

Intellectual Property

Entrepreneurship Courselet

The American Patent System

- **Constitutional Mandate:** Article 1, Section 8 of the United States constitution specifically grants to Congress the 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
- **United States Patent Statutes:** Pursuant to its constitutional mandate, Congress enacted a system of patent statutes. These laws are set forth at Title 35 of the United States Code.
- **Federal Regulations Which Govern Operation of the Patent System:** The United States Commissioner of Patents is vested with the power to promulgate regulations which specify the means and procedures by which the patent laws are implemented. These regulations are set forth under Title 37 of the Code of Federal Regulations.

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Types of Patents

- Utility Patents: protect new and useful methods, devices, articles of manufacture, compositions of matter and improvements thereof
- Design Patents: protect only those aspects of the article's shape or appearance that are *purely ornamental or aesthetic*
- Plant Patents: protect certain asexually reproduced plants (uncommon)

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Requirements For Patentability

- Statutory Subject Matter: Claimed invention must be a method, device, article of manufacture or composition of matter. (genetically modified organism may qualify)
- Utility: Must have *some* utility. (In doubtful cases, Patent Office may require applicant to prove that the claimed invention has utility—e.g., perpetual motion machine, sky hook, etc.)
- Novelty: Claimed invention must not have existed previously
- Unobviousness: Claimed invention must not be obvious over the prior art to one of ordinary skill in the relevant art. The "ordinarily skilled artisan" is a mythical worker in the field of the invention who has only ordinary skill, but who is presumed to have omniscient knowledge of all prior art.

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War of Words

- Means For
- Comprising:
- Catch all phrase prior to claims
- Trend in law toward narrower claim construction
- Slidably engaged
- Releasably connected
- Fixedly attached
- Imageably guided
- Frustoconical
- Frangible
- Elongate body
- Mammalian body

Steps

- Assemble Background Information
- Search
- Search Again
- Create Your Universe
- What is the Prior Art?
- Are there Licensing Opportunities?
- Are there Blocking Patents?
- Need to Have v. Nice to Have
- Are there Alternative Designs?

Assemble Background Info

- Clinical Articles, or Names of Physicians/Inventors in the Field
- Competitive Products
- Competitive Companies
- Known Patents in the Area
- Know what you are Claiming

Search

- Search Terms
 - Terms of Art
 - Clinical Terminology
- Search Forward
 - What patents cited this one since issuance?
- Search Back
 - What references did this patent cite as prior art?

Search Again

- Technical Articles
 - MEDLINE (PubMed)
<http://www.ncbi.nlm.nih.gov/entrez/query.fcgi>
 - Specific Journals in Field
- Product Literature
 - Catalogs
 - Trade Shows
 - Proceedings

Create the Universe

- Prioritize the Universe
 - What is the Prior Art?
 - Most Relevant
- Claim Charts
 - Attorney Client Privilege Issues
- Visual Aids
- Timelines
- Link Products, Patents, Competitors

Case Study - Licensing

- What are the Licensing Opportunities
 - Status of the Patent
 - Expired - In public domain
 - Abandoned - In public domain
 - Invalidated - I wish they had a service for this!
 - Who Owns It?
 - Assignee
 - What Does it Really Cover?

Analysis

Are you Blocked?

- Understand the Claims
- Understand the Spec
- Understand the File History
- Have an Alternative Design

Action Plan

Need to Have v. Nice to Have

- Shopping List
- Rank/Eliminate
- Make Contact

Are There Alternative Designs?

- Design Around

Summary

- Look for Solutions to Problems
- Understand the Universe
 - Search
 - Chart your key competitive patents
- Understand Licensing Opportunities
- Have Alternative Designs
 - Reduce to Practice to Gain Practical Understanding