

PATENTS: WHAT YOU SHOULD KNOW

Steven R. Ludwig, Ph.D., Esq.

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Strategists and Advisors
specializing in the protection,
transfer and enforcement of
Intellectual Property Rights.

Overview

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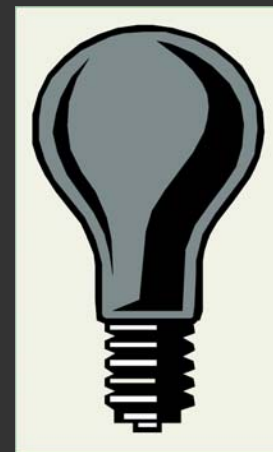
- What is a Patent?
- Why Patent?
- How to Obtain a Patent?
- When to Patent?

What is a Patent?

A PATENT is a form of:

“**Intellectual property**” which is a creation of the human mind that is protected by U.S. state and federal law in a fashion similar to real property (e.g. a piece of land). Intellectual property rights include:

- Patents
- Copyrights
- Trademarks
- Trade Secrets



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What is a Patent?

The US Constitution, Art. I, sect. 8 provides that:

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"

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Patent Rights

A patent is a grant by the U.S. government that entitles the owner (e.g., an individual inventor or company) to exclude others from:

- Making, Using, Selling, Offering to sell or Importing into the United States a patented invention.
- A domestic patent only provides these exclusive rights in the United States.
- A patent does NOT necessarily give the owner the right to practice the patent, because of others' potential prior patent rights.

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A Dominating Patent

Patent 6,123,456

A method for making a chair comprising:
1) Step A

Your Patent

A method for making a chair
comprising:
1) Step A
2) Step B and
3) Step C

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What is the Period of Protection that a Patent Provides?

- 20 years protection from the earliest filing date to which the invention is entitled

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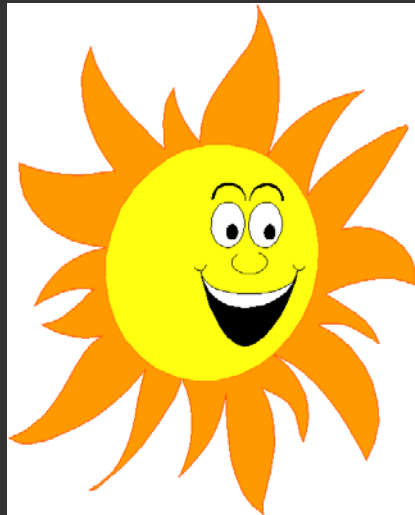
WHY PATENT?

Why Patent?

- Patenting is Prestigious –
 - I did it!
 - And I was first!
- Easy Publication – no editors.
- Licensing possibilities.
- Recoup dollars spent on R&D
- Expanded collaborations.
- Commercial advantage over competitors
- Provide valuable trading assets to help assure freedom to operate

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What is Patentable?



“. . . Anything under
the sun that is made
by man.”

Diamond v. Chakrabarty, USPQ 193, 196 (US 1980)

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What is Patentable?

“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor,” subject to certain conditions.

35 USC § 101

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Specific Examples of Patentable Subject Matter

- Machine – screwdriver
- Improved machine – better screwdriver
- Compositions – new drugs
- Methods of making
- Methods of Using
- Methods of Treatment, e.g., a method for treating a disease
- Business Methods

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What Cannot be Patented?

- Only a few limitations:
- An algorithm
- A theory or scientific principle, e.g. the Theory of Relativity
- A human being

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Who is Entitled to a Patent?

- In the US, Patent Rights Awarded to the First to Invent
- Invention Consists of:
 - Conception - mental part of the inventive act
 - Reduction to Practice (RTP) –
 - Actual RTP - Build or conduct claimed product/method and verify that it works for its intended purpose
 - Constructive RTP - File patent application
 - Diligence - effort between conception and RTP

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How to Obtain a Patent?

- GETTING STARTED

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Planning for Successful Patent Protection

- Keep and maintain good laboratory notebooks
- Routinely sign and date your notebook even prior to actually accomplishing your objective
- Have records “witnessed” with signature and date by an objective witness – a non-inventor

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When to Patent?

1) Identify Innovation

2) Evaluate Research, Product Development, etc.

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What are the Requirements for a Patent?

- New or Novel (Not already known)
- Not Obvious
- Utility (Useful)
- Written Description (Details of the invention)
- Enabled (Must describe how to make and use the invention)
- Best Mode (The preferred way of practicing the invention known to the inventors as of the filing date)

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Potential Barring Activities

- Public use in U.S. before date of invention
- Patent or publication before date of invention
- Publication more than one year before filing
- Public use more than one year before filing
- Sale or offer for sale more than one year before filing

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Planning for Successful Patent Protection

- 1) Identify Innovation
- 2) Evaluate Research, Product Development

NEXT:

- 3) Invention Disclosure Form
- 4) Interact with Tech Transfer Office
- 5) Prepare disclosure
- 6) Patent application prepared

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Two Basic Parts to a Patent

- Application specification
 - the description must provide sufficient information to allow one skilled in this area to reproduce the invention
- Claims
 - defines the invention being protected

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Possible Patent Application Filing Strategy

Provisional Application



Non-Provisional Application
(Not later than 1 year after
than Provisional filing date)



Published Patent Application
(18 months after filing the
non-provisional application)



Patent Cooperation Treaty
(Not later than 1 year after
filing the first application)



National Stage Filing in
Individual Countries
(approximately 30 months
after the first application is
filed)

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What is a Provisional Application?

- Establishes a filing date (earliest priority date)
- Examination process does not begin
- Clock does not start running on lifetime of patent
- Has simpler filing requirements
- Lower filing fees
- Claims are not required

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Duty of Disclosure

- File Information Disclosure Statement
 - Duty on applicants, attorneys and anyone substantively involved in the patent application process to disclose all “material” information that they are aware of to the Patent Office
 - No duty to search
 - Duty continues until issuance
 - Failure to comply may render patent unenforceable

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Patent Application Process (2-5 Years on Average?)

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- Conceive the invention
- Write the application
- File the application
- Meet the application formalities – e.g., declaration, formal drawings
- Examination process begins
- Restriction requirement issued – sometimes
- Substantive Office Action issued
- Reply filed (usually there will be multiple iterations of this and the above step before an allowance is obtained)
- Appeal filed
- Application Allowed
- Pay necessary fees – file continuations?
- Patent issues
- Pay Maintenance Fees

Too much to do?

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- Patenting is easy.
- Inventing is tough.

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THANK YOU