

INVENTION STARTS WITH CONCEPTION – UTILITY PATENTS

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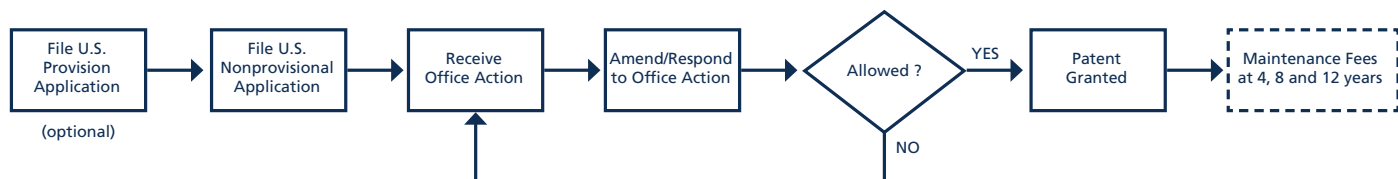


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With this article we delve into the world of protecting inventions, and in particular functional inventions that are protected by utility patents. As discussed in the earlier article, utility patents protect functional apparatuses, processes, or articles of manufacture. What does this mean? Utility patents protect the solutions that solve problems. The patent of Thomas Edison's light bulb is an example of a utility patent.

Utility patents differ from design patents, which protect how something looks. Design patents, or Industrial Designs, as they are typically referred to outside of the U.S., protect the ornamental features of your product. For this article, when we refer to a patent, we mean a utility patent.

For those who are unprepared, the process of obtaining a U.S. patent can be long, frustrating, and costly. In many ways it is like a game of chess - you need to think ahead, anticipate, and occasionally be prepared to take a high-risk move. A simplified illustration of the process is shown in Figure 1.



The workflow of Figure 1 covers only the steps involved in obtaining your initial U.S. patent. This process is repeated in each country in which you want to obtain protection. One important thing to remember about patents is that they are jurisdictional: they only provide protection in the country that grants the patent.

The first step in the process begins with you, at the conception of the invention. You had a problem to solve and came up with an idea to fix it. At that instant, you became an inventor. If you stop right there, once you show that invention to another person, that person can copy it and there is nothing you can do to stop them. This is where patents come in. Patents are a government-sanctioned monopoly that allows you to prevent others from making, using, selling, importing or exporting the patented invention.

One important rule regarding protecting inventions involves keeping the invention secret until the patent application is filed. In the U.S., once an invention has been publicly displayed or used, the inventor has 12 months to file a patent application. Once the 12-month period has expired, you are barred from obtaining a U. S. patent. This is true even if the only person you showed your idea to was your neighbor. Outside the U.S. the rules can vary, but in most non-U.S. countries, once the invention is publicly shown, then, too, you are barred from that point from receiving a patent in that country - this is true even when the public showing was not in that country. These are sometimes referred to as "absolute-novelty countries." Further, one additional rule that applies to the U.S. relates to offering the invention for sale. Like the public display rule, once an invention was offered for sale (even if the sale offer was secret), the inventor has 12-months to file a patent application. The on-sale bar rule can be a little tricky because it can apply even if the inventor has never made the invention (*Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 67–68 (1998)).

So, it is important before you show or try to sell your invention to anyone that you protect it by filing a patent application. You can certainly do this yourself, but the patent law is always changing. What was acceptable practice a few years ago may today result in a rejected patent claim or an invalid patent. Therefore, it is advisable to work with an experienced patent attorney or patent agent.

The preparation of the patent application is fairly straightforward for you. Typically, you will meet with a patent practitioner (attorney or agent) and explain your invention to them in detail. It is recommended that you provide as much information as you can in writing on how your invention works and also provide drawings. Doing this will make the

process proceed more smoothly and should reduce your costs. The patent practitioner will prepare a document with the following parts:

- Background of the Invention
- Summary of the Invention
- Brief Description of the Drawings
- Detail Specification
- Claims
- Drawings

It is important that you read your application carefully. It needs to be technically accurate and also cover the aspects of the invention that you consider important. This is your patent it needs to represent your work. Also, it needs to be complete since once the application is filed you will not be able to supplement it with additional information. Further, in some countries/regions the words that are used in the specification are the only words that you can use in claim amendments (literal support jurisdictions).

In particular, you need to spend time reviewing the claims section. The claims are what defines the scope of protection that you will receive. Think about each claim as being the description of a deed to a property. The deed to property describes the boundaries of the property. From a legal standpoint you know that someone is trespassing on your property when they cross the boundary described on the deed. The claims of the patent define the boundary on your invention. Claims are admittedly written funny. There can only be one sentence that describes the patentable elements of your invention. For example,

1. An apparatus comprising: a cylindrically shaped body having reservoir; a tip fluidly coupled to the reservoir, the tip selectively allowing a fluid from the reservoir to flow in response to the tip being

pressed against a surface; and a mechanism having a biasing member and a releasable latch, the mechanism being operably coupled to the tip to move the tip between a first position inside the body to a second position at least partially outside the body in response to releasing the latch.

As I said, claims are written funny. This claim is one way of describing a pen. It is important to talk through the claims with your patent practitioner and make sure that the independent claims have the minimum number of elements that distinguishes what is in the claim from what is taught by the prior art. Prior art is any public information, patent, technical article that is publicly available before you file your patent application. Prior art is what the examiner considers when analyzing your claims in determining whether your patent application should be granted into a patent.

A couple of other notes on claims. One issue that we sometimes run into is that inventors want the claim to be functional; however, the claim does not need to include all the elements of your invention and doing so may unnecessarily limit your patent. Rather, the claim just needs to have the minimum number of elements to distinguish it from the prior art. Also, sometimes patent practitioners will write claims in a way so that it covers multiple ways of practicing your invention. These written gymnastics may result in what appears to be an awkward claim. Talk with your patent practitioner on why something was worded in a particular way so you

understand its meaning. It is your patent, you need to understand and approve what it says.

There are several other requirements that your patent application needs to fulfill. In particular, the specification has two legal requirements: 1) enablement; and 2) best mode (note these are U.S. requirements). The enablement requirement means that you must provide sufficient detail in your specification for someone (referred to as “one of ordinary skill in the art”) to practice the claimed invention. You don’t have to provide complete details on your invention, but it should be sufficient for someone to replicate it without undue experimentation. The second requirement of best mode means that you have to disclose the best way of carrying out your invention. If the invention can be performed or made in different ways, then the best way that the inventor considers to be the best way needs to be disclosed.

That should be enough for now. Next time we will delve into the world of patent prosecution.

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