

The Process of Creating Patented Inventions

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Forms of Intellectual Property

- **Trade Secrets**
- **Patents**
 - Provisional patent application
 - Utility patent application
 - Design patent application
 - Plant patent application
 - Continuing patent application
- **Copyrights**
- **Trademarks**

Patenting vs. Trade Secrets

- **The bargain:** protection of the invention is a reward for an *enabling* disclosure;

Protection is the right to exclude others from:

- Making
 - Using
 - Selling
 - Offering for sale
- Purpose: **To advance technology.**

U.S. Patent Law and Rules

- **U.S. Constitution: Congress shall have the 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. ” Article I, Section 8
- **Federal Statutes 35 U.S.C.**
- **U.S. Patent Office Rules 37 U.S.C.**
- **Court of Appeals for the Federal Circuit**

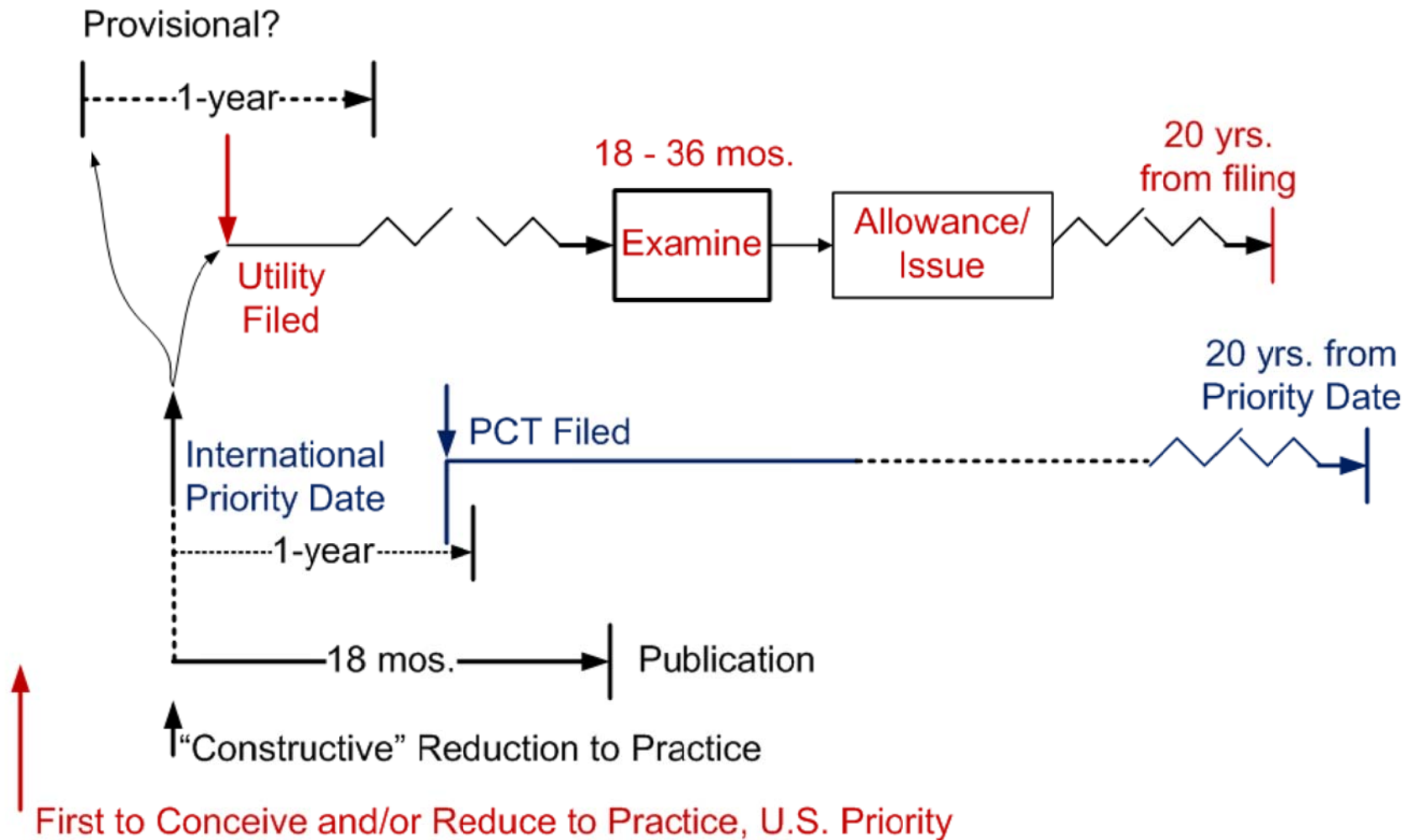
What Patents Can Protect

- Virtually any item, compound, or process made by man “...any new and useful process, machine, manufacture, or composition of matter...”
35 U.S.C. § 101
- But **NOT**:
 - law of nature or principle
 - mathematical formulae/algorithms (e.g., $E = MC^2$)
 - inoperable device (e.g., perpetual motion)
 - An obvious improvement
- Exceptions vary by law of individual countries

Statutory Requirements for a Patent

- New – 35 U.S.C. § 102
- Useful – 35 U.S.C. § 101
- Non-obvious – 35 U.S.C. § 103
- Fully disclosed – 35 U.S.C. § 112

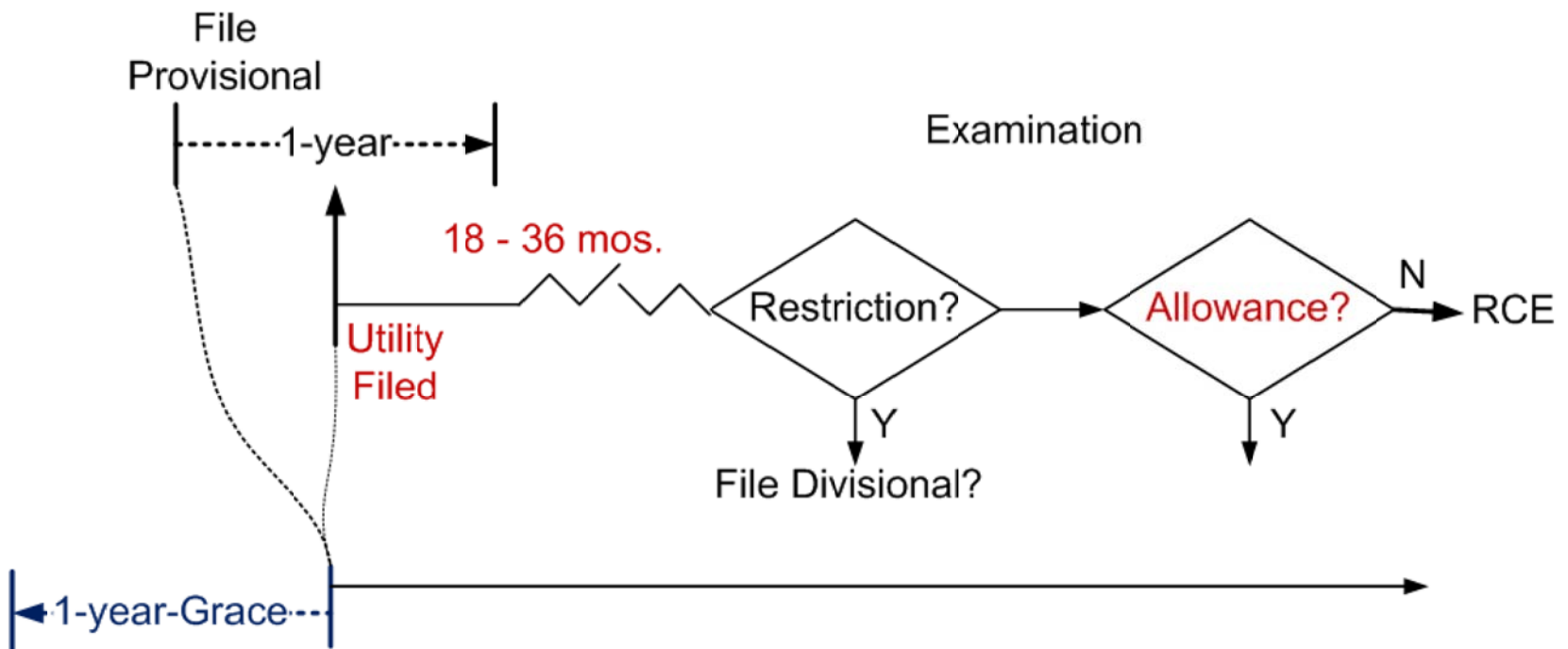
Patent Process (Simplified)



More Timelines

- In general, one year grace period from public disclosure to filing in U.S.
- In foreign countries, there is generally no grace period for public disclosure before any filing.
- Invention “offer for sale” starts the bar even if the offer is private.

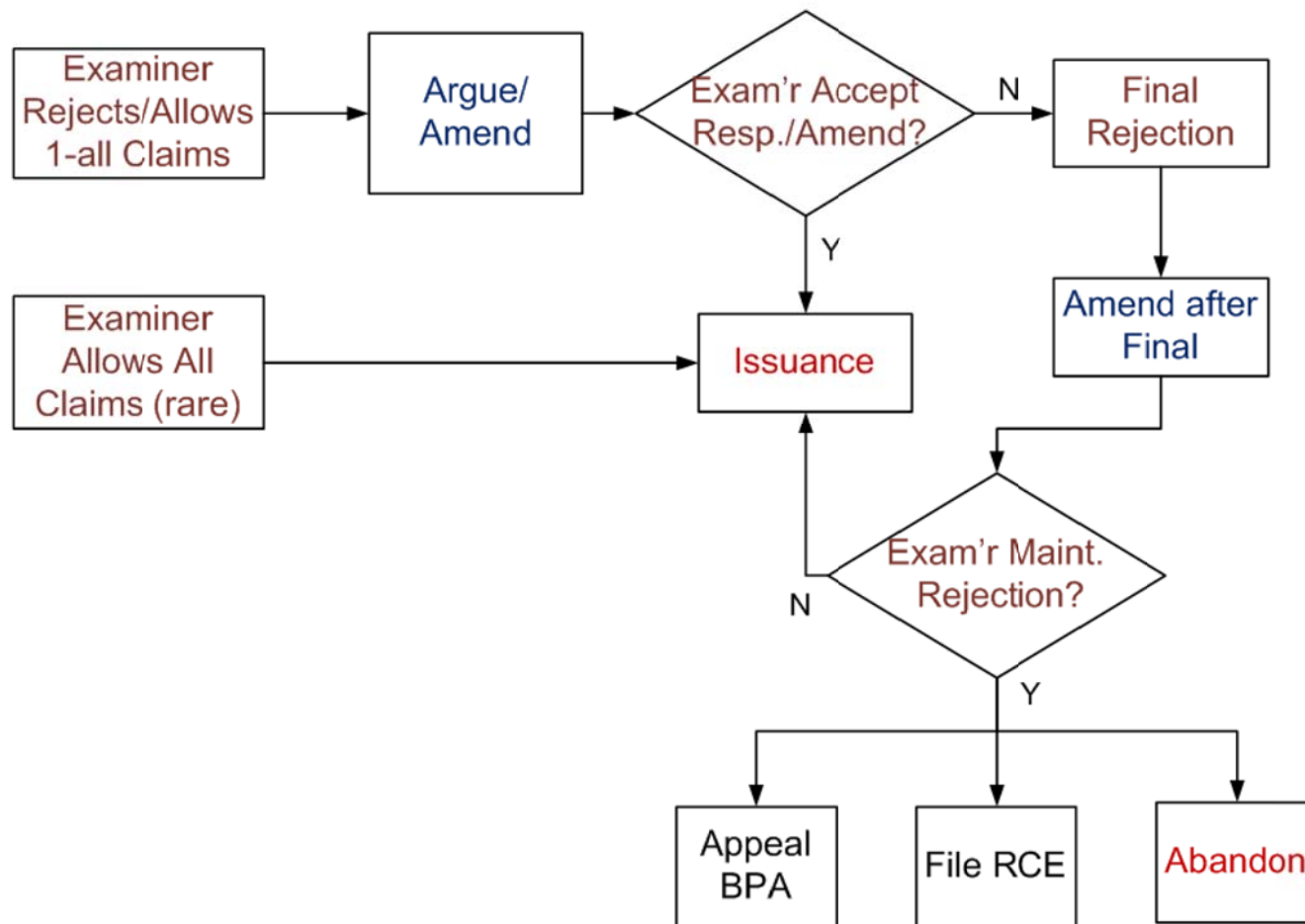
Other Time Lines and Events



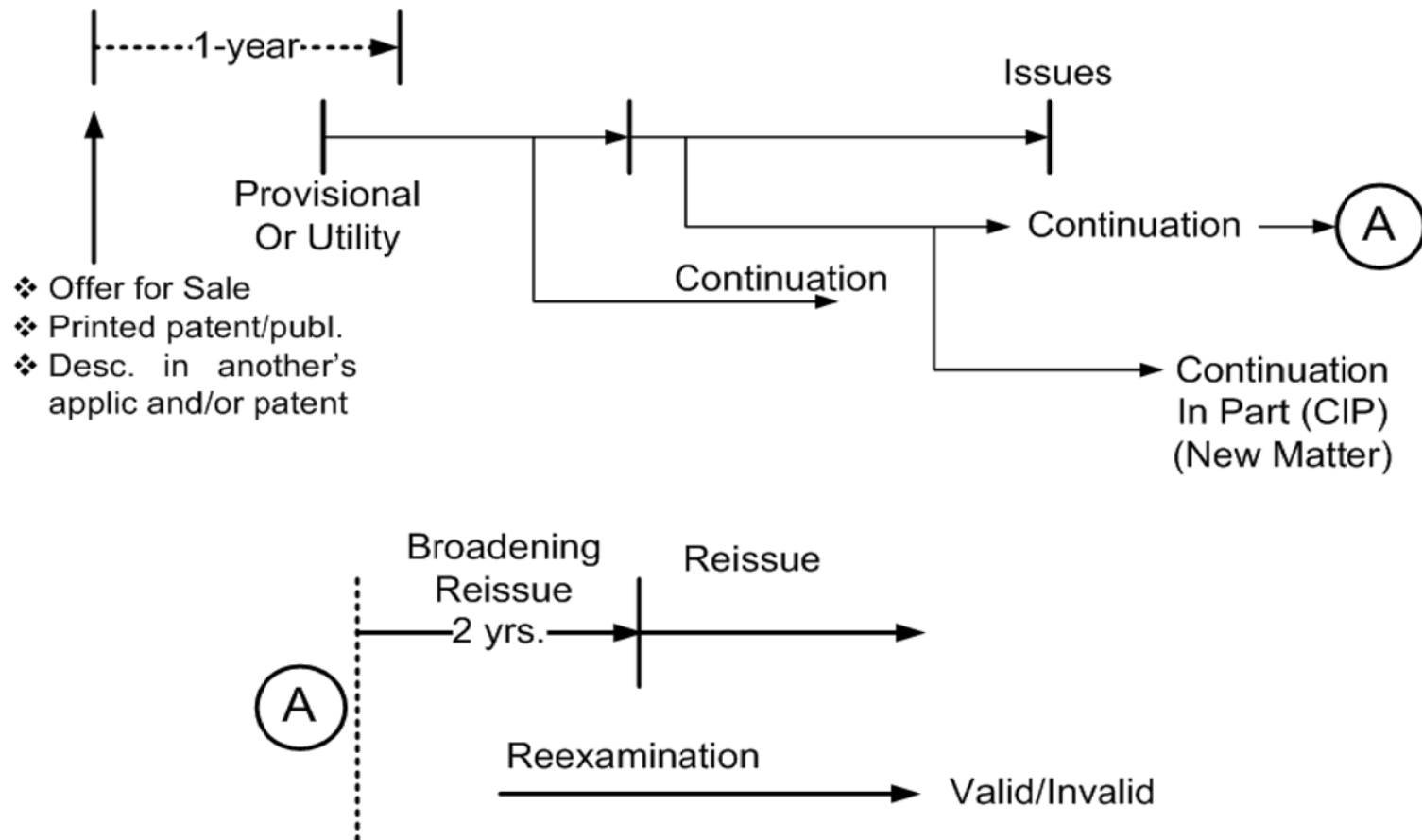
Bars

- ❖ Offer for Sale
- ❖ Printed patent/publ.
- ❖ Desc. in another's applic and/or patent

Prosecution



Clinical History of a Patent Family



The Patent Cooperation Treaty

- A United Nations Treaty
- Operational since June 1978
- Administered by World Intellectual Property Organization (WIPO) in Geneva
- Single application can file in >120 countries
 - filed in one patent office , in one language
 - Effective as a national application with int'l filing date in each designated state

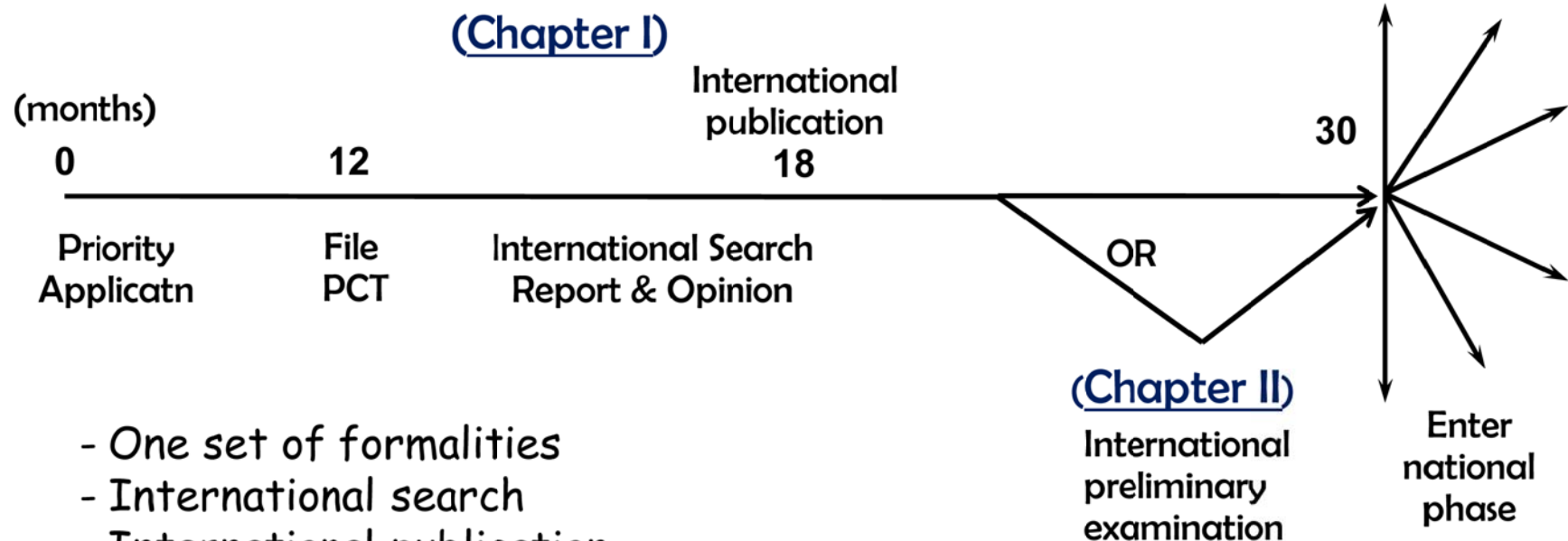
PCT International Application

- **Designated regional/national pat. offices receive**
 - search report by an authorized Office
 - (optional) non-binding examination
- **Delay expenses (translation, foreign filing fees)**
- **Early indication of prior art**
- **Time to assess commercial value**

Two Phases

- **International Phase**
 - Chapter I (international search report & written opinion, optional amendment to the claims)
 - Chapter II (optional examination)
- **National Phase** (generally after 30 months)

PCT System



- One set of formalities
- International search
- International publication
- Optional international preliminary examination
- Translations & national fees at 30 mos, only if national entry

Components of a U.S. Utility Application

- Title, abstract, declaratory documents
- Specification
 - Background
 - Summary (of Invention)
 - Detailed description and drawings
- Claims

A Provisional Patent

- Secret, unless used to claim priority
- Claims are not *required*, but ...
- Important Requirements:
 - Enablement
 - Best mode
- Low cost
- An extra year

Specification

- The written description
- 35 USC 112: “a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . to make and use the same, and shall set forth the best mode”



Specification

- What should be included
- What is not necessary
- Inadequate **disclosure** can result in an invalid patent
- **Limiting** statements may narrow the effective scope (of claims).
- Important: must have **support** for present and future (continuation) claims

Claims

- Exact statements of precisely what the invention encompasses
- Notice to the public
- Claims are what are substantively examined and eventually allowed or finally rejected

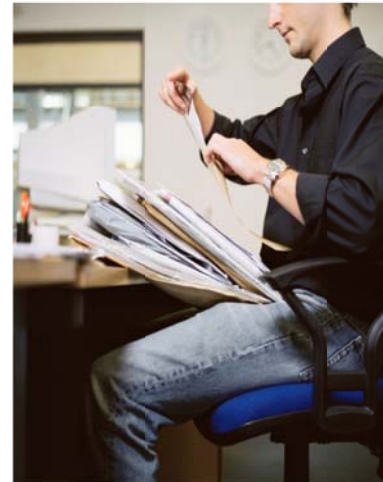


Claims

- Broad vs. narrow
- Independent vs. dependent
- Many kinds, means/step plus function, lots of law here.
- Apparatus, process, etc.: selecting the infringer

Course of Prosecution

- Non-Final Action
 - Allowance
 - Rejection
- Final Action
 - Rejection
 - Allowance
- Appeal
- Continuing applications
- Abandonment



Patent Issues

- Ownership starts with inventorship
- You can prevent others from practicing the invention covered by the claims (“injunction”, but this may be in flux)
- Does NOT give YOU a right to practice the invention!
- Owner can license or sell (assign) patent rights

Inventors



- The individuals who contribute ideas that are embodied in any claim
- A sole inventor must have conceived the ideas in all of the claims
- An individual whose ideas are not claimed is not an inventor (even if those ideas are disclosed in the specification)
 - Can be used to limit inventorship!
- Inventors have independent equal rights

File History

- The record of prosecution
 - Original filing documents
 - Rejections
 - Arguments
 - Interviews
 - Amendments (“Festo”)
- The bottom of the “iceberg” that may limit a patent



Thank you!



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