Patent Webinar Series

The Basics of Patents

March 25, 2021

FISH.

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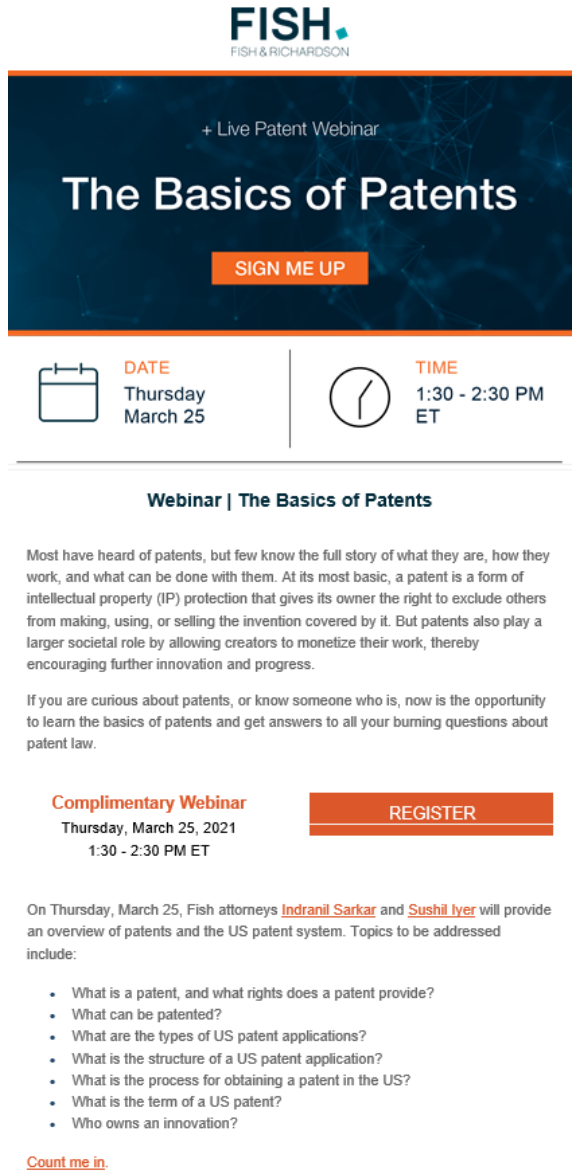
Meet The Speakers

Indranil Sarkar
Principal

Sushil Iyer
Principal

Overview

- **Topics**
  - What is a patent?
  - How to get one?
  - Some practice tips
- **Housekeeping**
  - CLE
  - Questions
  - Materials
    - http://www.fr.com/webinars



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+ Live Patent Webinar

The Basics of Patents

SIGN ME UP

DATE
Thursday
March 25

TIME
1:30 - 2:30 PM
ET

Webinar | The Basics of Patents

Most have heard of patents, but few know the full story of what they are, how they work, and what can be done with them. At its most basic, a patent is a form of intellectual property (IP) protection that gives its owner the right to exclude others from making, using, or selling the invention covered by it. But patents also play a larger societal role by allowing creators to monetize their work, thereby encouraging further innovation and progress.

If you are curious about patents, or know someone who is, now is the opportunity to learn the basics of patents and get answers to all your burning questions about patent law.

Complimentary Webinar
Thursday, March 25, 2021
1:30 - 2:30 PM ET

REGISTER

On Thursday, March 25, Fish attorneys Indranil Sarkar and Sushil Iyer will provide an overview of patents and the US patent system. Topics to be addressed include:

- What is a patent, and what rights does a patent provide?
- What can be patented?
- What are the types of US patent applications?
- What is the structure of a US patent application?
- What is the process for obtaining a patent in the US?
- What is the term of a US patent?
- Who owns an innovation?

Count me in.

Agenda

- Background
- Patent FAQs
- Types of US Patent Applications
- Anatomy of a Patent Application
- Claims
- Requirements for Patentability in US
- Prosecution in the US

Background

Introduction

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.

U.S. Constitution, Article I, section 8, clause 8

What is Intellectual Property?

- **Intellectual Property (IP) refers to creations of the mind:**

  inventions; literary and artistic works; and symbols, names, images, and designs used in commerce.

- **Patents** – protect inventions.

- **Copyrights** – protect written or recorded expressive content.

- **Trademarks** – protect words, symbols, logos, designs, and slogans that identify & distinguish products or services.

- **Trade Secrets** – protect confidential business information.

What is a Patent?

- A grant from the government of the right to *prevent others* from making, using, offering to sell, selling, or importing the invention(s) claimed in the patent.
- Personal property – can be bought, sold, licensed, bequeathed, mortgaged, assigned.
- Limited Term – 20 years for utility and plant patents; 14 years for design patents.
- Territorial – must obtain patent in every country where protection is desired.
- United States Patent and Trademark Office (USPTO) – tasked with examining US patent applications and granting US patents.

Purposes of the Patent System

- Protect Entities Engaged in Development of Inventions
- Encourage Inventions
- Promote Commercialization and Application of Invention
- Provide a Technology “Database” Available to All

Why Get a Patent?

- To gain entry to a market.
- To exclude competitors from market.
- To use as bargaining chips to exchange with other companies for use of their intellectual property.
- To generate revenue by way of royalty payments.

Common Patent FAQs

FAQ #1

"I own a patent. Can I practice the invention that is claimed in the patent?"

- **Not necessarily**
- **A patent grants the patent owner the right to prevent others from making, using, and selling it to others.**
- **It is a negative right; not an affirmative right to practice the invention.**
  - If making the claimed invention infringes someone else's patent, then the patent owner cannot make, use, or sell his own invention without the permission of the other patent's owner.
  - The invention may be illegal to sell (an unapproved drug?).
- **Tip - conduct a Freedom to Operate (FTO) study prior to practicing any technology**

FAQ #2

"Can I patent my invention and also protect it as a trade secret?"

- **No**
- **A patent, by definition, is a public disclosure in exchange for the exclusionary right.**
- **That for which a patent is sought cannot also be maintained as a trade secret.**
- **Tip – Consider the following non-exhaustive factors**
  - Is my invention "visible"?
    - **Yes → patent; No → trade secret**
  - Are others working to solve the problem that my invention solves?
    - **Yes → patent; No → trade secret**
  - Will my invention provide a competitive advantage for a long period (> 20 years) or short period?
    - **Long → trade secret; Short → patent**

FAQ #3

“A patent I know is about to expire. Am I free to practice that technology?”

- **Depends**
- **Just because one patent has expired, it doesn’t mean that the same patent owner or other patent owners do not have other patents on similar or related technology.**
- **Tip - conduct a Freedom to Operate (FTO) study prior to practicing any technology**

FAQ #4

“Despite extensive research, I’ve never found a product like my invention on the market. Does that mean my invention is patentable?”

- **Not necessarily**
- **Whether or not a similar product is “on the market” is not the test for patentability.**
- **To qualify for patent protection, the invention must be new, useful, and non-obvious.**
- **All publicly available information can be used to deny a patent.**
- **Tip – Perform a patentability analysis before pursuing patent protection**
  - Hire a good patent attorney. You are listening to two of them! ☺

FAQ #5

"To get a patent, all I need to do is fill out a form and send it to the Government, right?"

- **No**
- **Simply filing a patent application does not guarantee a patent.**
  - Be wary of anyone who says otherwise!
- **A filed patent application may publish. But, a published application is not a patent.**
- **After filing a patent application, years of back-and-forth with the USPTO examiner ("patent prosecution"), typically with all claims rejected at least once.**
- **Tip – hire a good patent attorney, even though an inventor can pursue patent protection on their own**

Types of US Patent Applications

Types of Patent Applications

- **Provisional**
- **Utility (Non-provisional)**
- **Patent Cooperation Treaty (PCT) application**
- **Design Application** – protects the *ornamental features* of an object; not nearly as common as utility applications.
- **Plant Application** – protects distinct and new varieties of plants that are asexually reproduced.

Provisional Application

- Never examined, never will issue as a patent.
- Automatically expires in 12 months.
- Think “place holder” for priority date.
- Provides 12 months to further refine the invention (BUT added matter only gets the new date!).
- Must be “re-filed” as a Utility or PCT application within 12 months of filing date to maintain priority date.
- Claims of later filed Utility must be fully supported by provisional application to be entitled to filing date of the provisional application.
- Tip – file comprehensive provisional application if possible.

Why File a Provisional Application

- **Provides 12 additional months to refine the invention before filing a utility application.**
- **Allows additional improvements made within those 12 months to be rolled into a single utility application and a single PCT application.**

Utility Application

- **Application that is examined by the USPTO and may ultimately be granted as a patent.**
- **Protects the functional or structural (*not ornamental*) aspects of an invention.**
- **This is the text that may ultimately be granted as a patent (after possible amendments to the claims).**
- **After filing, no substantive changes can be made without risking a "new matter" rejection.**
- **During pendency of a "parent" utility application, one can file "continuing applications" such as a:**
  - *Divisional* - same specification as parent but different invention
  - *Continuation* - same specification and general invention as parent
  - *Continuation-in-Part* - specification has added matter

PCT Application

- International “place holder” for filing date.
- PCT must be filed within one year of priority application.
- Does not issue as a patent.
- Applicant must eventually proceed with actual filings in countries of interest (“national phase” filings) (153 PCT contracting states).
- The granting of patents remains under the control of the national or regional patent Offices.
- Convenient way to keep options open globally before deciding in which countries to pursue applications.

Why File a PCT Application

- **Advantages of the PCT route:**
  - Defers expenses while preserving priority date for up to 30 months.
  - Allows time to assess marketability and patentability before making significant patent filing investments abroad.
  - An International Search Report and International Preliminary Report on Patentability are provided.

- **Disadvantages of the PCT:**
  - Additional cost of filing the PCT application.
  - Delays start of prosecution, so may delay issuance of patents.

Anatomy of a Patent Application

Anatomy of a Utility Application

- **Specification**
  - Written description of the invention
  - How to make and use
  - Abstract (short summary)
  - Can contain figures (important for devices)

- **Claims**
  - Purpose of the specification is to support the claims (e.g., teach how to make and use).

Anatomy of a Utility Application

- Title of Invention
- Cross-Reference to Related Applications
- Statement Regarding Federally Sponsored Research or Development (*if applicable*)
- Reference to Sequence Listing, a Table, or a Computer Program Listing Compact Disc Appendix (*if applicable*)
- Background of the Invention
- Brief Summary of the Invention
- Brief Description of the Drawings (*if any*)
- Detailed Description of the Invention (including Examples)
- Claims
- Abstract
- Drawings (*if any*)

Claims

Patent Claims

- **Most important part of the application**
  - The patent claims define the subject matter protected
  - Thus, to secure broadest rights, claims must avoid *unnecessary* limitations
- **Must define an invention that is novel and non-obvious.**
- **Define what patentee can prevent others from making, using or selling.**
- **Whole purpose of the application: support the claims.**
- **Must be clear enough for skilled practitioners to determine whether a process/product would infringe.**
- **Claim language is unusual.**

Anatomy of a Patent Claim

Independent and dependent Claims.

Claims 1 and 2 are independent claims.

Claim 3 is a dependent claim.

1. A chair **comprising** a seating surface, four legs, and a back.
   - Preamble - “A chair”
   - Transitional Phrase - “comprising” / “consisting of”
   - Body - “a seating surface, four legs, and a back”
2. A chair **consisting of** a seating surface, four legs, and a back.
3. The chair of claim 1, wherein the back is made of wood.

Classes of Claims

- **Apparatus -** Directed to what the invention is (product) not what it does
- **System** - Directed to a combination of multiple devices
- **Method** - Directed to a way of doing something
- **Composition of matter -** Directed to products where the chemical nature of the substance or materials used, rather than the shape or form of a product, is the distinguishing characteristic
- **Product-by-process -** a product, but recite the steps of the process that create the product

Requirements for Patentability in the US

What are the Requirements for Patentability?

Must comply with the:

- Statutory Subject Matter Requirement—35 USC § **101**
- Utility Requirement—35 USC § **101**
- Novelty Requirement—35 USC § **102**
- Non-Obviousness Requirement—35 USC § **103**

- Written Description Requirement—35 USC § 112**(a)**
- Enablement Requirement—35 USC § 112**(a)**
- Best Mode Requirement—35 USC § 112**(a)**
- Definiteness Requirement—35 USC § 112**(b)**

The Statutory Subject Matter Requirement

- **Requires that the invention fall into a category that Congress has designed the patent laws to protect.**

- **US law specifies four categories of patent-eligible subject matter:**
  - process (or method)
  - machine
  - manufacture
  - composition of matter

Statutory Subject Matter

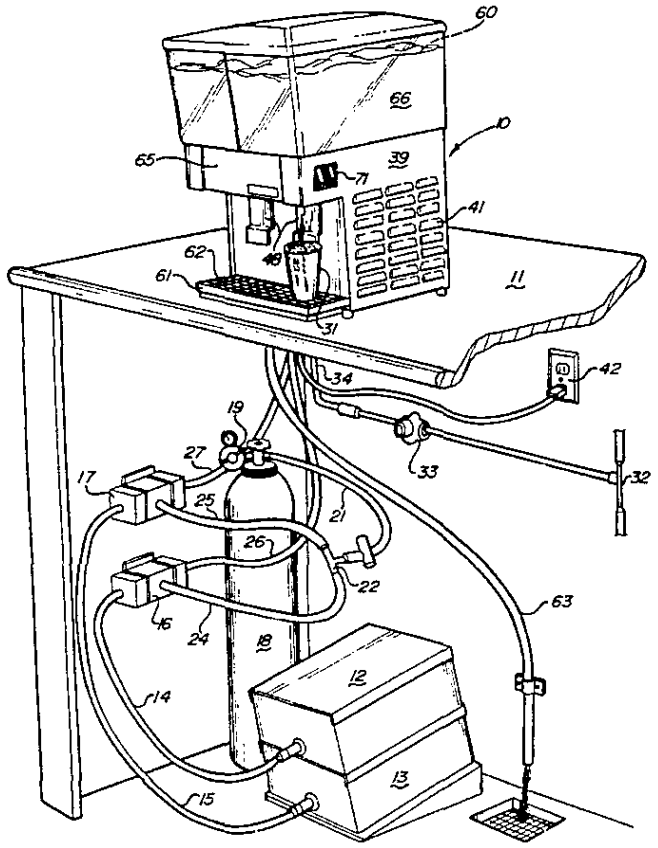
- **Court interpretations of the statute have defined the limits of patentable subject matter and there have been major changes/tightening over the few years.**

- **Judicially created exceptions to those four categories:**
  - Product of Nature
  - Laws of Nature
  - Natural Phenomena
  - Abstract Ideas

- **A claim that falls within one these exceptions is not valid.**

The Utility Requirement

- **Requires that the invention be “useful.”**
- **Use must be specific, substantial, and credible.**
- **Low bar**
  - *Juicy Whip, Inc. v. Orange Bang, Inc.*



The Novelty Requirement

- **Requires that the invention not be in the public domain prior to the filing of the patent application:**
  - Patenting of the invention
  - Publication of the invention
  - Public use of the invention
  - Sale or offer for sale of the invention
- **File priority application before any public disclosure, or use, or sale, or offer for sale ("bar dates").**

The Novelty Requirement

- **Public Disclosure and Grace Period**
- **An inventor's public disclosures will not preclude a patent in the US, if the patent application is filed within one year of the disclosure.**
  - AKA the "grace period"
  - An inventor's public article and speeches are not prior art if made within one year of patent application.
- **But rights may be lost abroad!**
- **Best practice is to file a patent application before any public disclosure occurs!!!**

The Novelty Requirement

- **Typical bar date triggers:**
  - Journal articles
  - Product release brochures
  - Conference presentations, abstracts
  - Disclosures not protected by non-disclosure agreement (NDA)
  - Website postings
  - Selling/Offering for sale (even under a secrecy agreement)

The Non-obviousness Requirement

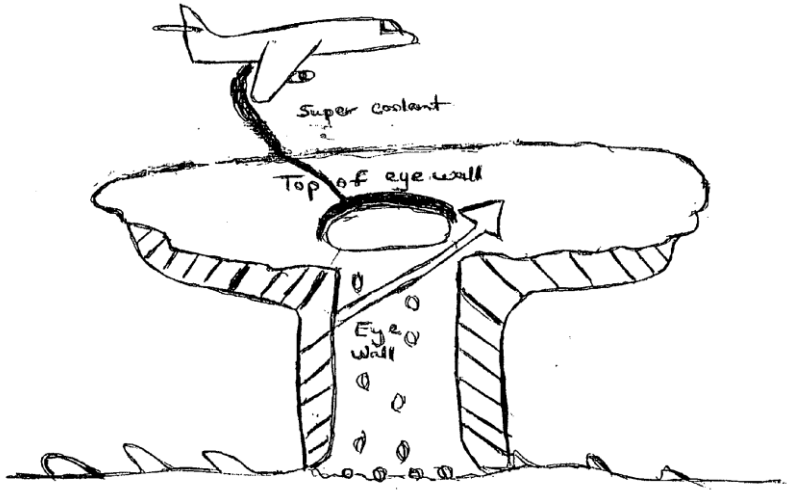
- Even if novel, invention is not patentable if it differs from the prior art only by way of an “obvious” modification.
- “Obvious” means obvious to a person of ordinary skill in the art at the time the invention was made.
- Keeps inventor from claiming something that is not inventive over something belonging to the public or someone else.
- Highly subjective.

The Written Description Requirement

- Requires the specification to describe the invention in such a way as to prove the inventor was in possession of the full scope of the invention.
- Keeps inventor from overreaching and claiming at a later time more than he/she actually had in-hand at time of filing.
- Can be more difficult to satisfy for inventions in unpredictable fields (e.g., pharma, biotechnology).

The Enablement Requirement

- Requires the specification to teach one of skill in the art how to make and use the invention without undue experimentation.
- Inventor should describe how to practice the invention – no "hiding the ball."
- Frequently an issue for the "unpredictable arts" (biology and chemistry), especially for unproven methods of treatment.



The Best Mode Requirement

- **Must describe the best way of performing the invention.**
- **Public entitled to the best way you know of at the time of filing – quid pro quo.**
- **AIA implications**
  - "failure to disclose the best mode shall not be a basis on which any claim of a patent may be cancelled or held invalid or otherwise unenforceable"

The Definiteness Requirement

- **Requires a patent's claims to inform those skilled in the art about the scope of the invention with reasonable certainty.**
- **Defines the metes and bounds of the invention such that a person reading the claims would reasonably know what is being protected.**

Prosecution in the US

General US Prosecution Outline

- File Application
- Possible Formality Issues – Notice to File Missing Parts and Possible Restriction Requirement
- First Examiner's Office Action
- Applicant's Reply to First Office Action
- Final Examiner's Office Action
- Applicant's Reply to Final Office Action
- Conclusion of Prosecution (allowance or abandonment)

Prosecution of US Application

- **(1) File application and complete any formalities, including filing an Information Disclosure Statement disclosing all pertinent prior art of which the applicant is aware.**
- **(2) Examiner may insist on splitting multiple inventions into separate applications (divisional applications) before examining each ("Restriction Requirement").**
- **Restriction Requirements – One invention per application**
  - If two or more inventions are claimed in a single application, applicant will be required to elect one invention for examination.
  - The other inventions may be pursued in a divisional application – aka a "child" application.

Prosecution of US Application

- **(3) First office action rejects the claims on various grounds**
  - PTO will perform a prior art search.
  - The applicant is notified in writing of the examiner's decision.
  - Sets forth reasons for adverse action, objection, or requirement.
  - Claims may be rejected.
  - It is common that some or all of the claims are rejected on the first office action by the examiner; relatively few applications are allowed as filed (AKA a "first action allowance").

- **Either the examiner or the applicant can request a telephone or in-person interview to discuss and resolve the issues.**

Prosecution of US Application

- **(4) Applicant responds to each ground of rejection with arguments, factual evidence, and/or amendments to the claims and/or specification, as appropriate.**

- **(5) If examiner was not fully satisfied by Applicant's response, she will send a second office action, most likely final, explaining what issues remain.**

Prosecution of US Application

- (6) Various options after final action, including appeal.
- (7) Eventually prosecution concludes with either an allowance of all claims still in the case, or abandonment.
- (8) After allowance, applicant pays the issue fee and the patent issues.
- On average it takes 2-3 years to obtain an issued U.S. patent in from the date the utility application is filed. Varies depending on the art unit and the examiner the application is assigned to at the USPTO.
- US Utility Patents have a 20 year term, calculated from earliest claimed non-provisional (i.e., U.S. Utility or PCT application) priority date.

Thank You!

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