The Basics of Patent Law

You have invented something that you think could make you rich. The word “patent” comes to mind. Should you get one? Can you get one? How do you get one? While the answers to these questions can be complicated, the following general overview may assist you in deciding whether to pursue your dream with the United States Patent and Trademark Office.

A patent is a grant issued by the U.S. government to an inventor. It gives the inventor the right to exclude others from using, making or selling an invention for a period of 17 years. (Patents for plants and for design—i.e., appearance only—are issued for a shorter period of time.) In short, a patent gives an inventor the right to sue others to protect his interest in his invention; it is not a guarantee of financial rewards. After obtaining a patent, it is up to the inventor to exploit his invention for financial gain and to take steps to keep others from doing so without his permission.

The right granted by a patent is considered to be the inventor’s intangible personal property. An inventor, therefore, can sell, mortgage, license or will his patent to his heirs.

What Inventions Can Be Patented?

Patent protection is given to “[w]hoever invents or discovers any new and useful process, machine, manufacturer, or com-

position of matter, or any new and useful improvement thereof, ...”

The word “process” refers to a method for doing something. The phrase “composition of matter” refers to the chemicals or ingredients that make up something. The United States Su-

preme Court has interpreted this statutory description of patentable subject matter broadly, holding that it includes “anything under the sun that is made by man.”

What is excluded under this definition? Material in its natural state (e.g., oxygen); principles or laws of nature or scientific truths (e.g., gravity); mathematical expressions of scientific truths (e.g., calculation for the volume of a square); and phys-

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ical phenomena (e.g., lightning) are not patentable. Put another way, patents are given for what did not exist before and not for bringing to light what existed but was not known.

Also, ideas in themselves are not patentable. What is patentable is the physical exploitation or concrete embodiment of an idea. In short, there must be some tangible thing—a product or a process.

Although anything under the sun made by man is potentially patentable, to qualify for a patent, an invention must meet three criteria: It must be new, useful and nonobvious.

To qualify as “new,” an invention must not have been known or used in the United States and must not have been patented or described in a printed publication anywhere in the world. Knowledge and use in the United States means public knowledge and use: A patent is not precluded because someone had prior knowledge of or used the invention in secret. The courts, however, have interpreted “printed publication” broadly, saying that this includes not just a printed document but also microfilm, slides, photographs, computer tape and any other fixed, tangible media. The key is not how the information was recorded but rather whether the public had access to it.

Courts, when deciding questions of novelty, often state that the claims asserted by the inventor for his invention must be compared to the “prior art”—meaning that all the technical information available in the field to which the invention pertains.

To qualify as “useful,” an invention must be capable of performing some beneficial function that the inventor claims for it. While some benefit is required, the USPTO and the courts are not concerned with measuring the degree of usefulness. Interestingly, an inventor does not need to know why his invention works, just so long as it does work in some way!

To qualify as “nonobvious,” an invention cannot involve changes so trivial as to be readily apparent to those of ordinary skill in the field in question. A person with “ordinary skill” is one who has the ability to understand the technology and to make modest adaptations or advances. Notably, just because an invention is simple does not mean it is obvious.

Many inventors successfully have proven the “nonobviousness” of their inventions with evidence showing one or more of the following: the invention is a commercial success; the invention provides a feasible solution to a long-standing problem in the field that others have failed to solve; competitors are willing to purchase a license for the invention; experts in the field were skeptical of the invention working; the invention has received praise or awards; and/or competitors have copied the invention.

How Does an Inventor Get a Patent?

With the assistance of a patent attorney or a patent agent, an inventor obtains a patent by filing an application and fee with the USPTO. An inventor must hire a patent attorney or patent agent because they are the only individuals who can represent the inventor before the USPTO, and because of the expertise required to understand an invention and its relationship to the prior art in the field.

The application has three parts: a specification, a drawing (if necessary) and a signed oath. The specification portion is a detailed technical description of the invention that includes at least one “claim.” A “claim” is not an assertion of the benefits or advantages of the invention but rather the words that set out the metes and bounds of the property to be protected, like the legal description of a piece of real property. The claim portion of the specification is the most critical part of the application, since the USPTO and the courts use the inventor’s claim(s) to compare with the prior art to determine the patentability of the invention and to compare with the activity of a competitor to determine whether or not an infringement of the patent has occurred.

While the filing fee for a patent application varies based on the number and type of claims an inventor asserts, the base fee currently is $500. However, if the inventor qualifies as a small business under the Small Business Act, or if the inventor is an individual, the fee is half this amount.

After an inventor files his application and fee, the USPTO assigns an examiner to conduct an independent study of the invention described and to make a decision on the merits of granting a patent. The examiner’s review can take up to nine months. If the examiner grants the application, the inventor must pay another fee, currently $820, to have the patent issued. If the examiner refuses the application, the inventor may appeal the examiner’s decision to the Board of Patent Appeals and Interferences to be considered by a three-member
panel of examiners. The inventor can appeal an adverse decision by the Board of Patent Appeals and Interferences to the United States Court of Appeals for the Federal Circuit or the United States District Court for the District of Columbia.

**Can an Inventor lose His Right to a Patent?**

An inventor can forfeit his right to a patent if the inventor permits his invention to be used by the public or to be put on sale in the United States more than one year prior to the date of his application for a patent. The purpose of this provision is to encourage inventors to promptly apply for a patent.

Importantly, if the invention is a process or a device that the inventor has kept secret, but the inventor permits an article to be sold that is prepared using his secret process or device, the law considers the process or device itself to have been subject to a public use or sale. Moreover, forfeiture occurs when an invention is offered for sale, even if no sale ever takes place.

The law, however, does permit an inventor to test his invention even if the test is publicly performed. For example, in one case an inventor who had created a particular type of paving tested his invention on a toll road used by the public for six years before he applied for a patent. The court considered this to be a legitimate experimental use, since performance over time was an important consideration for this product.

**If You Think You Have a Patentable Invention, What Precautionary Measures Can You Take to Protect Your Right to a Patent?**

If you think you have an invention that can be patented—it is new, useful and nonobvious—and have not yet filed an application with the USPTO, you should consider taking certain precautionary measures to protect your right to a patent.

First, you should take steps to prevent premature public disclosure of your invention which could destroy your right to a
patent. Limit the number of people with whom you share your invention and notify each such person of his confidential relationship with you and his duty to not disclose or misuse your invention.

Second, document the development of your invention so that you can establish your priority in the event of rivals seeking a patent for the same or a similar invention. Also consider keeping a journal with signed and dated entries describing your progress.

Third, once you have developed your invention sufficiently, summarize your invention in writing on a single sheet of paper with the date, your signature and the signature of a witness. Then fold and seal the paper, address it to yourself or your attorney and mail it so that the postmark can establish the priority of your claims over later claims.

Finally, consider hiring a law firm that specializes in the development and marketing of patents. The yellow pages of your local phone directory should contain listings of such firms.

There are also legal directories published by various companies and the local bar association often has lists of attorneys by practice area. Requests for proposals (without obligation) can be made via the Internet at Counsel Connect (http://www.counsel.com). Your regular business lawyer might be able to provide a referral. Before you choose a firm, however, check into the background of the firm carefully. Obtain the firm’s promotional materials, ask for a fee schedule, find out what must be paid when and get references from other clients.

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