

Patent Basics

What is the purpose of patent?

- Federal government grants a patent to an invention for a limited period of time in exchange for public disclosure of the invention

Incentive:

invention owner gains control of the exploitation of the invention
<in exchange for>
expanding the common knowledge of the public in relation to that invention

Rights gained:

right to exclude others from making, using, selling, or importing the invention described and claimed in the patent

- in US, only federal government grants the right, no basis in state law
- each country grants patents
- no international patents although

Classes of patents:

- **utility patents** - “any new and useful process, machine, manufacture, or composition of matter, or any improvement thereof.” 35 USC sec 101
- **design patents** – ornamental design of article of manufacture
- **plant varieties**

Term:

utility and plant patents - maximum of 20 years from date of application filing with US Patent and Trademark Office

design patents - maximum of 15 years from date of issuance

Utility Patent Requirements:

- statutory: processes, machines, articles of manufacture, or articles of composition
- new
- useful
- non-obvious

Specification Requirements:

- true inventor named
- application must completely describe the invention to point of “enablement” of creation and use ... cannot hide any key aspects
- must disclose the “best mode” of the invention
- “claims” identify breadth and coverage of subject matter

- application is a fairly complex document that consists of a mix of technical and legal characteristics
- aside from direct filings by original inventors, only individuals registered to practice before the PTO are entitled to represent owners in the prosecution of patent applications
- must be filed in the name of the human inventor but invention may be assigned

One year deadline for filing. Triggered by:

- a) a public use or display of the invention
- b) a publicly available document describing the invention
- c) the sale, or offering for sale, of the invention, or
- d) an oral description of the invention presented in a public forum

In most nations, no public disclosure allowed prior to the filing.

Under certain patent conventions, possible to rely on a US patent filing date as the filing date in many other countries

Once application filed with the PTO, has “patent pending” status

Examiner at the PTO reviews the application and “prior art”

- in most instances, examiner initially “rejects” the application based on the alleged teachings of prior art references deemed relevant by the examiner
- applicant permitted to respond by (1) modifying the scope of the invention and/or (2) addressing prior art arguments
- assuming examiner agrees, application issued

Process typically 2-3 years

- can’t initiate litigation to bar another from making, using or selling without first obtaining the patent
- can be applied retrospectively from date of filing

Design Patents

- protect ornamental design of an article of manufacture, typically design of a utilitarian object
- if the design shape of a mouse is to make it more comfortable, utilitarian purpose of the shape is not protected
- are the design shapes of most modern cars able to be protected by design patents?

- If protected by design patent, test is whether subsequent object appears “substantially the same”

Term: 15 years

International Patent Laws

- each country has own patent laws
- need to file in each country
- if invention first patented in U.S., need to acquire license from PTO before applying elsewhere

Common Country Characteristics:

- publication prior to application, bars patent
- maintenance fees required

Must be manufactured within each country, within typically 3 years, or either:

- patent void or
- subject to compulsory licenses

Paris Convention for Protection of Industrial Property

- 175+ countries/contracting parties
- citizens of other countries gain same rights in patent and trademark as granted to your own citizens
- when applying in another country, filing date accepted as same as in previous app
- apply within 12 months for utility patent and 6 months for design patent and TMs

Patent Cooperation Treaty

- centralized filing procedures among member countries (150+ members)
- after filing in one country, an eligible PCT office evaluates patentability as set forth in the treaty
- if it passes, PCT applications filed in each member country where patent desired

Software Patents

- results of Bilski vs. Kappos and Alice Corp vs. CLS Bank
- several previous tests for patentability of software and business methods overturned
- software may still be patented but not all software may be patented (same for business methods)

Unless software is significantly more than implementing one or more abstract ideas and the right types of abstract ideas, it is ineligible for patent.

Software designed to improve the functioning of a computer or some other technology (e.g. a utilitarian invention), then eligible.

Current U.S. tests unclear and such patentability is nonexistent in most nations
