INTRODUCTION

Patent Policy: patent law seeks to reward the creator of a useful thing, in hopes that society will yield more useful things.

Constitution, Article I, Section 8: authorized 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."

Patent Structure: has a ***specification*** which discloses a *written description* of the invention, the manner and process of using it (*enablement*), and the *best mode* to carry out the invention. The ***claims*** of a patent are the most important part, which defines the patentee's rights.

Right to Exclude: patents give an inventor the right to exclude others from using or selling the invention. The 3 types of patents include *utility*, *design*, and *plant patents*.

International Law: TRIPS made uniform rules for IP protection. New rule is that protection runs 20 years from the date of application.

PATENTABLE SUBJECT MATTER

§101: "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…"

What is patentable: "anything new under the sun that is made by man." Diamond.

Laws of Nature and Abstract Ideas: prohibited categories of patents include: phenomena of nature, mental processes, abstract intellectual concepts, a principle or fundamental truth, or an idea of itself.

Algorithms: a practical application of a mathematical algorithm, formula, or calculation that produces a useful, concrete, and tangible result is patentable. State Street.

UTILITY § 101

§101: requires *usefulness* (utility) to receive patent protection. The minimum threshold is that the invention *has to do something*. There are three major issues concerning utility: *practical* or *specific* utility (actual), *beneficial* utility (to society), and *operability* (invention does what claim says it will do).

Low Threshold Requirement: "All that the law requires is that the invention should not be frivolous or injurious to the well-being, good policy, or sound morals of society." Lowell.

Identifiable Benefit: The threshold of utility is not high; all it has to do is provide some *identifiable benefit*.

DISCLOSURE / ENABLEMENT § 112

§112 Disclosure: "The specification shall contain a *written description* of the invention, and of the *manner* and *process of making* and *using* it…"

Adequate Disclosure Requirements: (1) enablement, (2) written description, (3) definiteness of claims, and (4) best mode.

ENABLEMENT

Enablement: requires that the specification teach those with ordinary skill in the art to make & use invention *w/out undue experimentation.*

Undue Experimentation: the description is vague and uncertain so that no one can tell, except by independent experiments, how to construct the patented device. Voids patent.

Undue Breadth: the scope of enablement must be at least roughly commensurate with the scope of the claims. i.e. don't claim *too* much.

Scope of Enablement: what is *disclosed in the specification* plus what would be *known to one of ordinary skill in the art* without undue experimentation.

Timing for Enablement: inventors are required to establish enablement for their claims as of the date that the *application is filed.*

WRITTEN DESCRIPTION

Purpose: to recognize what invention is claimed and to show that the *inventor had possession* of the invention at the date of application.

Chemicals & DNA: require a *more precise description*, such as structure, formula, etc.

Drawings Alone: may be sufficient to satisfy this requirement, so long as one skilled in the art can use it. Used mostly in *design* patents.

DEFINITENESS OF CLAIMS

Policy: puts limits on what is protected. People will know what they can safely use. Provides the "meets and bounds" of patent protection.

Definite-Enough Test: whether one skilled in the art would understand what is claimed when the claim is read in light of the specification. Compliance is a *question of law*.

Reading Limitations into Claim: if the language in the claim is clear, then don't read in from the specs. If language is unclear, look at the specification for limitations.

Vague Terms: will render a patent invalid; preventable by defining all terms in specs and then use consistently. (e.g. partially vs. slightly)

BEST MODE

§112: "the specification shall set forth the best mode [BM] contemplated by the inventor of carrying out his invention."

Policy: against selfishness. If inventor knows the best way to use the invention, he should not conceal it and require the public to hunt for it.

No Updating: one may not change the BM.

NOVELTY § 102

§102: requires something new in order to get patent protection (a *quid pro quo* for society).

Prior Art: anything in existence before the date of invention (also called a "reference"). The affect of a reference may lead to an *anticipation* of the current invention.

Anticipation: that which infringes, if later, would anticipate if earlier.

Identity Requirement: an invention is not anticipated unless a *single piece of prior art* (a single reference) discloses (expressly or inherently) the *identical* (every element) invention.

Accidental/Unknown Anticipations: do not count as anticipations because they give nothing to the world. The inventor is still protected.

Enabled Reference Requirement: a prior art reference cannot anticipate unless the reference is enabling (adequate directions w/in 4 corners).

Structure/Product Patents: scope is broad, covering even unforeseen uses. This broad protection implies broad anticipation.

New Use (Process) Patents: under §100(b), new use patents are called process patents.

§102(a) – Known / Used by Others

§102(a): "No patent if, before the date of invention, the invention was *known* or *used by others in this country* or if, before the date of invention, the invention was *patented* or *described* in a printed publication *anywhere*."

Corroboration Rule: says you can't have oral testimony of a prior art; must have exhibit.

Used By Others: needs to be *open* (not secret) and *in the ordinary course of activities*.

Global Inquiry: looks at printed publications and foreign patents. (e.g. Internet descriptions)

Global Date of Publication: a publication becomes public when it becomes available to at least one member of the general public (publisher not a member of the general public).

Secret Foreign Patents: do not bar inventors in the U.S. Patent must be available to the public.

§ 102(e) – Secret Prior Art

Function: permits publicly available material to be backdated to a time prior to public disclosure (i.e. fiction that patent issued on filing date).

Applications Can Anticipate: because the first to apply is giving the best evidence of first to invent. Application must be granted for the rule to "kick in" and become effective.

§ 102(f) – Derivation from Another

Rule: no one is entitled to a patent if the invention was derived from someone else's work. One must be the inventor (the one who conceived) to get a patent on the invention.

Shop Rights: exist in the employer of an employee-inventor.

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