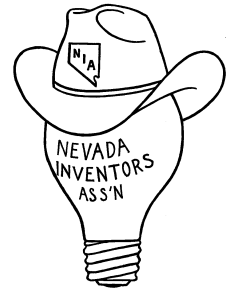


Nevada Inventors Association

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(This is a copy of a letter I sent to another inventor.
The information is pretty generic, so it will help.)

Dear John,

Your wife called this afternoon asking for some help in getting protection for your roof truss idea. This letter is in response to that.

When you have an idea that appears to be marketable, you should reduce it to a description and sketch, called an Invention Disclosure Document. (sample enclosed for guide)

Then as soon as you can, have a witness sign and date it under the phrase “**read and understood by**” ***** on this ***** day of *****, 2005 You must also sign and date it of course, (as inventor) with legible name, address and phone number. Also include the address and phone number of the witness. Everything must be legible, with the names printed below the signatures. A notary won't help because they cannot testify to the content of a document. It's also a stranger to whom you are revealing your idea -- an unnecessary risk.

This witness should be someone who is a friend, **who will not benefit by the success of your product**, is not a relative, and who would be willing to go to civil court and say "yes, that is my signature and that is the day I signed it, and yes, I understood what I was signing, because Joe Inventor explained it to me". Their only motive should be to help you establish a date of disclosure and nothing else. The idea is a reliable witness for an important date. Forget about mailing a certified letter to yourself. It's not reliable in court because the chances of getting someone from the Postal Service to corroborate that document by testimony is just about zip.

Since June 8th, 1995 there has been available a new category of patent application called the “Provisional Patent Application.” Its purpose is to establish an **application date** that is in effect for up to one year before a **complete non-provisional application** is filed with the U.S. Patent and Trademark Office. (PTO) It currently costs \$100.00 to file, **offers no protection**, and is only a means of establishing a date that may be relied upon for an early application date, **but only if no new material is added to the final application**. It does offer a legal “Patent Pending” status though, if immediate litigation, licensing or marketing is critical.

Under current U.S. patent law, the inventor who is “First to Invent”, with a solid paper trail, is awarded the patent as the “true inventor.” The Provisional Patent Application is only one step in that paper trail until, and if, the law is ever changed to “First to File.”

After you have established a date of invention, with your confidential disclosure document, the law then says that you must diligently pursue it to filing a **complete and accepted** patent application. That's called "Reduction to Practice." You can take as long as necessary to do this if you make entries in a log book, or journal, or diary or whatever, as long as it is a bound book of some sort. Book-keeper's ledger books that have numbered pages are OK, but an inventors' logbook is best. (see www.ipbookstore.com on last page)

Your logbook entries should be every time you make a significant change in your invention, or every time you have a relevant piece of evidence of progress, such as a phone bill, a freight bill, an invoice for a purchase, a quotation letter etc. Anything that has a date on it to show that you're dili-

gently pursuing its development to the point of Patent Application. Just make a note in your record explaining each document that you attach to that page.

You haven't waited too long to start your book. You can start anytime by just entering a history of what you have done to date. Start by saying: My invention, which I call the "Vegas Roof Truss" (or whatever) was conceived by me on ____, 2004 (or whenever) and I refined the concept and reduced it to writing and sketch form so I could have it witnessed on ____, 2005 (or whenever). I then. . . . (get the picture?) Just a narrative history of what you have done that shows you have progressed to this date. Fill in the dates as near as you can remember. Be sure and make a few sketches that show any changes, or improvements, if that is true. Photos showing prototype improvements are a good idea. I know this is asking a lot, but you need good documentation or you might wish you had if you're ever in court. Then it will be too late. It's simply developing good record keeping habits.

Now, after you have brought this *introduction* up to date, (this is the important part) sign and date it, and have a witness sign and date it. (Perhaps the same witness who signed your disclosure.) Then every time you make another entry have it witnessed again, on the same page that you sign. Fill in blank areas with diagonal lines so that there are no spaces where one can say you made the entry after it was signed. If you leave a page blank, write on it "blank page."

All this is for a reason: it is leading up to the day you receive a receipt from the Patent and Trademark Office that your application has been received and file numbered. From then on that date is carved in stone. And you will have an ironclad paper trail from the date of invention.

I would suggest that you make an entry in your book at least once every couple of months. Don't let it appear that your project was ever abandoned.

Your wife said that you may be selling this product soon. That's OK, as long as you keep records. The only thing is, *when you offer a product to the public, either by marketing it or offering it for sale, your One Year Time Clock starts*. If you haven't applied for a patent within that year it will become public domain.

Now, your next step after starting the journal is to do a "preliminary patent search." You can do it yourself online or here at the UNR library in Reno, but to go 450 miles from Las Vegas to here and pay 2 or 3 days expenses is going to be more expensive than having a professional searcher do it. Their fees run about \$250 to \$400, and their search may take a week or more.

Because Vegas doesn't have a patent depository library like Reno, your best bet is probably to do an online search or look up a patent search firm and contact them to find out what their fees are. The best search I believe, is the one done by the inventor himself, because he knows his product better than he can communicate it to someone else.

If you do decide to have the search done by someone else, I recommend Ms. Usha Mehta, who is a local Reno searcher.

Her E-mail address is UMEHTA4PS@aol.com Her phone number is 329-2032

Searches may seem expensive at first, but if you can't do your own for some reason they really aren't. The couple hundred dollars you spend is part of the inventing process. Inventing is not cheap. You will have to cough up over \$1,200 for just patent fees alone to the patent office. (\$550 to file, and \$700 to issue) It's exorbitant, but with present PTO administration's policies it is a fact. There's also maintenance fees at 3 1/2, 7 1/2 and 11 1/2 years.

There are always the "idea promotion" scams that can be found in the back of magazines, Radio, and on TV. (800 numbers) They promise marketing "ideas" but it can easily cost you from \$8,000 to \$12,000 and all you'll get is ripped off.

John, I highly recommend that you purchase the book "Patent It Yourself" by David Pressman, latest edition is the tenth. Here in Reno, the Sundance Bookstore on Fourth St, west of Keystone usually stocks it. It's not cheap, it sells for around \$50.00 but it's an excellent investment for any seri-

ous inventor. You will learn a hell of a lot about patent writing by using that book. In case you can not find it, the publisher is NOLO Press, 950 Parker Street, Berkeley, CA 94710. Order it online at a discount at <http://www.nolo.com> or call 1-800-728-3555, to order by phone.

You can file your own Patent Application by using that book as a guide plus the form and text of a similar patent you obtain as a result of your search. You just substitute your words for theirs. It's not plagiarism because government paper is not copyrighted. It's ethical and legal.

But for a first time I recommend you use a patent attorney (Ian Burns comes to mind) for as much of the work that you can afford, like writing the legal "claims." It shouldn't take him more than two or three hours, and if his fees are around \$300 per hour, or so, you have to consider that. But a word of caution -- make sure you discuss it with the lawyer first. Ask him if he will do it, and ask what he estimates his time will be and how much will it cost. If he gets offended, or won't work on that basis, forget it. Find another one. One last word about patent attorneys: they usually charge from \$3,500 to "whatever" to write an application from scratch. Naturally it depends on the attorney and on the complexity of the device to be covered, but you will get a better patent application, obviously. Drawing fees, as a rule, are extra. NOLO Press also has an excellent book on doing your own patent drawings. The patent office will accept drawings from a printer or a copier because they are in permanent form. They may insist however on submission of drawings on 67 lb. "Bristol" paper so it will stand up in the file. With electronic filing, which the PTO encourages, that is not necessary.

It also greatly depends on the amount of work the inventor is willing to do by himself. If you hire your own searcher, for example, you might spend \$250. If you tell an attorney to do it, figure another \$250 at least for him to have the same guy do the same work. (get the picture ?) Don't ever be afraid to ask how much is it going to cost you. (after he sees what is involved, of course) But remember this: ***Whatever you hire someone else to do for you, is something you will never learn to do for yourself.*** "When I first got into it I didn't know my butt from my shoulder about any of it. Fortunately I didn't fall into the "product development scam" trap. I bought Pressman's book instead. Now I have written two patent applications by myself and received what I believe to be two good patents because of it.

Beginning in 2003 there are software available to inventors for writing patent applications. This is great news for inventors who do not have the funds to hire an attorney at all. The names of the software are "Patent Wizard" for provisional applications, plus "PatentEase" and "PatentPro" for complete applications. Current costs are around \$300 to \$350, with the provisional application software about \$200. Discounts are available by ordering from the "Inventors' Digest" magazine. (see end of letter for URL's)

I do feel that you should establish early on a trade name, logo, or product name and establish a Trademark. It doesn't cost anything to put a superscript "TM" behind your logo or product name. That's a notice to the world that you intend to register it. Once you register it with the PTO you can then place the R in a circle after your logo. Currently it will cost \$335, but you can't do it anyway until you've marketed the product in interstate commerce.

If at all possible, a prototype that works is a must! Not because anyone requires it, but to prove to yourself it works, plus as you are making the prototype you'll be amazed at how many ideas you get about making it simpler, or better, or different. I'm assuming you aren't reinventing a diesel engine or locomotive, of course.

Keep in mind that if you are employed, and do any work on your prototype, drawings or notebook at your place of work, or use any of your employer's tools, resources or time, you probably will be obligated legally to turn over the title of your patent to your employer. I'm not aware of any legal precedent that would be a guideline for what belongs to an employer and what belongs to an

employee in the absence of a contract, but common sense dictates that if you invent something relevant to your employer's business, then he could logically claim you learned the technology on his time and with his facilities.

It would seem that there are obvious elements in an employment relationship that would determine who owns what, but in the event of a potential lawsuit it would be wise to approach your employer early on and establish what you can and cannot patent on your own. Sometimes an offer to share licensing royalties if the employer pays the fees and costs would be the best course to follow.

That's about all I can think of for now. Good Luck!! Make a mint!

Don Costar,



P.S. Before you get any further into inventing, call up the "Inventors' Digest" magazine and order a subscription. It's a "must have" magazine for inventors and costs \$27.00 a year. 1-800-838-8808.

Or, order it online at <http://www.inventorsdigest.com> One of its best features is an archive of past articles, one of which may be similar to your product, or marketing needs. They are about \$2.00 each.

Also, that's where you can review names and numbers for patent searchers, patent attorneys, prototype makers, marketers, etc. The information in the magazine is reliable and the advertisers are usually qualified as to their honesty and integrity. Naturally the publisher can't guarantee them 100%, but she tries not to let any bad guys slip by.

Some helpful internet addresses, and that have links to resource information:

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| Inventors' Digest Magazine | www.inventorsdigest.com |
| United Inventors Ass'n of USA | www.uiausa.org |
| US Patent Office home page | www.uspto.gov |
| Patent database searching | www.uspto.gov/go/pats |
| Trademark database searching | www.uspto.gov/go/tm |
| Academy of Applied Sciences | www.aas-world.org |
| Lemelson -- MIT programs | web.mit.edu/invent/www/links.html |
| Provisional Patent Applications | www.PatentWizard.com |
| PatentEase Application software | www.inventorprise.com |
| PatentPro Application software | www.patentpro.us |
| Patent Cafe bookstore | www.ipbookstore.com |
| Nolo Press -- inventor's books | www.nolo.com |
| General Inventor Information | inventors.about.com/ |