PATENT PROTECTION BASICS

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A. Patents: Important, but Not the General Rule. It comes as a surprise to many in this country that not every new idea can be protected under the law. In fact, the general rule of free enterprise provides that anyone who has an idea for a product or service (whether the idea is their own, or someone else=s) should enter the market place and compete. Monopolies are usually illegal under antitrust laws. One of the few exceptions to the free enterprise system is provided by the patent system, without taking advantage of which, someone=s Agreat new idea@ is simply up-for-grabs.

The patent system is often criticized for making certain products and services more expensive than they would otherwise be without the leverage of patent protection. The arguments against patent protection seem even more resonant when applied to medicines, for example. However, without the benefit of patent protection, through which investment in innovation can be justified to investors, shareholders, etc., many, if not most of the now-patented inventions would not be available - at any price.

B. What is Patenable? At the outset, a patentable invention is one which satisfies four basic requirements: (1) it falls in one of several categories of protectable inventions -- mechanical devices, machines, compounds, compositions, or processes, for example (35 U.S.C. '101); (2) it is Anew@ -- neither the inventor, nor anyone else has, before certain prescribed dates, either patented, used, sold or otherwise publicly disclosed the invention which is sought to be patented (35 U.S.C. '102); (3) at the time of its invention, it was not Aobvious@ to persons skilled in its field of technology (35 U.S.C. '103); and (4) it is Auseful@ (i.e. it meets some previously unmet need, or does so better than prior solution (35 U.S.C. '101). Satisfying these requirements only means that the invention is Apatentable@, but actually obtaining a worthwhile patent involves many steps, considerable time, and (usually) significant expense.

C. Patent Claims. An Ainvention@ is not, as is often presumed, the prototype or commercial product that an inventor may make, nor is it what is shown in patent drawings, or even what is described in great detail in the text of a patent specification. Rather, the Ainvention@, for purposes of patent protection, is what is protected by the patent, and that, in turn, is what falls within the scope of patent A**claims**.@ To aid in understanding the function of patent claims, this author refers to claims as Achecklists for infringement.@

A patent may have one or several patent claims, each one of which will have several elements (usually parts, process steps, or ingredients). To infringe a patent means that someone has, without permission of the patent holder, made, sold, offered to sell, used, imported, or caused someone else to make, sell, use, etc., something which includes each and every element (Achecklist item@) of at least one of the patent=s claims (35 U.S.C.

'271). On the other hand, if a patent claim is to be valid, it is this very same combination of elements which must never have been publically known or rendered obvious either: (1) before the patentee made the subject invention; or (2) more than a year before the patent application was filed.

Principally because of a failure to understand patent claims and their function in patent protection, few people (inclusive of most practicing attorneys) fully appreciate how easy it is to infringe certain patents, or what qualifies for patent protection.

Suppose your patent on a hypothetical Awidget@ machine includes a (presumed valid) claim which reads:

1. A widget comprising:
   A,
   B,
   C, and
   D.

Having this claim means that only you can legally Apractice@ the invention (make, sell, use, import, or even offer for sale anything which ***includes*** A, B, C and D. Because the word Acomprising@ is the part that means Aincluding, but not limited to@, it does not matter that someone adds elements to a widget which has parts A, B, C, and D - there is still infringement. So, if one builds a widget with parts **A, B, C, D**, E, F, G,....R, he or she is still infringing. In short, contrary to popular myth, one does ***not*** avoid infringement of a valid claim by *adding* elements or characteristics, but only by eliminating items such that the Achecklist@ is not fully checked off.

D. <u>The Patent Process</u>. Someone new to the patent process should understand that (contrary to another popular myth) the typical first step in getting a patent - the patentability search - is optional. The primary reason for doing patentability research, in most cases, is to determine whether or not it appears reasonable to spend the money for filing a patent application. A patent search does not guarantee that a patent will issue (a search capable of such a guarantee would cost more than virtually any patent application), nor does such a search address the issue of possible infringement of other, earlier patents.

The critical phase of obtaining patent protection begins with the patent application. Contrary to yet another widespread myth, a patent application is much more than a mere form to be filed with the government. The patent application is a start-from-scratch, detailed description of the needs to which an invention is addressed, details of how to make and use the best embodiment of the invention, and (most importantly) claims which are neither so broad as to be invalid for encompassing old technology, nor too narrow as to allow competitors to benefit from the true invention with no accountability to the patent holder.

While it may be true that most anyone can file a patent application and ultimately obtain a patent of some kind, experience reveals it exceedingly rare for a *pro bono* patent application to yield results worth any effort or expense. Furthermore, most circumstances surrounding a *pro bono* patent make correcting defective or unduly narrow patent protection nearly impossible.

The patent prosecution process involves many stages and procedures, and rarely concludes in less than about 18 months.

E. Provisional Patent Applications. The relatively new "Provisional Patent Application" is often promoted as a way for inventors to save money. It is true that the filing fee for a provisional application is less than that for a regular patent application, and no patent claims are required at the time of filing (thereby arguably reducing legal expense at the time of filing). Yet, a provisional patent application must ultimately be converted to a regular application (with payment of the full filing fee), and claims must later be prepared, often cost-ineffectively by a patent attorney who has not touched the case in nearly a year.

Of even greater concern is the fact that provisional applications are never examined by the U.S. Patent Office. Examination only occurs of the converted regular patent application, and this is long after the initial filing, at a time when the opportunity to correct potentially fatal errors in the provisional application has long passed.

F. Design Patents. Almost everything discussed so far in this article has concerned "utility patents." However, design patents (often promoted by unscrupulous invention companies) are worthy of specific mention.

Design patents protect only the aesthetic appearance of manufactured items -- basically how products look apart from their purely utilitarian features. Under the right circumstances, design patents can be very valuable. However, for the vast majority of inventions, design patents are worthless. Most products of invention can be designed to look any number of ways, other than the way they are depicted in a design patent. Therefore, the inventor who has only a design patent cannot sue anyone who copies his or her invention, so long as the copier sufficiently changes the way the item looks.

G. Conclusion. An un-patented invention is nothing but an idea, while a patented invention may be one's greatest asset. Patent protection is difficult to obtain and quite easy to lose.

Asking the right questions about protecting a valuable invention is something that simply cannot wait, and sending the self-addressed letter which describes an invention (a "poor man's patent") is virtually worthless, Disclosing the invention at the wrong time and place can lose all prospect of protection.

So, when a new invention is born, and the inventor faces the myriad of issues surrounding important patent protection (only a few of which have been considered in this brief paper), an old adage should come to mind: DON'T TRY THIS AT HOME.

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ABOUT THE AUTHOR (see also: **www.PilotAtLaw.com**) :

David G. Henry is a registered patent attorney in both the United States and Canada, and carries on his private law practice as a Partner of the law firm of Patton Boggs LLP, based on Washington, D.C. (www.**PattonBoggs.com**). Mr. Henry maintains his primary office in the firm's Dallas, Texas offices. On the academic side of his professional work, Mr. Henry has, since 1994, served as professor for patent and trademark law courses at Baylor Law School.

Mr. Henry's private practice includes prosecuting patent and trademark applications before the United States Patent and Trademark Office and in patent offices throughout the world. His clients range from Fortune 100 companies and University Systems to individual "backyard inventors." As an active intellectual property litigator, Mr. Henry is also involved, at any given time, in a number of federal court actions throughout the U.S. (and some in Canada) concerning claims of patent, trademark, or copyright infringement.

Mr. Henry is a Lieutenant Colonel in the United States Air Force's Auxiliary where his unit flies humanitarian, search and rescue and disaster relief missions under auspices of the U.S. Air Force and a variety of federal and state emergency services agencies. Mr. Henry also channels his passion for aviation into his private practice as he flies, nation-wide, to meet clients and manage his various patent and trademark projects and cases. It is, in part, because of his well-known stance that "geography is never an issue when working with me", that Mr. Henry's practice extends throughout the United States (and beyond).