Overview of Patents

Written by independent, registered patent attorneys to provide key information and facts about filing for your patent.
I. What is a Patent?

A patent is a limited right granted by a government (all patents are limited by country) that allows
the inventor to stop other people or companies from making, using or selling a specifically defined
invention. In the United States, a patent term lasts for a period of twenty years from date of the filing of
the patent application.

A. Patent Misunderstanding

The main thing about patent law that is usually misunderstood is the fact that patents grant only
the right to stop others from making, using and selling the invention. In other words, patents may
only be used to fence off certain features of the invention from competitors, and do not mean that the
owner of the patent is not infringing on the patent rights of another patent holder.

B. Types of Patent Applications

The process of actually obtaining a patent begins with the filing of a patent application with the
USPTO. There are two types of patent applications that may be filed: provisional applications (patent
pending) and non-provisional applications (Utility & Design Patents).

Provisional patent applications are not examined by the USPTO and never directly become an
actual patent. They are placeholders used as a way to get a filing date for the technical description that is
contained in the application. All provisional applications must have a non-provisional application filed in
their place within one year of the provisional filing date. The filing date of the provisional application,
however, only covers the written description contained in the provisional application. Any new information
added in the non-provisional application is only entitled to the filing date of the non-provisional application.

Non-provisional applications (utility or design), unlike provisional applications, are examined by
the USPTO. If all of the requirements for patentability are satisfied, the non-provisional application will
mature into a patent.

Both provisional and non-provisional applications must include a complete written description or
specification of the invention. The written description must fully comply with the requirements discussed
above, being a complete and clear description of how to make and use the invention. It is very
important to consider, especially when filing a provisional application, whether all of the technical
details of the invention are developed enough to be included in a complete description, because
the non-provisional application and ultimate patent will have to depend on it. This is even more
important if a Bar Event either has happened or will happen before the filing of the non-
provisional follow up to the provisional application. This is because no new technical information
can be added to the written description without getting a new filing date. Once a Bar Event has
happened, new filing dates after the Bar Event may prevent the invention from being patented,
because it is no longer “new.” The filing of a summary provisional application may NOT, therefore, preserve all patent rights in an invention.

C. What’s in a Patent?

A patent includes a complete technical description of the invention, together with other older
related inventions and devices, which will be helpful for the reader to understand the new invention. The
text of a patent typically includes a section on the background of the invention, which typically includes a
review of those inventions or devices already known to the public. These older inventions and other
information known to the public are called “prior art.” The prior art includes all information, which is
related to the claimed invention. The prior art is not what is actually known by the inventor, but what is generally known to all people skilled in the particular field that is the subject matter of the patent application. During examination, the invention is compared to the prior art to see what the inventor has really invented. A patent continues with a detailed description of the invention itself. The description must be in enough detail that readers who are skilled in the field of the invention can make and use the invention themselves. The patent document also may contain detailed drawings.

D. The Claims

The patent ends with the recitation of the actual boundaries of the invention, known as the “claims.” Claims are one-sentence descriptions of the precise features, which make up the invention. For example, a stool might be claimed as: “A device for supporting a person in a sitting position, having a flat seat supported some distance from the ground by legs.” A chair, on the other hand, might be claimed as: “A device for supporting a person in a sitting position, comprising a flat seat, a back support attached to the seat, and legs supporting the seat some distance from the ground.” The chair would be patentable “over” the stool, as it has a unique element not found in the stool, namely, the back. The stool, would, however, not be patentable in light of the chair.

Like the “metes and bounds” of a real estate deed, the claims lay out the exact coverage of the patent, and identify for others what items must be left out of any competitive device to avoid infringement. Infringement is found when another device, sometimes called the “accused product,” includes all of the elements listed in the claims. Using the example above, the chair would infringe the stool claim, because it has all of the elements, but the stool does not infringe the chair claim, because it doesn’t have a back. Writing the claims of a patent application is important and skilled work, usually performed by a patent attorney. It is important when creating the claims to balance the number of elements necessary to get a patent allowed (since including more elements makes the invention more patentable because the elements are not shown in the prior art) and the minimum number of elements that describe the invention (since including less elements makes it easier to find infringement in other devices). A “broad” claim is therefore one, which claims the least number of elements or required parts.

II. Getting and Enforcing Patent Coverage

A. Filing Dates

Filing a patent application has two very important aspects. One is the completion of the written description that contains all of the technical details of the invention. The other aspect is the filing of the application itself. The filing effectively stops the running of the “clock” which destroys patentability one year after any of the Bar Events, described above, have happened. It also determines what prior art will be used to examine the application, as only certain prior art is used depending on the date of the prior art and the filing date of the application. Additionally, what is described in that patent application, especially if a Bar Event has happened, is frozen and the inventor cannot add any new technical description. After filing, the term “Patent Pending” may be placed on the invention or any documents or material associated with it.

B. Duty to disclose Prior Art to the USPTO

Each inventor and their attorneys have a duty of honesty and good faith to disclose to the USPTO all information which they know might be important or relevant to the examiner in considering whether the invention is patentable. This means that the inventor must disclose prior art that he or she knows about, if it could have or would have prevented a patent application from issuing as a patent. This duty to disclose continues throughout the period that the patent application is pending. There is, however, no
obligation to search for information. Thus, in the event that a prior art or patentability search is made, the results of the search will need to be reported to the USPTO and will be considered during the examination of the application.

During the examination process, which applies only to non-provisional applications, the examiner makes a search in the USPTO records, which contain every patent issued in the United States, plus many foreign patents and a lot of published materials, such as magazines and technical journals. Once the examiner selects what he or she considers to be the most relevant patents or other "references," the examiner compares the claims in the application to the prior art to determine if the novelty and nonobviousness requirements have been met. As discussed above, if all of the claim elements are found in one prior patent or disclosure, the claims will fail the novelty requirement, having been invented before in its entirety. If all of the claim elements are not found in one prior patent or disclosure, but instead in multiple, related patent or disclosures, making it "obvious" to one skilled in the field of the invention to combine the features of these known inventions, then the claims will fail the obviousness test. It is therefore necessary for the inventor to include elements in the claims not found in the prior art to receive patent coverage. The examiner then makes up a written report, either granting or rejecting the application claims, called an "office action" and sends it to the inventor or his or her attorney. After reviewing the office action, the inventor or attorney can change the claims of the application in response to the comments of the examiner. Ultimately, the patent will either be granted or finally rejected by the USPTO after a few rounds of letters. If granted, it will be published by the USPTO and mailed to the inventor or his or her attorney.

III. Formal Requirements for Patentability

A. Brief Overview

The key question is "What constitutes an invention which can get patent protection?" In the United States, there are several requirements. An invention must fall within one of four specific technical categories and must also meet three requirements: utility, novelty and nonobviousness.

Utility means usefulness. Each invention must be useful for some purpose. Novelty relates to the uniqueness of the invention, in that the elements of the invention (found in the claims, described above) have not already been developed and/or described by someone else. Nonobviousness means that the invention is not just an obvious small improvement to a known device or process. Each of these requirements is discussed in greater detail below.

B. What May Be Patented

There are four categories of invention:

1. Processes;
2. Machines;
3. Articles of manufacture (things that are made, like a pencil); and
4. Compositions of matter (chemical compounds).

Not all new and useful inventions can be patented; instead, only those inventions that fall within these categories are eligible for patent protection. Things such as laws of nature, naturally occurring products of nature and physical phenomena are not eligible for patent protection because they do not fall within one of the identified classes of invention.
C. Novelty

In order to be eligible for a patent, an invention must be “new” or “novel.” An invention is considered to be not “new” or “novel” if:

1. It was known or used by others in the U.S. before the applicant “invented” it;
2. It was patented or described in a printed publication anywhere before the applicant “invented” it;
3. It was patented or described in a printed publication anywhere more than one year before the applicant filed an application for a patent in the U.S.;
4. It was in public use or on sale in the U.S. more than one year before the applicant filed an application for a patent in the U.S.;
5. It was described in a U.S. patent granted to someone else that was filed before the applicant “invented” it;
6. It was not actually invented by the applicant; or
7. Before the applicant’s “invention,” it was made by someone else in the U.S. who did not abandon, suppress or conceal it.

These rules are applied during the examination of the patent application by the United States Patent and Trademark Office, or USPTO. The invention is compared to the prior art by an examiner who is familiar with the technical subject matter of the application. The examiner searches through the USPTO files of existing patents and other publications to see if the invention was already developed.

Certain Activities can Destroy Patent Rights

The activities listed above that can make a development not “new” or “novel” (and not patentable) are not limited to things done or developed by others, but also include acts committed by the inventor. If the invention is:

- described in a printed publication,
- used in public,
- was for sale or sold

even by the inventor, it starts a one year clock running during which time the patent application must be filed. If more than one year elapses, then the development is considered “barred” from patenting, as not “new” or “novel.” It is very important to promptly consider whether something might be patentable and if any of the four “Bar Events” have occurred or might occur in the near future. Delay in filing an appropriate patent application can have permanent and fatal consequences to the protectability of the invention.

D. Nonobviousness
Novelty is not the only hurdle to jump in getting a patent. Even if an invention is “new” or “novel,” the invention may still not be patentable. In addition to being “new” or “novel,” the invention must also be “nonobvious.” Simply put, if the invention would have been obvious to a person having ordinary skill in the field of the invention in light of other known inventions (the prior art), then it is not patentable (because it is not “nonobvious”). In practice, this is also evaluated by the examiner. The examiner will usually show obviousness by combining two existing inventions to find all of the elements of the invention being examined. For example, if the inventor is trying to patent a chair with arms and the prior art shows a patent for chairs without arms and another patent for sofas with arms, the examiner will state that putting arms on a chair is an obvious improvement, since arms were already put on other seating devices.

E. **Description Requirements**

Certain requirements are also applied to the written description portion of patents and patent applications, also called the “specification.” These requirements include the following:

1. the specification must contain a detailed written description of the invention, and of the manner and process of making and using the invention, in such clear terms so that any person skilled in the area of the invention can make and use the invention; and

2. the specification must disclose and set forth the “best mode” or best particular way that the inventor has developed for making and using the invention (which means this best mode cannot be concealed or kept secret by the inventor).