

# FINDING AND PATENTING INVENTIONS



- The Law
- Finding inventions
- Deciding if/when to file
- Filing/prosecuting applications
- A patent isn't the end...

## Title 35 of the US Code

Part I: US Patent and Trademark Office

Part II: Patentability of inventions and grant of patents

Part III: Patents and protection of patent rights

Part IV: Patent cooperation treaty

## Code of Federal Regulations, Title 37

*Manual of Patent Examining Procedure*

## **35 U.S.C. 101 Inventions patentable.**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**New/useful thing or method, or improvement to same**

## 35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, **before the invention thereof** by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, **more than one year prior to the date of the application** for patent in the United States, or ...

## **35 U.S.C. 103 Conditions for patentability; non-obvious subject matter.**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are **such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.** Patentability shall not be negatived by the manner in which the invention was made. ...

## 35 U.S.C. 112 Specification.

The specification shall contain a **written description** of the invention, and of the manner and process of making and using it, **in such full, clear, concise, and exact terms** as to **enable** any person skilled in the art to which it pertains, or with which it is most nearly connected, **to make and use the same**, and shall set forth the **best mode** contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. ...

## General requisites:

101. Subject matter is patentable

102. New

103. Nonobvious

112. Adequate teaching/description; claims aren't vague.



- The Law



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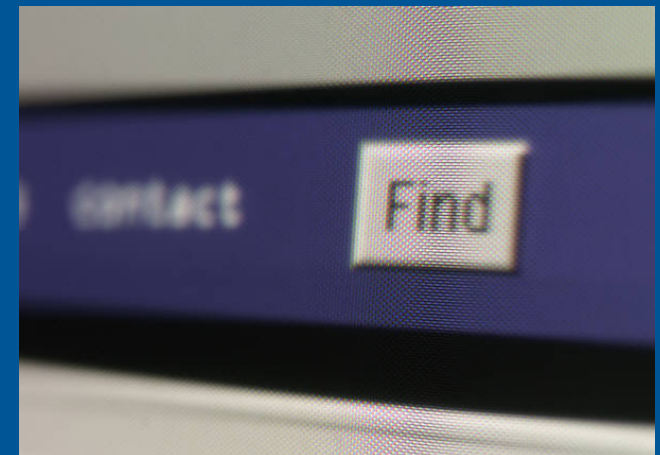
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- Research
- Manufacturing
- Process development
- Others?
  - business methods?
  - shipping/delivery?
  - administration/consumer interaction?
- Don't forget third parties doing work on behalf of company



## Very important part of in-house counsel job is locating inventions!

1. R&D provides: the invention disclosure form
2. You ask: monitoring
  - prepublication review
  - meeting agendas/minutes
  - participating in teams
  - 1:1 interactions with clients
3. Reward system?
4. Hybrid

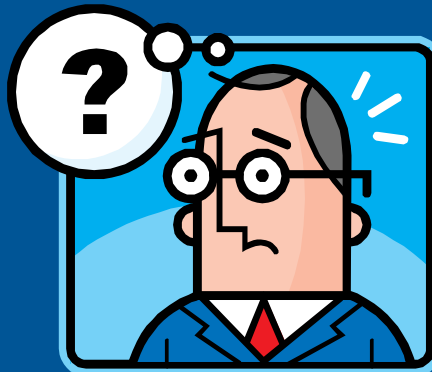


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- Can you satisfy 35 USC 101, 102, 103, 112?
  - 101 is usually straightforward
  - 112 – do you have enough information?

## HOW DO YOU KNOW ABOUT 102/103?

- Clients themselves (requires extraction)
- Patentability search (requires time)



Just because you CAN file an application and have a reasonable shot at getting a patent doesn't always mean it's a good idea.

- Better kept as a trade secret? (hard to enforce? competitive advantage?)
- Is the story not yet fleshed out?
  - need to be “in possession” of the invention
  - don't have to have ALL information, but what you propose/claim should be logically supportable by the info you do have.
    - Need to support the full scope (ie, genus usually requires more than one example species)
    - Try to avoid guessing wrongly (it publishes!)
    - Be aware of different attitudes of other territories on what is required to support a claim (ie, method of treatment claims)



When will the patent you hope to get have its maximum value?

Biotech: typically late in the term of the patent

Electronics/computing: typically early in the term of the patent

- If your value occurs early, then get the patent ASAP.
- If late, you may want to consider waiting to file.

BUT: there are risks in delaying filing!

- intervening art? (first to file systems)
- does the company need to outlicense/find a partner?
- term extension availability if you wait?



There are two types of common patent term modifications:

- patent term adjustment
- patent term extension

Adjustment: due to USPTO delay (less your own delay); extends the full scope of your claim

Extension: in the biotech/chemical realm, due to FDA (or other regulatory agency in certain foreign countries) delay (less your own delay); extends only the portion of your claim relevant to the approved therapeutic.

**KEY POINT:** in the US, you cannot begin to accumulate PTE until the US patent grants.



In sum, the calculation involves:

- (1) how patenting-ready is your work?
- (2) what's the competition like?
- (3) what's the timing on your product development?

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Title

Specification

- background
- summary of the invention
- description of the drawings
- detailed description
- examples
- abstract

Claims

Drawings

Sequence Listing

## You versus Outside Counsel

- **COST**
- Capacity
- Timing
- Confidence in technology understanding
- Expected complexity of future prosecution
- Contractually obliged to send it out?

# What about your clients?

- They have the data
- They best understand the invention
- They are (probably) not patent attorneys/agents
- Inventors need to make an oath/declaration, so they need to know, understand, and agree with the contents of the application and claims

## QUESTION: Who's an inventor?



## Provisional application vs. regular application

Low-cost

Not examined

Secures a date

Must be converted w/in 1year

More expensive  
examined

Secures a date

Really, boils down to TIMING

At some point you need to decide how extensively to file

US only?  
PCT?  
Rest of world?



Balance cost versus location of your markets and manufacturing and any concerns about patentability in certain territories

Patent prosecution is the process of trying to obtain a patent from a patent office (US or elsewhere).

Applications are generally (though not always!) examined.

Patent Examiners look at your proposed claims and examine them against the operative regulations/statutes to see if they are allowable. If not, they reject them, giving you their reasons.

- Can argue in response
- Can amend claims in response
- Can provide (in most countries) additional data
- Can seek to interview the Examiner

After a final rejection in certain patent offices, you can appeal.



In making rejections, an Examiner will usually rely on prior art. Where does the Examiner find this art?

- From searches

- Conducted by another patent office (ie, ISR)

- Conducted by the Examiner

- note both keywords and sequences are searched!

- From you

- Duty of disclosure to the USPTO

- What's in your application



Note that once your application publishes, all of the associated prosecution documents may be publicly available (and even online).

<http://portal.uspto.gov/external/portal/pair>

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Congratulations!  
You're about to have a patent!

Now what?

Unless you're in a technology area where it's typical to have only a single invention in an application, think about filing a continuation or divisional application and pursuing some other aspect of your original application.

If the patent is eligible for patent term extension (or ex-US equivalents) make sure you do the analysis and file for it if necessary/appropriate.

If it's a US patent, double-check their patent term adjustment calculation and request correction if appropriate.

Mark your products

Inform partners in keeping with your contracts

Reevaluate your claims periodically

Keep the ribbon copy safe (corporate record)

Pay maintenance fees/annuities (or not)

Monitor the field; take action when appropriate

QUESTIONS?