



# Patents

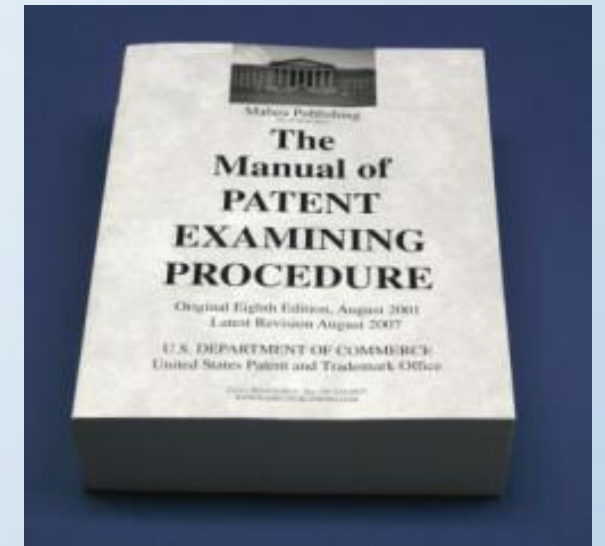
Law 115 | Week 6 | Lecture 13  
Rachael Vaughn

# Agenda

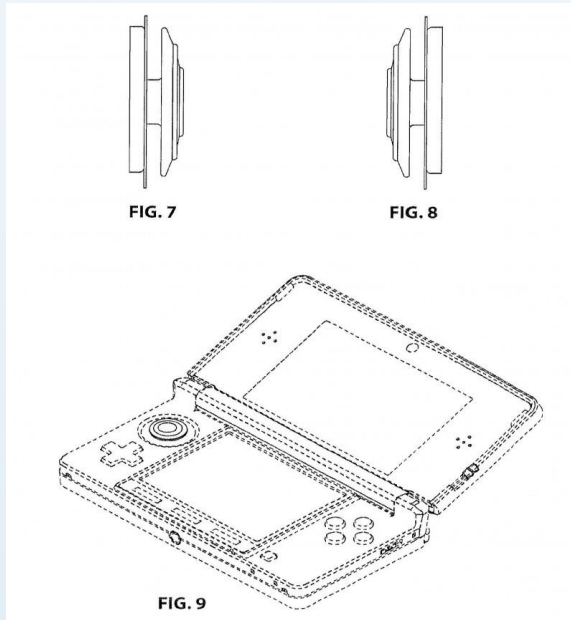
1. Origins of Patent Law
2. Types of Patents
3. Applying for a Patent
4. Claims are the Name of the Game
5. Requirements for Patent Protection
  - a. Statutory Subject Matter
  - b. Novelty
  - c. Obviousness
6. Example

# Origins of Patent Law

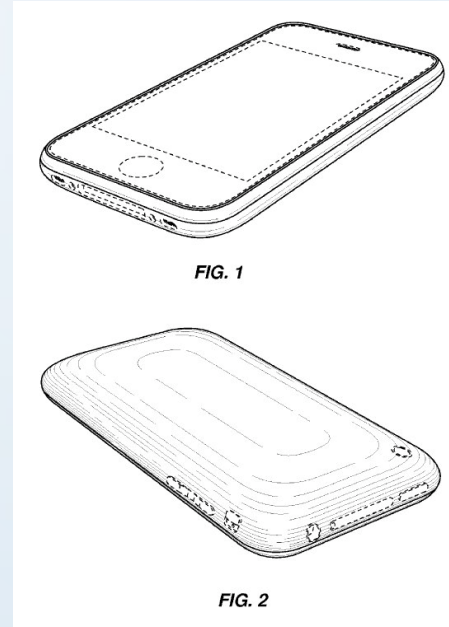
- Romans did not have patent system, but they invented many things
- Ancient Greeks → monopoly for one year
- **U.S. Constitution Article I, Section 8, Clause 8:** Congress is authorized “to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”
- **Federal law:** 35 U.S.C., 37 C.F.R., MPEP (Manual of Patent Examining Procedure)
- America Invents Act



# Types of Patents



Utility Patents



Design Patents



Plant Patents

# Requirements for Patent Protection



Patents are the **only** type of IP that requires a government grant. To receive protection, an idea must...

1. **35 U.S.C § 101:** Fall into at least one category of statutory subject matter
2. **35 U.S.C § 101:** Have utility (be useful)
3. **35 U.S.C. § 102:** Be novel (not disclosed in the prior art)
4. **35 § 103:** Be nonobviousness to a person having ordinary skill in the art ("PHOSITA") or comprise an "inventive step"



# Claims are the Name of the Game

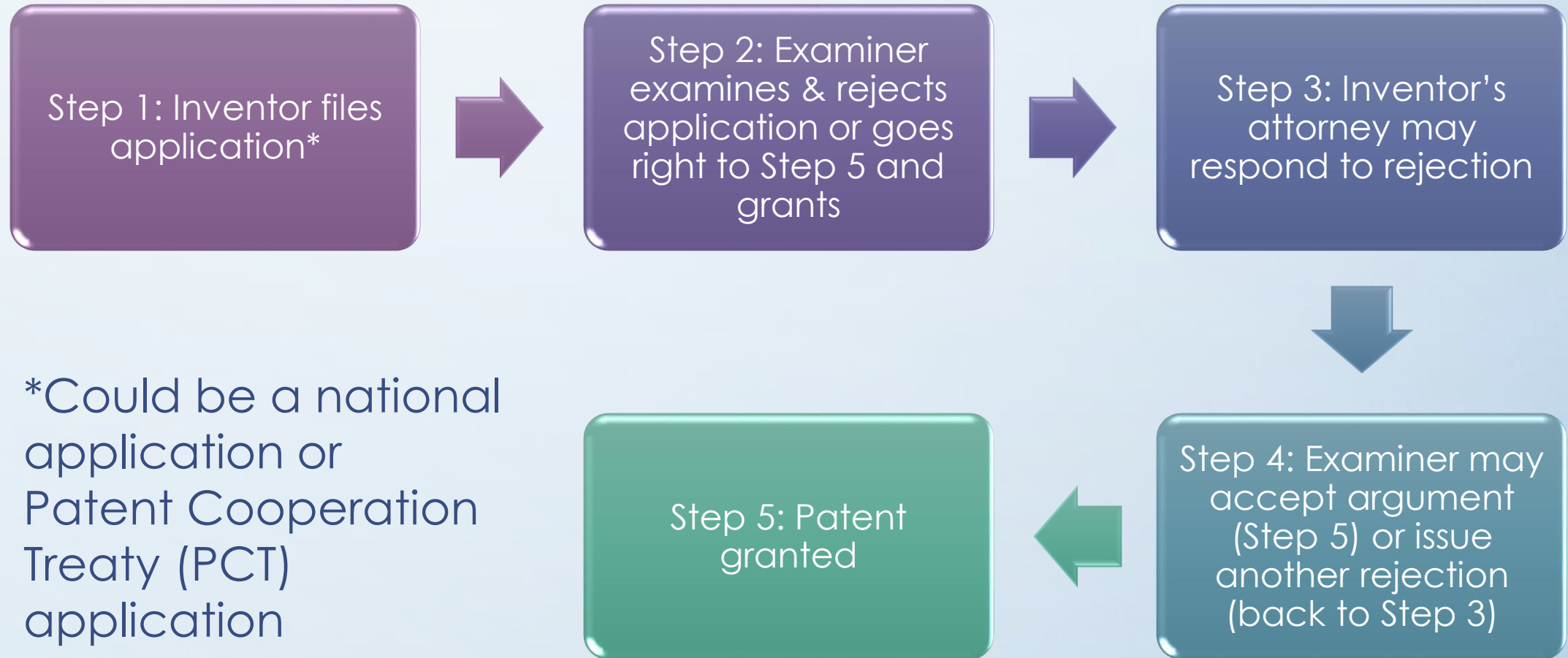
A patent covers a family of similar things defined by a “claim”



**Example:** A vehicle comprising:

- a) A chassis
- b) A plurality of wheels attached to the chassis; and
- c) An engine mounted on the chassis for turning of one or more of the wheels.

# Applying for a Patent



# Statutory Subject Matter

The following are statutory classes of subject matter that are protectable under the patent system...

- Articles of manufacture
- Machines
- Methods (of making or using substances or articles)
- Compositions of matter





# Statutory Subject Matter



The following **cannot** be protected under the patent system...

- Abstract ideas
- Laws of nature
- Written material where novelty is in the meaning of the words

Business methods and software patents can be statutory subject matter after *In re Bilski*.

# Novelty

Each patent has an effective filing date (EFD). To determine whether a patent covers a novel idea, an examiner will determine whether the exact invention claimed was described before the effective filing date in the prior art. Examples of prior art include...

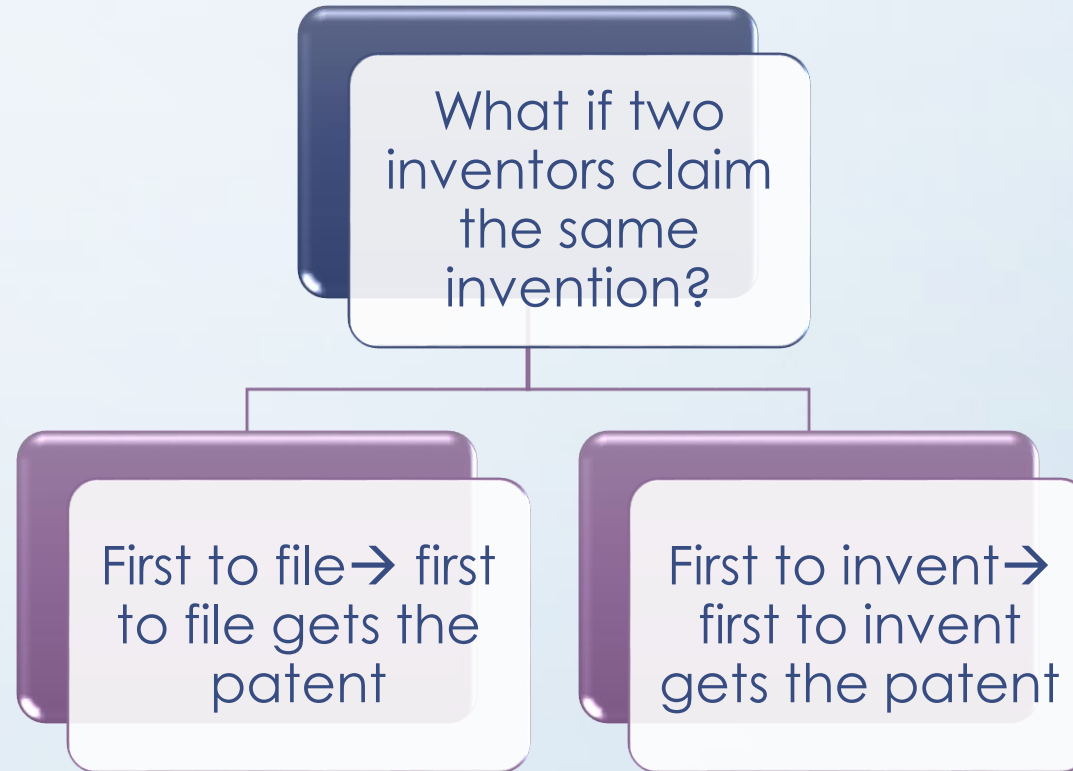
- Printed publications from third parties
- Other patent applications
- Public disclosure from third parties
- Inventor's own public use, sale, or disclosure



First Inventor to File:

[http://www.youtube.com/watch?v=fR3aW69St4o&feature=player\\_embedded](http://www.youtube.com/watch?v=fR3aW69St4o&feature=player_embedded)

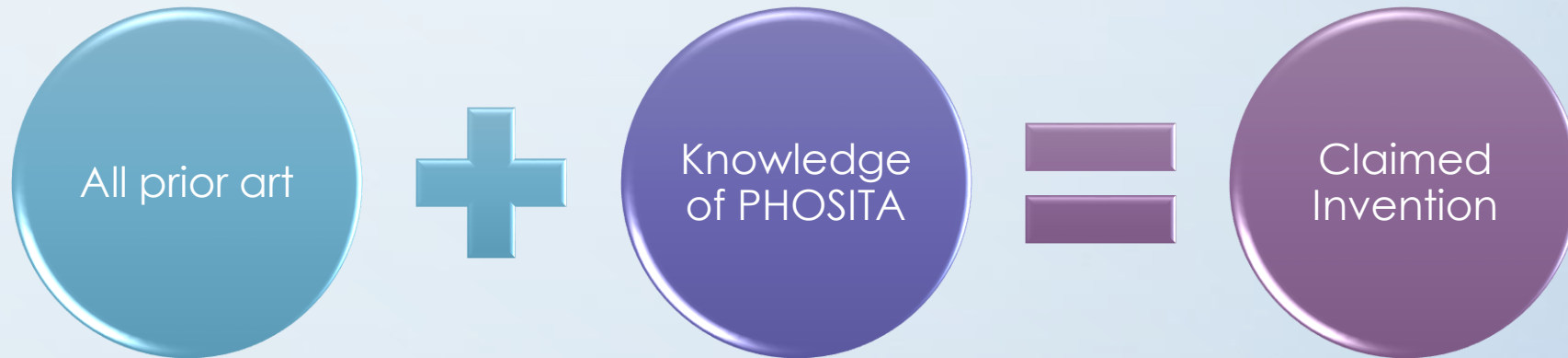
# Novelty



As of March 2013, the United States will be a ***first to file*** system.

# Obviousness

- Usually the biggest issue in litigation and USPTO proceedings
- For a claim to fail under novelty, all features must be found in a single prior art reference



# Obviousness

An inventor may rebut an obviousness rejection by arguing that a ***PHOSITA would never combine the prior art to arrive at the claimed invention*** because...

- The prior art teaches away from the claimed invention
- The examiner proposed combining the prior art in a way that would destroy the intended purpose of the references
- A number of other reasons

**Secondary indicia of non-obviousness:** commercial success, fulfillment of a long-felt need, doubt by experts, adoption in the industry



# Example

Tony Stark invents a new type of power source in a cave in Afghanistan. His new invention called the arc reactor consists of an electromagnet component and a power component. It is particularly useful for preventing pieces of shrapnel from piercing Tony's heart, but also has other applications for providing power.

1. What type of patent could Tony file?
2. What would Tony have to show to get the patent allowed?
3. What could he claim?

