

Patent Law Basics

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- Intellectual property is a category of rights protecting commercially valuable products of the human intellect.
- Contrast with:
 - Real property: land or anything growing on, attached to, or erected on it, e.g., house, parking lot, parcel of land.
 - Personal property: any moveable thing that is not real property, e.g., cars, computers, furniture.

Where do IP rights originate from?

- Answer: United States Constitution—Article I, Section 8

"The Congress shall have Power ...

*To promote the Progress of Science and
useful Arts, by securing for limited Times to
Authors and Inventors the exclusive Right to
their respective Writings and Discoveries."*

What is a Patent?

- Patents are a form of intellectual property that provides certain protection for useful inventions. They should be distinguished from other types of intellectual property, such as:
 - Copyrights, which protect expressive works, like art, music, dance, and literature, and also software.
 - Trademarks, which protect product, service, and company identifiers, like brands, logos, and package designs.
 - Trade secrets, which protect commercially valuable confidential information, like business and financial plans, formulas, recipes, and customer information.

What is a Patent? (cont'd)

A patent is a right granted by the US government to an inventor for a limited time to exclude others from:

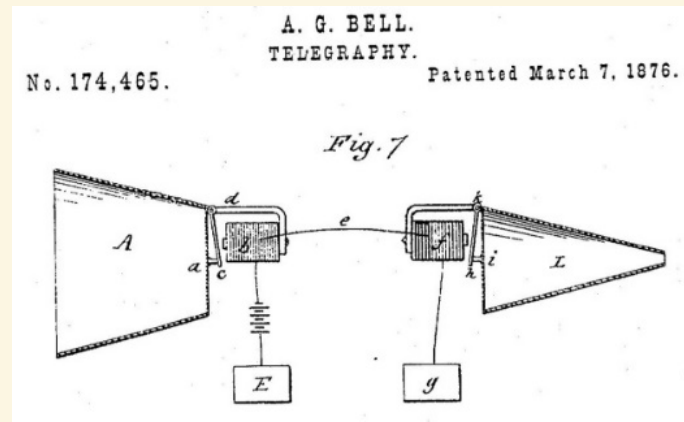
- Making, using, offering for sale, or selling the invention in the US.
- Importing the invention into the US.

What is a Patent? (cont'd)

- There are three types:
 - Utility Patent (term: 20 years from filing date)
 - new, useful and nonobvious invention
 - Design Patent (term: 15 years from issue date)
 - new, useful and ornamental designs of manufactured articles
 - Plant Patent (term: 20 years from filing date)
 - distinct varieties of asexually reproducible plants

Interesting Examples

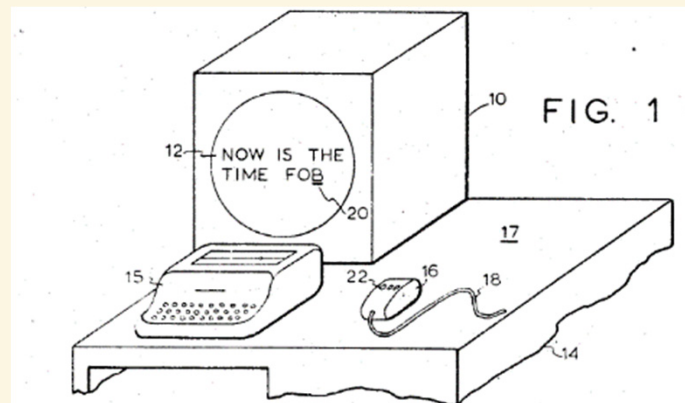
- Telephone



- Inventor: Alexander Graham Bell
- Date: March 07, 1876

Interesting Examples

- Mouse



- Inventor: D. C. Engelbart
- Date: November 17, 1970

Interesting Examples

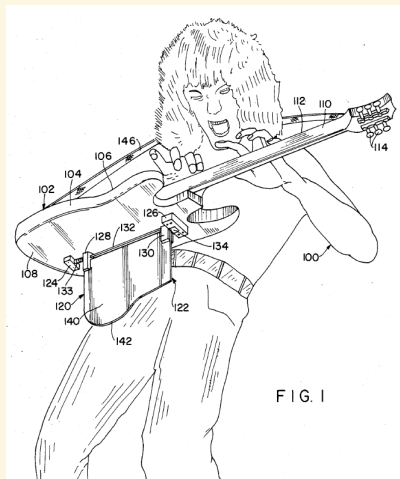


FIG. 1

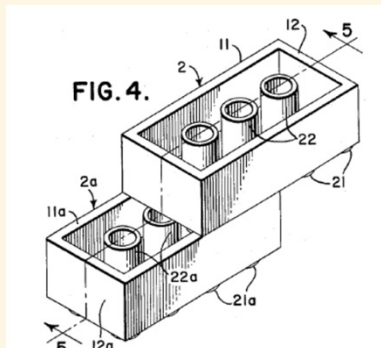


FIG. 4.

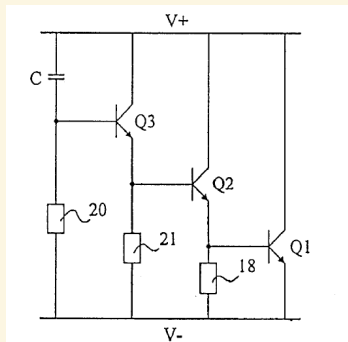


FIG. 2

Thank you for your 1-click order!

A quantity of 1 of [the item] will be shipped to you as soon as possible. We will do our best to minimize your shipping costs by combining your 1-click orders into as few shipments as possible.

Please continue browsing.

[Review or change your 1-click orders](#)

Summary Description of Item

Fig. 1B

105

101

Obtaining Patent Protection

File in the US Patent and Trademark Office (USPTO) a patent application covering an invention. This patent application includes:

- a specification, with drawings for most inventions, that describe the invention; and
- claims, which identify the scope of patent protection sought by the applicant.

Obtaining Patent Protection (cont'd)

The USPTO, through its patent examiners, examines the application to determine if it meets the statutory requirements.

Typically:

- The USPTO will reject the application one or more times before allowing the application and granting a patent.
- The patent applicant, through its patent attorney, responds to the rejections with arguments and facts to persuade the USPTO to allow the application.

Patent Requirements

A valid patent:

- Is awarded to the first inventor(s) to file the patent application claiming the invention.
- Must claim subject matter that:
 - is eligible for patent protection;
 - is novel and not obvious; and
 - has utility, which is rarely an issue.
- Must include a specification, and drawings in appropriate cases, meeting the statutory requirements.

Requirements – Eligible Subject Matter

- Processes
- Machines
- Articles of manufacture
- Compositions of matter
- Improvements to any of the above

In other words, “Anything under the sun made by man.” U.S. Supreme Court (*Diamond v. Chakraborty*).

Exceptions: laws of nature, natural phenomena, and abstract ideas

Patent Requirements (cont'd)

- Novelty
 - Invention must be **new** with respect to the **prior art**
- Non-obviousness
 - Invention must **not have been obvious** to a **person of ordinary skill in the art** at the **time** the invention was made in view of the **prior art**

Patent Requirements (cont'd)

- What is Prior Art?
 - Anything “described in a printed publication, or in public use, on sale, or otherwise available to the public” prior to filing
 - Includes activities of inventor/applicant themselves
 - Limited Exception: a disclosure originating from the inventor made one year or less before filing
 - Note: important foreign jurisdictions, such as Europe and China, provide no grace period

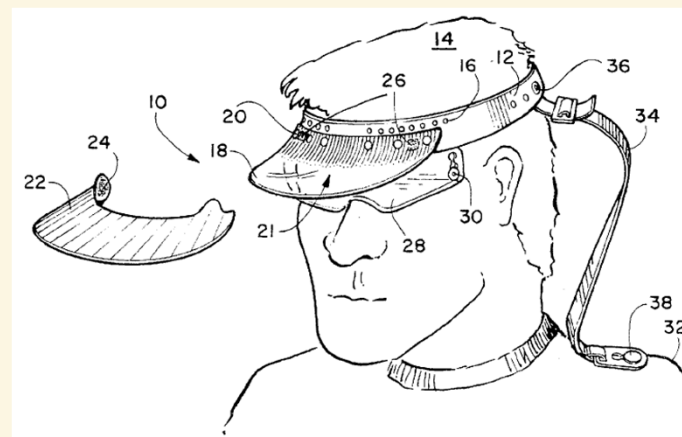
Patent Requirements - Specification

A patent's specification must:

- Provide a written description of the claimed invention.
- Enable a person of ordinary skill in the invention's technical field to make the invention.
- Set out the best mode for using the invention.
- Include at least one claim that:
 - defines the invention; and
 - forms the basis for determining patent validity and infringement.

Patent Requirements – Example Claim

1. A headgear apparatus, comprising:
 - a headband member having a frontal portion;
 - a visor member removably secured to said frontal portion of said headband; and
 - an eye shield member removably secured to said frontal portion of said headband.



Types of Utility Applications

Provisional v. Nonprovisional

- Provisional – place holder
 - Fewer requirements than nonprovisional application
 - Not examined by the US Patent and Trademark Office
 - Have 1 YEAR to file nonprovisional patent application
 - Can make public disclosure after filing provisional application
 - “Patent Pending”

Inventorship & Ownership

- Inventors own their inventions
 - Inventors contribute to the conception of the invention
- Employers can obtain assignments
 - Specific patent assignment agreements
 - Employment agreements may obligate employees to assign certain inventions and include an assignment to employer
- Single owner highly preferred

Patent Portfolio Value

A patent portfolio provides significant value, which depends on many factors, such as:

- The patents' claim scope and whether they covers core or non-core technology, or competitive technology
- Market demand for the patented technology and the availability of non-infringing alternative technology
- The cost to develop, manage, and maintain the patent portfolio
- Invention made public; potential loss of trade secret rights

Patent Portfolio Value (cont'd)

Patent owner may obtain value from its patent portfolio through:

- Third-party respect for patent rights (market exclusion)
- Marketing tool (innovation leader)
- Revenue generation (license, sale)
- Patent enforcement (injunctions, damages)
- Prevent others from patenting your invention

Patent Law Basics

Thank You!

Questions?

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