

FREQUENTLY ASKED QUESTIONS ABOUT OBTAINING A US PATENT FROM INDIA

1. What is an US patent?

An US patent gives the applicant the right to exclude others from making, using/copying, offering for sale, or selling the invention in the United States or importing the invention into the United States.

2. How does one obtain an US patent?

By filing an application with the United States Patent and Trademark Office (USPTO).

3. Who can file a patent application for an invention in the USPTO?

Inventors, owners and individuals or organizations with sufficient proprietary interest in the invention can file a patent application for an invention in the USPTO.

4. Do I need a US patent agent to file a patent application at the USPTO?

No, you do not need a US patent agent to file your patent at the USPTO. You can file it *pro se*, that is, by yourself. However, the USPTO strongly recommends that, “all prospective applicants retain the services of a registered patent attorney or patent agent to prepare and prosecute their applications”.

<http://www.uspto.gov/web/offices/dcom/gcounsel/oed.htm> gives a list of registered patent attorneys and agents.

5. What are the main benefits of obtaining the assistance of an US patent agent to represent me before the USPTO?

Time is a scarce resource. You get what you pay for. Even for filing an application at the USPTO and receiving a filing date (the importance of which is described below), there are technical and legal requirements to be met.

A patent is only as good as what is claimed and how it is described in a patent application. A strong patent protection requires good patent application drafting skills. A good patent helps to prevent others from designing around your invention and prevent others from entering the same market space. An experienced patent attorney or agent brings such skills in drafting patent application. In addition, the attorney/agent also helps in prosecuting the application before USPTO. Once an application is examined, the USPTO sends out office actions- official communications to the inventor, and may reject or allow based on the merits of the patent application. The attorney/agent, on behalf of the inventor, can present arguments to meet the legal and technical thresholds set by the USPTO and help in obtaining a patent.

In addition, a customer number associated with a registered US patent agent allows him or her to keep track of your application. The US correspondence address of your patent agent allows USPTO to communicate with him or her instead of the inventors located in India. This in turn allows, the patent agent listed on your application to send you timely reminders and recommended actions that need to be taken to ensure timely prosecution of your application at the USPTO.

6. I am not a US citizen. My invention was made in India. Can I file for patent in the US?

Yes. You can file your patent application in the USPTO. But, a foreign filing license from Indian Patent Office is needed before filing in the US OR the inventor can first file in India and then in the US. A lot of inventors prefer to file in the US as it is the largest economy in the world and provides good patent protection for inventions.

7. How long does it take to file a patent application at the USPTO?

It takes anywhere from one week to more than a month to file a patent application. The main factor that determines the time taken is drafting a patent application, which usually depends on the nature of the invention. Complex inventions, such as inventions in biotechnology and life sciences take around 2-3 weeks to draft good patent application.

8. Who is an inventor in a patent application at the USPTO?

Anyone who has contributed even partly to at least one concept (inventive embodiment) listed in the claims section of a patent application is eligible to be an inventor in a patent application.

9. Can an individual who is not the inventor file a patent application?

Yes. If the person filing the invention has sufficient proprietary interest in the invention, he or she can file a patent application for the same.

10. Are the contents of patent application held in confidence by the patent agent?

Yes. Patent agents are registered with the USPTO and they are required to maintain the confidentiality.

11. Are the contents of patent application held in confidence by the USPTO?

Yes. Patent applications are held in strict confidence until they are published by the USPTO.

12. Is it possible to prevent publication of a patent application by the USPTO?

Yes.

13. Are individual inventors or small businesses from India eligible for discounts for USPTO fees?

Yes. There are micro entity and small entity statuses that can be claimed for applicants from India in order to obtain discounts for several USPTO fees.

14. How much discounts are available at the USPTO for individual inventors or small businesses?

Individual inventors who can claim micro entity status receive a 75% discount for several fees such as filing, examination, maintenance and issue fees among others whereas small entities receive a 50% discount.

15. Who is eligible for a small entity status at the USPTO?

Small entities may claim reduced fees regardless of the country in which they are located. There is no restriction requiring that the person, small business concern, or nonprofit organization be located in the United States. Persons (individuals), non-profit organizations such as Universities and other institutions of higher education are among the categories that can avail small entity discounts.

16. Who is eligible for micro entity discounts at the USPTO?

Among others these are applicants who can claim small entity status and in addition is not an inventor in more than 4 applications at the USPTO, has a gross income of less than 90 lakh rupees (this is slightly variable based in the media annual household income in the US for a particular year and the dollar rupee exchange rate specified by the IRS). Individuals employed by universities or places of higher education and under obligation to assign their inventions to their employer also qualify for micro entity discount.

17. Can I discuss my invention with others before I file a patent application at the USPTO?

Yes. But, you should discuss your invention with others only if they can maintain confidentiality of the information disclosed. If you are not sure, it is better to enter into a non-disclosure agreement between the two parties.

18. What kind of patent applications does the USPTO accept?

USPTO accepts applications for utilities, plants and designs.

19. What is covered in the USPTO under utilities?

New and useful process, machine, manufacture and composition of matter OR any new or useful improvement thereof. Most of the patent applications in science and technology fall under this category.

20. What is covered in the USPTO under designs?

New, original, and ornamental designs for articles of manufacture.

21. What is covered in the USPTO under plants?

Inventions or discoveries of distinct and new varieties of plants. The inventor has to asexually reproduce the plant, even if the plant is propagated by seed naturally.

22. What are the patent terms for utility, plant and design patents?

Design patents have a term of 14 years from the date of filing. Utility and plant patents have a term of 20 years from the date of filing.

23. Can I file a provisional application for my invention?

Yes. If the invention is a utility. You cannot file provisional applications for plants and designs.

25. Once granted, do I have to pay patent maintenance fees at the USPTO for keeping my patent alive?

It depends. You do not have to pay maintenance fees for plants and designs, whereas for utilities you have to pay a maintenance fee.