



Do It Yourself Patenting

Brian D. Gildea, MS, JD
Executive Director, IP & Licensing

Do It Yourself Patenting

- Disclaimer:
 - **YOU SHOULD NOT DO IT YOURSELF!**
You should consult and hire a patent professional to prepare and file your patent application. However if you elect to “Do It Yourself” the following is a non-limiting list of important considerations.

The Invention

- Idea/Discovery – Morphs to the Invention
 - New
 - Useful
 - Non-Obvious

The Invention

- Don't waste your time – Know the art
 - Conduct a search
 - PCT Applications (<http://patentscope.wipo.int/search/en/search.jsf>)
 - US Patents & Applications (<http://patft.uspto.gov/>)
 - Google (http://www.google.com/advanced_patent_search)
 - SciFinder (if you have access through your University Library)
- At least identify the low hanging fruit

The Invention

- Write a claim (but don't necessarily include it in your application)
- Don't worry about the claim formalities but structure the claim to describe your invention in terms of what you've invented that is different than what's in the art.

The Invention

- Example:
 - The art describes a red, blue and green widget.
 - New Claim: A yellow widget

The Invention

- Ask yourself why do you want to patent what you believe is patentable?
 - I want a patent!
 - A patent will help support my research!
 - I believe there is a market for my invention that I want to protect!
- Does your reason justify the time and expense?

The Invention

- Examples of Patentable Subject Matter
 - New Compound – Use Required
 - New Use of Existing Compound
 - Method of Producing the Compound
 - Method of Diagnosis
 - Business Method
 - New Instrument or Apparatus

The Provisional Application

- Essential Parts Of A US Provisional Application
 - Provisional Application Cover Sheet
 - Specification (You must draft)
 - Fee (Currently \$ 130 for a small entity & no extra sheets)
- Significantly more is needed for a US Non-provisional Application

The Specification

- Description of the Invention (35 USC 112)
 - Sufficient ‘Written Description’
 - Enable One of Skill in the Art to Practice
 - Demonstrate ‘Possession’ of the Invention
 - Disclose Best Mode to Practice
 - Comply with Duty of Candor To The Office

Contact

- I can be reached at gildeabd@bu.edu