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# Intellectual Property (Quick Study: Law)

AMERICA'S #1 LEGAL REFERENCE CHART

## INTELLECTUAL PROPERTY

### PATENT LAW

#### MAIN SOURCES OF THE LAW

- The U.S. Constitution (Art. I, §8, cl. 8) confers upon Congress the power "to promote the progress of science and the useful arts, by securing for limited times to inventors the exclusive right to their discoveries"
- Federal statutes (35 U.S.C., 4809 et seq.)
- Federal regulations (37 C.F.R., 41.1 et seq.)
- Federal judicial precedents

#### WHAT IS A PATENT?

- A patent is a "negative right," limited upon issuance to exclude others from making, using, selling, or importing that which falls within the "claims" of the patent
- The patent holder may exploit a patent but may not infringe the rights of other patent holders
- A patent generally enjoys a non-renewable 20-year term, an extension of up to 5 years is based on U.S. Patent and Trademark Office (USPTO) delays
- In comparison, trade secret protection applies to inventions until they are made public; trade secret law protects against others misappropriating the invention but not against others who "independently conceived" of the same invention

#### WHAT IS PATENTABLE?

- Any new, useful process, machine, article of manufacture, or composition of matter or any new, useful improvement is patentable (35 U.S.C. §101)
- Includes:
  - Process: Including business, artificial intelligence, and mathematical processing-related inventions
  - Product: A composition of matter, a manufactured item (mechanical, product of human effort), a machine, or a non-naturally occurring plant
  - Design: The nonfunctional aspects of objects of utility (e.g., automobile ornaments)
    - Useful: Inventions to "ornament" articles of utility
  - Limitations: Terms of design patent is shorter (14 years)
    - Lines of color, texture, shading, ornamental designs or ornaments, and things that are copyrightable (generally) are not patentable

#### ANALYZE PATENTABILITY

- Must be "new" (i.e., not published or known to the public) (35 U.S.C. §101)
- "Prior art" includes anything known to previously issued patents, published patent applications, published articles, white papers, lecture slides, and even sales brochures
- "Public disclosure" of invention, even if by oral or contract breach, defeats eligibility for patent unless patent application has been filed
- Disclosures of an invention under a manufacturing agreement are not "public disclosures"
- Must be "useful" (i.e., the invention must teach a specific or demonstrable utility) (35 U.S.C. §102)
- Must be "non-obvious" (35 U.S.C. §103)
  - Invention must have an "inventive step"
  - Invention does not require a "flash of genius"
  - Obviousness analysis does not apply to mechanical rules: Consider whether the invention results from "inferences and creative steps that a person of ordinary skill in the art would employ" including things that would be obvious to try; for instance, distinguish between a skilled mechanic's work versus a true invention that requires a creator's function
- Statutory test of obviousness:
  - Survey the scope and content of prior art
  - Analyze differences between the invention and prior art
  - Determine the ordinary skill that a part of the art
  - Secondary considerations, including **Info-Data** factors, that examine:
    - Whether the invention addresses long-standing needs
    - Extent of research devoted to solving the problem
    - Number of people attempting to solve the problem
    - Commercial success (i.e., how much the invention displaces prior solutions)

#### LEGAL DATE OF INVENTION

- Prior to March 16, 2013, U.S. patent law protects the person who invents first; on March 16, 2013, U.S. law changes to protect the person who files first
  - Must file in the right jurisdiction
  - Date of invention will only be relevant to applications filed before March 16, 2013
  - Several ways to establish date of invention:
    - The date the invention is recorded in a tangible medium (e.g., a drawing or specification dated and signed by an independent witness)
    - The date the invention was built (called the "inception to practice")
    - The date the patent application is filed, which is treated as "constructive reduction to practice"

**NOTE:** Precedence suggests filing as early as feasible

#### APPLICATION FOR PATENTS

- To apply for a patent:
  - Prepare a clear, written description of the invention (patent application), which provides a "full teaching" of the invention so that another could make or implement it
  - Follow by USPTO Express Mail, first-class mail, or electronic submission, file the following with the USPTO:
    - The application
    - The fee, cost
    - The declaration of inventorship
  - The application must name the actual inventor(s)

**CAREFUL:** Multiple inventors may arise if they contributed to the actual claimed invention, even if some did not work together or did not intend to cooperate

- The patent application is not published for the inventor's lack of formal education or ignorance of technical terms
- Inventors may represent themselves in the patent process or may employ an attorney or agent admitted to practice before the USPTO
- Precedence suggests filing an application before publicly disclosing the invention; some inventors, however, first sales volume of inventions before commencing the legal to apply and prosecute the patent; gives the "invented secretly" priority periods; consider, however, likelihood of foreign novelty if sales of invention occur prior to patent filing

#### PROVISIONAL PATENT APPLICATIONS

- U.S. law permits filing a "provisional application" for protection for and without formal requirements (i.e., claims not required)
- Provisional applications are not examined and are not made public
- A provisional application is useful to obtain a priority date recognized in the United States and under the Patent Cooperation Treaty (PCT), so long as a U.S. nonprovisional or PCT patent application is filed no later than one year after the provisional filing

#### PATENT INFRINGEMENT

- Patent prosecution refers to the process of patent application and the examination by the USPTO
  - The process is adversarial
  - A Patent Examiner evaluates the merits of the application
- Application should include these elements:
  - Title
  - Cross-reference to other patents
  - Statement regarding federally sponsored research or development
  - Background of invention
  - Brief summary of invention
  - Brief description of drawings (if any)
  - Detailed description of invention
  - The claims of the invention
- Abstract [see 37 C.F.R. 41.129 et seq.]
- USPTO publishes applications 18 months from the first priority date, unless the applicant timely requests nonpublication
- Reissues:** Allows later correction of defects in original patent
- Reexamination:** Allows a third party to request clerical reexamination of an existing patent
- Judicial review:** The U.S. Court of Appeals for the Federal Circuit provides appellate review of patent decisions

#### PATENT INFRINGEMENT

- Infringement:** When a nonowner of a patent makes, uses, imports, offers for sale, or sells a validly patented item, design, or process without the owner's authorization (35 U.S.C. §271)
- Statute of limitations:** No time limit exists for bringing suit for infringement, but recovery is limited to monetary damages calculated for the six years prior to the lawsuit filing
- First sale rule:** The patent holder's rights do not extend beyond the "first sale" of the patented item; the buyer of a patented item may use or resell the item; the buyer may repair a patented item, provided the repair does not constitute "making" the item

#### ELEMENTS OF PROOF OF INFRINGEMENT

- Determine the scope of patent's "claims" in question of law for a judge may be determined in a **Markman** pretrial hearing
- Determine if the accused infringer's falls within the scope of the "claims" (a question of fact that may be decided by a jury)

#### TYPES OF INFRINGEMENT

- Literal infringement:** When the accused item overlaps the "claims" of the patented item
- Under the "doctrine of equivalents," the accused item infringes the patent if the item performs substantially the same function in substantially the same way to accomplish substantially the same result
- File wrapper estoppel:** Any changes to the patent application made during the course of patent prosecution cannot be argued or disputed after the patent issues; changes made to narrow the claims prior to issuance of the patent cannot later be challenged



## Synopsis

Now that everything seems available at our fingertips via the Internet, the issues surrounding intellectual property and content protection have become even more relevant. Whether you are a student of intellectual property law or a content producer concerned about your rights and responsibilities, our updated QuickStudy® guide contains easily accessible information about inventions, content, trademarks, and more. Protect your brand or creations with access to the most pertinent laws regarding intellectual property in this handy, three-panel guide.

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