The Process of Creating Patented Inventions

Daniel L. Flamm
Buchanan Ingersoll & Rooney, LLP
333 Twin Dolphin Drive, Suite 700
Redwood Shores, CA  94065-1418
email: daniel.flamm@bipc.com

DISCLAIMER: This presentation is for informational purposes only, does not constitute specific legal advice, and does not create any attorney-client relationship with Buchanan Ingersoll & Rooney LLP or its attorneys or agents. It represents the current opinions of the author, and not necessarily those of any other attorney or agent affiliated with Buchanan Ingersoll & Rooney, LLP, or of any past or future client of Buchanan, Ingersoll & Rooney, LLP. NO warranty or representation is made nor does the author assume any legal liability, whether direct or indirect, or responsibility for the accuracy, completeness, or usefulness of any information herein.
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.
- 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

- Non-obvious – 35 U.S.C. § 103
Patent Process (Simplified)

Provisional?

1-year

Utility Filed

18 - 36 mos.

Examine

Allowance/Issue

20 yrs. from filing

International Priority Date

1-year

18 mos.

Publication

“Constructive” Reduction to Practice

First to Conceive and/or Reduce to Practice, U.S. Priority

20 yrs. from Priority Date
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

File Provisional

--- 1-year ---

Examination

18 - 36 mos.

Restriction?

Allowance?

N → RCE

Y ↓

Restriction?

Y ↓

Allowance?

File Divisional?

Bars

- Offer for Sale
- Printed patent/publ.
- Desc. in another’s applic and/or patent
Clinical History of a Patent Family

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

Provisional Or Utility

1-year

Issues

Continuation

Continuation

In Part (CIP)
(New Matter)

Broadening

Reissue

2 yrs.

Reissue

Reexamination

Valid/Invalid

A

A

Buchanan Ingersoll & Rooney PC
Attorneys at Law and Registered Patent Agents
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

(Chapter I)

(months)

0 12 18

Priority Applicatn File PCT International Search Report & Opinion

International publication

30

OR

(Chapter II)

International preliminary examination

Enter national phase

- 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!

LOOK AHEAD
YOUR SUCCESS IS OUR FOCUS