

Patents and Patent Prosecution

By Timothy D. Smith

The area of patent law is highly technical and requires expertise in the procedure of obtaining a patent. What follows is an overview of the basics of patent law as it relates to obtaining a patent.

What is a Patent?

A Patent is a governmental acknowledgement of a right, privilege or authority.¹ A valid United States patent secures to its owner, for a limited time, the right to exclude others from making, using or selling a claimed invention in the United States or importing it into the United States.²

All patents filed within the United States fall under the jurisdiction of the United States Patent & Trademark Office ("USPTO").³ The United States Constitution, Article 1, Section 8, Clause 8, empowers Congress 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."⁴ Note that the Constitution speaks of "securing" and not "granting", thus implying that the inventor has rights to his or her invention that the patent system merely "secures" to the inventor for a limited time. The duration of the "limited time" and the starting date from which the duration is counted, both, are purely arbitrary.⁵

Individuals can seek governmental protection of patents, copyrights and trademarks. Of the three, it is more important to seek protection of inventions via patent than to file for protection for copyrights or trademarks. Under the Copyright Protection Act of 1976, copyright protection attaches once the work is

fixed in some tangible form, regardless of whether the copyright is registered or the work is published.⁶ Using a sign or insignia in commerce in a particular geographic area gives one a common law right to trademark.⁷ Registering these words and marks with the Federal Government secures more protection for the owners than simply relying on common law rights, however.

Patentable ideas have to be filed with the USPTO and approved by the USPTO for the inventor to receive protection. Therefore, to protect their ideas inventors must file patent applications. The patent application process can be complicated, and as a result, people who draft patents for inventors must be licensed to practice through the USPTO.⁸ Patent attorneys must pass a separate bar exam administered by the U.S. Government.⁹

Nuts & Bolts of Patents

The USPTO recognizes three distinctive types of patents, which are, utility, design and plant patents.¹⁰ Utility patents are inventions that perform a function.¹¹ They are inventions that accomplish a means to an end. Utility patents are the most frequently filed patents and as a result are the most frequently granted. Design patents are a patent on an ornate design.¹² Design patents typically have no other function than to be esthetically pleasing or novel. Plant patents obviously pertain to plant and plant developments.¹³ This is often developments in the hybridization of plants, although that too can fall under the utility patent scheme.

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Timothy Smith is licensed to practice patent law by the United States Patent & Trademark Office. He also provides assistance in the procurement of copyrights and trademarks. He is currently an attorney in the Mississippi Department of Public Safety Legal Division in Jackson.

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In order to be patentable, an invention must pass four tests:¹⁴

1. The invention must fall into one of the five "statutory classes" of things that are patentable:
 1. processes,
 2. machines,
 3. manufactures (that is, objects made by humans or machines),
 4. compositions of matter, and
 5. new uses of any of the above.
2. The invention must be "useful." One aspect of the "utility" test is that the invention cannot be a mere theoretical phenomenon.
3. The invention must be "novel," that is, it must be something that no one did before.
4. The invention must be "unobvious" to "a person having ordinary skill in the art to which said subject matter pertains". This requirement is the one on which many patentability disputes hinge.

As mentioned, the idea or discovery must exhibit a degree of usefulness or utility. An inventor can not simply think of an idea and then go to a patent attorney and file a patent based on theory and words describing that theory. The idea must essentially be reduced to practice when filed. Working models or prototypes are desired by the USPTO.¹⁵ Obviously, an inventor can not necessarily exhibit a model of a new chemical believed to cure some disease. However, they can exhibit the chemical formula and illustrate how that formula functions in solving the problem at hand.

The invention must also be novel. An inventor cannot receive a patent on something that has already been patented or something that has not been patented but is within the public domain. When filing a patent, the invention will be measured against "prior art." "Prior Art" is defined as what has been previously patented or what is already in the public domain.¹⁶ The USPTO also recognizes the "Doctrine of Equivalents." The Doctrine of Equivalents protects patented ideas from other ideas that are very similar in nature. It allows the inventor to claim those insubstantial alterations that were

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not captured in the drafting of the original patent claim but which could be created through trivial changes.¹⁷ It essentially gives the inventor a hedge of protection not just upon his idea, but the area immediately around it as well. As a result, persons desiring to obtain a patent must truly exhibit a novel idea for their idea to be patentable.

An inventor's own invention may very well be prior art that works against him in some cases. An inventor essentially has one year from the time his invention is released to the public to file his patent. After this one-year period, the inventor can no longer file a patent.¹⁸ Being released to the public does not necessarily mean telling someone about the idea; rather, it means selling the product, advertising the product, or printing articles about it for view by the public.

Finally, the discovery cannot be something that is obvious to people who work in the field.¹⁹ The statutory standard of obviousness is whether "one skilled in the art" would think of this idea as being obvious in light of present technology.²⁰

Filing the Patent

The filing process typically begins with an interview with a patent attorney about the idea or discovery. The patent attorney will try to grasp as much of an understanding as possible of the idea. For this reason, it is a good idea for the inventor to bring any notes available, any prototypes available, or drawings or other

items that may aid the patent attorney in understanding the invention.

The patent attorney will then conduct a thorough search of existing prior art that may prevent the idea from being patentable. After this search is completed, the patent attorney will report the findings and aid the inventor in deciding whether or not to pursue obtaining a patent based on the information gathered.

The patent application will contain all available information regarding the idea. The application is typically divided into

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three main parts, "the claims"²¹, "the specification"²² and "the drawings."²³

The claims are the heart of the patent. In this section, the applicant outlines the idea in detailed manner that a person skilled in the art can take the claims and make the invention. The specification is a detailed narrative that describes the invention. It will include a description of the invention as well as the other art in the area, and how this improves on that art in making it a novel idea. The drawings

relate back to the claims and specification and are literally drawings of the invention. They aid the patent examiner and those viewing the patent in visualizing the idea. The patent application is then filed with the USPTO. The application will be given a file number and will be assigned to a patent examiner. Correspondence by the USPTO seeking further information is usually frequent.

Within 12 to 18 months the examiner will normally issue his "initial office action." This "office action" will specify what the examiner thinks is wrong with the application and how it must be changed in order to become patentable.²⁴ Rarely does the initial office action come back without some type of complaint or criticism as to the invention by the examiner.

The patent attorney will file a response with the requisite changes and wait to see if another office action is filed. Either another office action will be filed by the examiner, or the application will be accepted or rejected. If accepted, the inventor or inventors will soon have a patent upon paying the issuance fee. Upon payment of the issuance fee, the inventor or inventors are granted the patent which protects the inventor for a period of twenty years from the initial filing.²⁵ ■

¹ *Zenith Radio Corp. v. Hazeltine Research Inc.*, 395 US 100, 89 S.Ct. 1562, 1583, 23 L.Ed. 2d 129 (1969).

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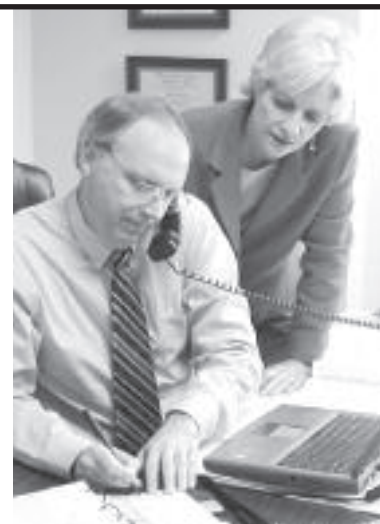
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- ² *Id.* at 1583.
- ³ 35 USCA § 1(a).
- ⁴ USCA Const. Art. I §8, cl. 8.
- ⁵ Martin Pheffer, *Fundamentals of Patent Prosecution* (Practicing Law Institute 2004).
- ⁶ 17 USCA §§ 102(a) and 411.
- ⁷ *Pedi Care Inc. v. Pedi-A-Care Nursing, Inc.*, 656 F.Supp 449, 2 USPQ 2d 1691.
- ⁸ 37 CFR § 10.5.
- ⁹ *Id.*
- ¹⁰ 35 USCA § 101 (utility), 35 USCA § 171 (design), 35 USCA § 161 (plant).
- ¹¹ 35 USCA § 101.
- ¹² 35 USCA § 171.
- ¹³ 35 USCA § 161.
- ¹⁴ 35 USCA § 101, 102, 103.
- ¹⁵ *Dolbear v. America Bell Tel. Co.*, 126 US 1, 8 S. Ct. 778 (1888); *Boyce v. Anderson*, 451 F.2d 818 (9th Cir. 1971); *Brunswick Corp. v. US*, 152 F.3d 946 (Fed. Cir. 1998).
- ¹⁶ 35 USCA § 102.
- ¹⁷ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558 (Fed. Cir. 2000).
- ¹⁸ 35 USCA § 102(a).
- ¹⁹ 35 USCA § 103(a).
- ²⁰ *Id.*
- ²¹ 35 USCA § 112.
- ²² 35 USCA § 112.
- ²³ 35 USCA § 113.
- ²⁴ *Manuel of Patent Examining Procedure (MPEP)* § 704.
- ²⁵ 35 USCA § 154(a)(2).

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