

# Innovators' Guide

Steps and Resources to Help You with  
the Innovation Process

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**Originated in 1998 by:**



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## GREETINGS

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### **Do you have an innovative concept or product? Are you trying to achieve commercial success for it?**

Montana state service providers get many requests for assistance from independent inventors and small businesses with new concepts they hope will succeed in the marketplace. Service resources are very limited and each organization can provide assistance only in their area of primary focus.

Therefore, before you can expect others to invest time or money in your concept, it is critically important that you take steps to:

- protect and develop your concept or product
- educate yourself about the innovation process
- learn if your innovation is feasible to achieve sales in the proposed market

This simple Innovators' Guide is in no way comprehensive, and you will want to dig more deeply into the resources referenced. Please understand clearly that Montana service organizations are NOT in the business of helping companies to find investors. At times, they can connect you to financial opportunities; however, be prepared – the application processes are highly competitive and require excellent writing skills.

Yours may well be among the small percentage of ideas that become successful. Or, your inventing may be nothing more than a fun and satisfying hobby. In either case, the information provided here will guide you in critical steps of innovation and commercialization.

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## CONFIDENTIALITY

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***It is important you don't share details about your invention publicly before your patent is filed.*** This isn't just to prevent someone from stealing your idea. When you "disclose" your invention, or make it "public," it starts a grace period in which you have one year to file a patent application, or you lose your right to monopolize the idea. Making an invention public might be something obvious like telling a crowd of friends at the coffee shop how to build and use your product or describing these details in your blog. Or, it might be less obvious like making a prototype and using it for your work on a commercial job.

At times, it is necessary to discuss details of the invention in order to market it or advance the development process. In those situations, ask the other party to sign a Confidentiality Agreement (also known as a Non-Disclosure Agreement). You can find sample agreements by searching online or by requesting a template from your patent attorney (a patent agent may not provide you with legal agreements).

The best behavior is to share the 'enabling' details (those details that would allow someone moderately skilled in the field to practice your invention) ONLY with those parties who absolutely must have that information to interact with you. It is not necessary to reveal enabling details in order to provide significant information to another party. Non-confidential information can include the type of product, the problem to be solved, the industry and market sectors, and the benefits of your invention.

Take efforts to learn how to talk about your invention non-confidentially while keeping patentable information to yourself until the patent is filed. Develop a simple one-page technology brief or 'sell sheet' to identify what you can reveal non-confidentially. It should state the problem being solved and the benefits of your invention solution. Add a graphic that will allow the reader to quickly understand your field of interest without seeing your invention, and don't forget to include your name and contact information. In addition to disciplining yourself in how to speak about your innovation, this print piece will allow you to rapidly introduce your concept to service providers and others. More information on "Telling Your Innovation" can be viewed in a short MTIP presentation on YouTube: <http://youtu.be/FxwF-6lFwSc>.

## INVENTION RECORDS

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***If you ever expect to make money from your innovation, you need to think and act like a business person.*** Keep good files and records on all of your invention development efforts.

In March 2013, the United States joined most other countries in giving credit for an invention to the first inventor filing a patent on it. This changed the importance of maintaining an invention logbook from earlier times when inventorship was based on documentation of being the first-to-invent. Nonetheless, your cumulative logbook or journal can be an important augmentation to memory when filing and prosecuting your patent. It should include all the details of your invention reduction to practice which is an essential requirement of patenting and which can be valuable in a patent interference proceeding. An invention log contains notes describing the development of your invention, including sketches, changes, test results, observations, materials used – everything! Future collaborators, investors, and licensing interests also may benefit from the insight into your invention development process.

Other vital records include a master file of all Confidentiality Agreements you execute, material supply records and correspondence, as well as good documentation of contacts you make and what information is provided to each. This recordkeeping ensures impeccable follow-up with prospective licensees and others. It also will permit you to follow through if confidentiality provisions have been violated.

## INVENTION EVALUATION

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***It is highly recommended that you collect abundant information before incurring the costs of prototyping, patenting, and marketing your innovation.*** It is critical that you make every effort to evaluate the feasibility of your invention from many different perspectives.

Your invention evaluation process should examine the following variables:

- Legality
- Safety
- Impact on society
- Performance
- Profitability
- Market demand
- Size of market
- Product-line potential
- Manufacturing feasibility
- Distribution channels
- Competition and bordering products
- Competitive advantages and disadvantages
- Consumer appeal
- Licensing potential
- Major barriers toward market or manufacturer acceptance

Be aware that the results you get from evaluations by service providers are only as good as the input you provide. If you don't have a strong basis for an answer, collect more information before requesting feedback. You are likely to invest vast quantities of personal time and thousands of dollars in your invention. Therefore, it is vital that you approach the process knowledgeably and with high-quality outside feedback. A simple, self-administered evaluation test can be found at:

[www.uspatentlaw.com/evaluation.htm](http://www.uspatentlaw.com/evaluation.htm), and following are details about two university-based innovation assessment services that can provide an objective third-party evaluation of your invention. This is not an endorsement of these services but their online information will help you to determine if they can add value to your own assessment efforts.

## WASHINGTON STATE UNIVERSITY INNOVATION ASSESSMENT CENTER

*Transforming ideas into products; shaping products into opportunities. The Washington State University Innovation Assessment Center (IAC) has provided evaluation services to individuals and small businesses throughout the world. An IAC early stage market assessment will help you decide about making additional investments in your idea, making changes in your product to improve marketability, or whether to invest in a different idea.*



IAC staff will give its genuine opinion on how it sees your innovation fitting into future markets. The entire team is bound by non-disclosure agreements, and the Center's third party independence from the project enables a critical and honest assessment. The evaluation costs \$795 and is completed within 6 weeks. It includes Market Research, Review of the Competitive Environment, a Keyword Patent Search, Marketing How-To information, and a Product Review by evaluators in your field of interest.

The IAC can be accessed by calling (509)358-7897, and an application can be submitted online through the IAC website: <http://edacenter.wsu.edu/innovation>.

## UNIVERSITY OF WISCONSIN INNOVATION SERVICE CENTER

*The Wisconsin Innovation Service Center (WISC) helps manufacturing clients from across the U.S. with new product and market decisions. WISC provides market research assessments for B2B companies and inventors, innovative manufacturers, and technology businesses looking to develop a new product or expand their market share.*



WISC helps clients make informed decisions by providing qualitative research on market opportunities, customers and competition. Inventors can see the feasibility of a new product idea, identify licensing partners, and solve manufacturing and distribution challenges. Business owners gain a competitive advantage through primary research results, helping them to grow and improve their companies.

WISC charges an \$995 flat fee for a New Product Development Assessment which includes Competition Review, User Need Estimates, Trend Reports, and a Technical Feasibility review. Time required in 6 to 9 weeks. Sample reports can be viewed at the WISC website: [www.wisconsinsbdc.org/wisc](http://www.wisconsinsbdc.org/wisc) and you can contact the program at (262) 472-1365 or [innovate@uww.edu](mailto:innovate@uww.edu).

## PATENTING BASICS

**A patent is granted by the government and given only to the inventor or discoverer of a new and useful process, machine, article of manufacture, or composition of matter.** Each patent grants the owner a monopoly on one invention, with rights to exclude all others from making, using, selling or offering for sale the invention for approximately 20 years from the date of the patent application.

To be patentable, an invention must be:

- Novel (not previously known or described in public disclosure, e.g. a publication);
- Useful (incorporates a useful purpose and is not frivolous or immoral); and
- Non-obvious (not obvious to a person with ordinary skill in the relevant area of knowledge)

The invention must be set forth in all the detail that would allow it to be duplicated by a person with ordinary skill in that field. A patent will not be granted if (among other things) the invention was already patented, if it was described in a printed publication anywhere else in the world, if the invention was made available for public use or sale in the U.S. prior to the 12 months before filing, or if the inventor's application for a patent in another country was granted before the filing date of the U.S. application. A patent cannot be obtained on an abstract idea, a law of nature, or a natural phenomenon.

A preliminary patentability search is important to determining whether an invention is novel and to aid you and your patent counsel in drafting the patent application. The government thoroughly examines for patentability. Present backlogs in the U.S. Patent and Trademark Office (USPTO) may prevent examination of a new patent application for 24 to 30 months. Therefore, it may take several years before a patent is issued.

A Provisional Patent Application (PPA) allows an inventor to claim "patent pending" status for the invention for 12 months, and can involve less work and cost than a Regular Patent Application (also referenced as a Non-Provisional Patent Application). A PPA allows the inventor a year to further develop and market the invention under a patent-pending status. Before the end of the year, the U.S. Regular Patent Application must be filed to continue the uninterrupted first-to-file patent rights on whatever you disclosed in the PPA filing.

The U.S. Patent & Trademark Office (USPTO) has an excellent resource section for inventors and entrepreneurs: [www.uspto.gov/inventors](http://www.uspto.gov/inventors). General information may be requested by calling the USPTO at (800) 786-9199.

## OBTAINING A PATENT

*The World Intellectual Property Organization distributes a FREE handbook about the patenting process. "Inventing the Future" is written in easy-to-read language and is at: [www.wipo.int/freepublications/en/sme/917/wipo\\_pub\\_917.pdf](http://www.wipo.int/freepublications/en/sme/917/wipo_pub_917.pdf).*

Following are the typical steps in pursuing a patent:

1. Look for similar products in stores and on the Internet to develop an understanding of the market opportunity or need for your invention.
2. Review publications, articles, and technical literature to find out how the problem you have identified is currently being solved. Become knowledgeable about the problem and the estimated costs of your solution as opposed to those already available.
3. Do an initial search online at [www.uspto.gov/patft/index.html](http://www.uspto.gov/patft/index.html), by going to a Patent Depository Library (one is located in Butte, MT), or by hiring a qualified search agent (most easily located through a patent attorney or agent). A preliminary approach to patent searching is described in an article on MTIP's website: [www.mtip.mt.gov/docs/PreliminaryApproachToPatentSearching.pdf](http://www.mtip.mt.gov/docs/PreliminaryApproachToPatentSearching.pdf).
4. Arrange a first consultation with a patent attorney or a patent agent qualified in your field of inventing and with whom you can communicate well. This individual must be registered with the USPTO, which you can verify by searching at <https://oedci.uspto.gov/OEDCI/>.

5. Clearly understand the costs and expectations of patent counsel before deciding on a patent strategy and making a deposit for services.
6. Prepare an invention disclosure and patent application interactively with patent counsel.
7. Cooperate with your patent counsel on a professional patent search (if needed), forms completion, and the creation of patent-ready illustrations.
8. File the application – getting a patent application number makes your invention “patent pending.”
9. Work with your patent counsel to respond to the patent examiner’s ‘Office Action’ in which your claims are allowed, disallowed, or challenged.
10. Be patient - today’s patent process moves slowly and may require two years or more before an examiner looks at your application. There may be more than one Office Action until the patent is in a form that can be allowed for issuance.

## MONTANA REFERENCES

### THE LIBRARY AT MONTANA TECH



The library at the Montana College of Mineral Science and Technology (Montana Tech) in Butte is a U.S. Patent Depository Library. Through it, you can access descriptions of over four million U.S. patents and gain easy access to full patents back to 1959. Reference personnel at the library will help you initiate a search to find out if an invention is unique. However, you should be prepared to spend many hours, perhaps a couple days, reviewing descriptions in the related categories. This effort may save hundreds of dollars. For more information, call the library at (406) 496-4281 or visit it online at <http://libguides.mtech.edu/patents-guide>.

### THE LIBRARY AT MONTANA STATE UNIVERSITY-BOZEMAN



Reference personnel at Renne Library, MSU-Bozeman will help you initiate a patent search. Library personnel also have search access to over 450 electronic databases, including patent databases, as well as access to other commercial online systems. For more search information, call (406) 994-3171 or look online at: [www.lib.montana.edu/services/index.html](http://www.lib.montana.edu/services/index.html). Handouts that explain the service and fees are available at the library.



### THE LIBRARY AT UNIVERSITY OF MONTANA, MISSOULA

The Maureen and Mike Mansfield Library offers patent-search features similar to those at MSU-Bozeman. This library also carries the Official Gazette, which contains abstracts of patents. For more information contact the Document Division at (406) 243-6866 or (800)240-4939, or online at [www.lib.umn.edu](http://www.lib.umn.edu).

## PAMPHLETS & BOOKS

The following are valuable self-help reference guides that can be ordered from Nolo Press, Berkeley, CA, at (800)728-3555 or online at [www.nolo.com/products/intellectual-property/patent-books](http://www.nolo.com/products/intellectual-property/patent-books).

*Patent Searching Made Easy* by David Hitchcock  
How to do patent searches on the Internet and in the library.

*Nolo's Patents for Beginners* by Nolo Press  
A basic reference primer for first time inventors.

*Patent Savvy for Managers* by Kirk Teska  
How to spot and protect your company's innovations.



*Patent It Yourself* by David Pressman

Understanding the invention process including how to get started, maintaining an invention log, the forms and instructions necessary to patent your invention in the U.S., marketing your invention, attracting investors, and more.

*Patent Pending in 24 Hours* by Richard Stim and David Pressman

The forms and basic information for filing a U.S. provisional patent application.

*Profit from Your Idea* by Richard Stim

Practical marketing advice and the legal language necessary to making smart licensing decisions.

## ONLINE RESOURCES

### INTELLECTUAL PROPERTY

U.S. Copyright Office	<a href="http://www.copyright.gov">www.copyright.gov</a>
World International Patent Organization	<a href="http://www.wipo.org">www.wipo.org</a>
U.S. Patent & Trademark Office	<a href="http://www.uspto.gov">www.uspto.gov</a>

### INVENTOR ORGANIZATIONS

United Inventor's Association of America	<a href="http://www.uiausa.org">www.uiausa.org</a>
American Society of Inventors	<a href="http://www.americaninventor.org">www.americaninventor.org</a>

### OTHER INVENTOR INFORMATION

Inventor's Digest - the only U.S. inventors magazine	<a href="http://www.inventorsdigest.com">www.inventorsdigest.com</a>	Subscriptions: (800) 838-8808
License Marketing Firms (Good Guys™)	<a href="http://www.inventorfraud.com">www.inventorfraud.com</a>	
Invention Disclosure	<a href="http://www.webpatent.com">www.webpatent.com</a>	
Invention Promotion Industry	<a href="http://www.uspto.gov/web/offices/com/iip/complaints.htm">www.uspto.gov/web/offices/com/iip/complaints.htm</a>	
Federal Trade Commission - fraud	<a href="http://www.ftc.gov/bcp/edu/pubs/consumer/products/pro21.shtm">www.ftc.gov/bcp/edu/pubs/consumer/products/pro21.shtm</a>	

### MONTANA TECHNOLOGY INNOVATION PARTNERSHIP (MTIP)

MTIP provides free counseling from consultants knowledgeable and well-experienced with the process of moving innovation into the marketplace. MTIP's program staff and consultants will help you determine the needs of the company and assist by offering technical assistance to guide you through the innovation process. For more information visit [www.MTIP.mt.gov](http://www.MTIP.mt.gov), or email [DoCMTIP@mt.gov](mailto:DoCMTIP@mt.gov).



### SMALL BUSINESS DEVELOPMENT CENTER NETWORK

The Montana Small Business Development Center network supports ten centers around the state, focusing on counseling in areas such as financial analysis, business planning, training and workshops and loan packaging assistance to help small businesses achieve their goals of growth, expansion, innovation and success. Call (406) 841-2747 or visit the network website at: [www.sbdc.mt.gov](http://www.sbdc.mt.gov) to find the center nearest to you.



## MONTANA PATENT COUNSEL

*Patent attorneys and patent agents have both taken and passed the rigorous examination for registration before the USPTO, and both may have similar technical education. The difference between patent attorneys and patent agents relates to their capacity to practice law. Patent agents can be very capable of preparing excellent patents. However, only a lawyer can provide legal advice, draft contracts or non-disclosure agreements, or represent you in legal proceedings involving state or Federal court.*

The following patent attorneys and agents are public practitioners registered by the USPTO for the State of Montana in 2016. The indication they are accepting new clients may not have been updated on their USPTO registration.

Last Name	First Name	Phone Number	City	Postal Code	Status	Accepting New Clients
Atkinson	Christopher	(573) 446-8219	Columbia	65203	AGENT	YES
Avniel	Yuval	(406) 550-4647	Missoula	59802	AGENT	YES
Bohn	Craig	(406) 751-6304	Kalispell	59901	ATTORNEY	YES
Coleman	Shane	(406) 252-2166	Billings	59101	ATTORNEY	YES
Conover	Richard	(406) 587-4240	Bozeman	59771	ATTORNEY	YES
Couturier	Shelley		Hamilton	59840	AGENT	YES
Davis	James	(314) 694-1000	St. Louis	63167	ATTORNEY	YES
Egan	William	(925) 788-2173	Augusta	59410	ATTORNEY	YES
Elpel	Jeanne	(406) 490-1951	Silver Star	59751	ATTORNEY	YES

Griebenow	Lori	(406) 438-5832	Helena	59624	AGENT	YES
Guenther	Jerry	(360) 801-3287	Helena	59601	ATTORNEY	NO
Haffey	John	(406) 493-1617	Missoula	59806	ATTORNEY	YES
Hunter	Robert	(406) 581-2234	Bozeman	59715	AGENT	NO
Kakuk	Michael	(406) 594-0515	Helena	59601	ATTORNEY	YES
Kelson	Robin	(406) 471-3284	Whitefish	59937	AGENT	YES
Kullick	Ronald	(406) 360-6098	Hamilton	59840	ATTORNEY	YES
Kyle	Jean	(406) 375-1317	Hamilton	59840	ATTORNEY	YES
MacBride	William	(406) 202-5839	Bozeman	59715	ATTORNEY	YES
Marr	Merry	(406) 531-1789	Billings	59102	ATTORNEY	YES
McGinnis	Robert	(406) 522-9355	Bozeman	59715	AGENT	YES
Mondul	Donald	(406) 210-0252	Seeley Lake	59868-1203	ATTORNEY	YES
Penton	Joel	(504) 251-3039	Whitefish	59937	ATTORNEY	YES

Peterson	Kevin	(406) 444-5785	Helena	59620-1601	ATTORNEY	YES
Rhoades	Sarah	(406) 721-2729	Missoula	59802	ATTORNEY	YES
Sako	Katie	(406) 226-4699	East Glacier	59434	ATTORNEY	YES
Scott	Zachary	(406) 203-2159	Missoula	59802	ATTORNEY	YES
Smith	Charles	(406) 497-1200	Butte	59702	ATTORNEY	YES
Sullivan	Katherine	(406) 493-1654	Missoula	59802-4914	ATTORNEY	
Tease	Antoinette	(406) 591-3689	Billings	59105	ATTORNEY	YES
Van Tricht	Paul	(406) 259-7631	Billings	59101	ATTORNEY	YES
Vap	Mitchell	(406) 721-7880	Missoula	59807	ATTORNEY	YES
Wylie	Paul	(406) 585-7344	Bozeman	59715	ATTORNEY	YES