

UNITED STATES PATENTS
How They Are Exploited and Enforced

Pennsylvania Bar Institute
Intellectual Property Law Primer
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Presented by
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Types of Intellectual Property

- Patents
- Trademarks
- Copyrights
- Trade Secrets

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Patents

- United States Constitution
- Article I, Section 8
- “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.”

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Patent Protection

- Patent owners granted the right under United States patent law to exclude others from:
 - Making
 - Selling or offering to sell
 - Using
 - Importing into the USthe patented invention
- “Lawful Monopoly”

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Patent Protection (cont)

- The grant is the right to exclude
 - Not necessarily the right to practice the patented invention
 - Example: Patents on improvements to the patented invention of another
 - Has exclusive rights to improvement but cannot practice the combination of the basic invention and the improvement without permission of owner of patent on the basic invention

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Types of Patents

- Design Patents
- Plant Patents
- Utility Patents

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Design Patents

- Protects new, original and ornamental design for an article of manufacture – 35 USC §171
- Example: Desk and Hutch Combination – Des. 346,078
- Design must be novel (35 USC §102) and non-obvious (35 USC §103)

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Plant Patents

- Asexually reproduced new variety of plants - 35 USC §161
- Example – Variety of Geranium Plant Named "EVKA" - Plant 10,954
- Grant includes the right to exclude others from asexually reproducing the plant and from using, offering for sale, or selling the plant so reproduced - 35 USC §163

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Utility Patents

- Most common type
- Granted for any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof
- Includes, for example, chemical, mechanical, electrical, biological, pharmaceutical and business method patents

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Requirements for Patentability

- **Novelty (35 U.S.C. 102)**
 - The invention must be new
 - *Diamond v. Diehr*, 450 U.S. 175 (1981)
- **Utility**
 - The invention must be useful
 - No perpetual motion machines
 - *In re Speas*, 273 Fed. Appx. 945 (Fed. Cir. 2008)
- **Non-obvious (35 U.S.C. 103)**
 - Must not be obvious to one of ordinary skill in the art to which the invention pertains
 - *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007)

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Acquisition of US Patent Rights

- **Application for patent**
 - In 2010, patent applications filed - 520,277
- **Examination of Patent Application**
 - In 2010, average first action pendency – 25.7 months
- **Grant of patent**
 - In 2010, patents granted - 244,341

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Application for Patent

- **Must be filed by:**
 - The inventor,
 - A registered patent agent, or
 - A registered patent attorney
- **Contains**
 - Specification including claims
 - Drawing
 - Abstract
 - Declaration of inventor
 - Fees

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▪ Sample Patent

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Specification

- Contains a written description of the invention
 - Enablement
 - Best mode
- Claims
 - The metes and bounds of the claimed invention
- Abstract
 - Brief description of the invention
 - May not exceed 150 words

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Examination

- Conducted by PTO patent examiner
 - Examiner technically knowledgeable
- Examiner makes sure that claimed invention meets the statutory requirements for patentability
- Examiner performs independent search of prior art
 - Official Action
- Examiner allows claims if they meet the requirements for patentability

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Grant of Patent

- Patent granted following issuance of Notice of Allowance and payment of issue fee

- Patent Term
 - Design Patent – 14 Years from date of grant
 - Plant Patent – 20 years from application filing date
 - Utility Patent – 20 Years from application filing date

- Term is subject to timely payment of maintenance fees

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Questions

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