rates in advance and the price for amendments.

Flowers raised money from friends and family. His corporation was born at a backyard barbecue when neighbors and relatives contributed enough money to foot the \$6,000 bill for his utility patent. He says the 34 shareholders of Tel-Lock, Inc. are from the neighborhood Flowers has lived in for over 30 years.

Digithong creator, Curry hired a patent attorney to help her. She has invested \$40,000 in developing the cellular telephone holder. Her patent is pending.

For Chiquita Ashley, inventor of the Look No More Remote, hiring a patent attorney was not an option.

"Lack of finances made me get creative and energetic and do it myself," says the Dalton, Ill. resident. Her invention prevents purchasers from having to ask: Where did I put that remote?

It took three years but Ashley says she was granted a patent because of her persistence. **TP**

### For more information about patents, trademarks and copyright contact:

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