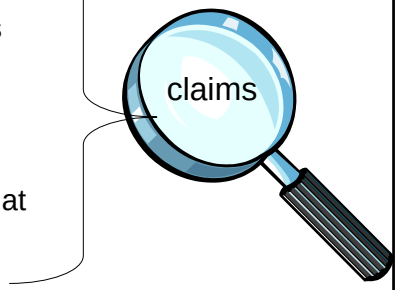
Patent Law

- Module 1
- Introduction

Patent Law – class overview

- First half of the semester – five elements of patentability
  - ***Patentable subject matter***, i.e., patent eligibility
  - ***Useful/utility*** (operable and provides a tangible benefit)
  - ***New*** (statutory bar, novelty, anticipation)
  - ***Nonobvious*** (not readily within the ordinary skills of a competent artisan at the time the invention was made)
  - ***Specification requirements***



- Then a few weeks on claims, prosecution and post-grant procedures
- Then infringement, defenses and remedies for two and a half to three and a half weeks

Bonito Boats v. Thunder Craft

Commentary on Authors & Inventors clause

It was beneficial to all parties, that the national government should possess this power; to authors and inventors, because, otherwise, they would have been subjected to the varying laws and systems of the different states on this subject, which would impair, and might even destroy the value of their rights; to the public, as it would promote the progress of science and the useful arts, and admit the people at large, after a short interval, to the full possession and enjoyment of all writings and inventions without restraint.

In short, the only boon, which could be offered to inventors to disclose the secrets of their discoveries, would be the exclusive right and profit of them, as a monopoly for a limited period.

Story, Commentaries on the Constitution of the United States (1833) (emphasis added)

Bonito Boats v. Thunder Craft

- "drawing a line between the things which are worth to the public the embarrassment of an exclusive patent, and those which are not"
- Our excerpt from the case summarizes the essence of the patent "bargain" and sketches the elements of patentability
- Elements of the bargain (mapped to the five requirements of patentability, i.e., of obtaining an invention)
  - Costs put on the public
    - Loss of "free" use of idea for certain things for approximately twenty years
      - in exchange for
  - Benefits to the public
    - Eventual "free" use [usefulness/utility] of the idea for certain things [patentable subject matter, i.e., patent eligibility] when patent expires and the idea falls into the public domain
    - Disclosure of ideas [specification requirements] that otherwise might have been kept cloistered and protected under the state law of trade secrets
      - obtained by providing exclusive rights to the patentee for a limited time to create
  - Incentives to generate sufficiently [nonobviousness] new [statutory bar, novelty, anticipation] ideas
    - Reward is period where patentee has right to exclude others from using the invention
    - This right allows patentee to recoup development costs that would otherwise be unrecoverable due to lower-priced (because they had no research and development costs) imitators replicating the invention

Bonito Boats v. Thunder Craft – foreshadowing 102(a)

102(a) – if the prior art reference occurred prior to the date of invention of what is claimed, then the claim is not novel if that reference anticipates the claim (has all the limitations/elements of the claim).

NOTE – it can be a very detailed and technical inquiry to determine what the date of the reference is and what the date of the invention is.

	***public*** knowledge or	"Public" is an implied requirement, relates to that segment of the public most interested in the technology, public if no deliberate attempts to keep it secret.
	used by others	One use is sufficient, even if private, remote or widely scattered, public if no deliberate attempts to keep it secret.
	patented or	A grant of exclusive rights, evaluated for what is claimed, accessible to public & not secret
	printed publication	Public accessibility – the document was made available to the extent persons interested and ordinarily skilled in the art, exercising due diligence, could locate it. The test for what is a "patent or printed publication" is the same under 102(a) & (b)).

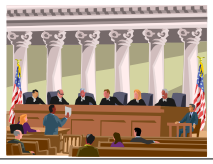
Bonito Boats v. Thunder Craft – foreshadowing 102(b)

102(b) – if the applicant does not file within one year of the date of the prior art reference or activity, then the patentee is barred from applying for the patent.		
	in public use or	No purposeful hiding of use. Experimental use exception.
	on sale	Commercial offer for sale and invention is ready for patenting
	patented or	same as 102(a).
	printed publication	same as 102(a).

Bonito Boats v. Thunder Craft

- Holding?
  - State law protection for techniques and designs already sold in the market "may conflict with the very purpose of the patent laws by decreasing the range of ideas available as the building blocks of further innovation"
  - Federal IP protection "would be rendered meaningless in a world where substantially similar state law protections were readily available"
  - "To a limited extent, the federal patent laws must determine not only what is protected, but also what is free for all to use."

Patent Acquisition and related actions



Supreme Court

Ct. of Appeals for the Federal Circuit

Dist. Ct. for the Dist. of Columbia

PTO Board of Patent Appeals and Interferences

PTO Examiner

Patent Enforcement and related actions

Supreme Court

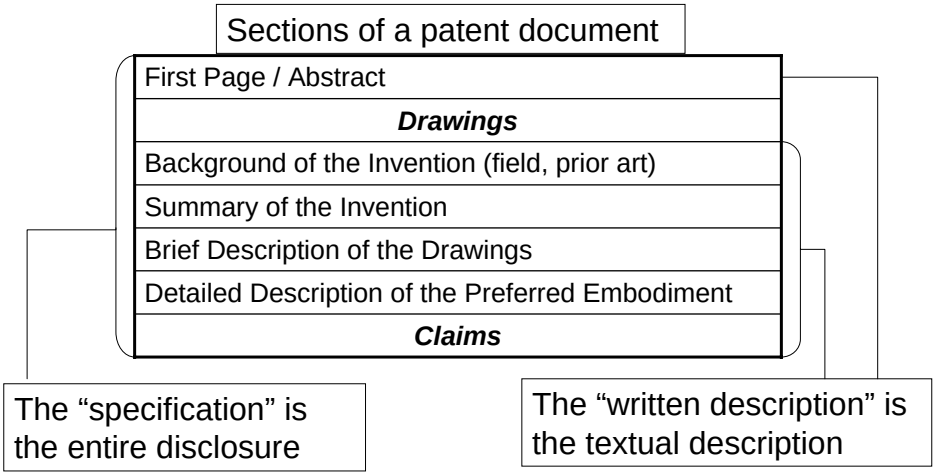
Ct. of Appeals for the Federal Circuit

District Court

Forms of Patent Protection

- Utility patents
- Design patents
  - new, original and ornamental design for an article of manufacture (unless design is "primarily functional")
- Plant patents
  - distinct and new varieties of plants that have been asexually reproduced
- Patent-like Plant Variety Protection
  - PVP certificates, only for sexually reproduced plants, including most seed-bearing plants. Fungi and bacteria are ineligible for certification. Plant must be a clearly distinguishable variety, and must breed true with a reasonable degree of reliability
  - Administered by Dept. of Agriculture, not PTO

Example Utility Patent - *5,190,351* - Terminology



The label "written description" that is used to describe a portion of the patent document is different from the **§ 112 ¶1** "written description requirement"

Example Utility Patent - *5,190,351*

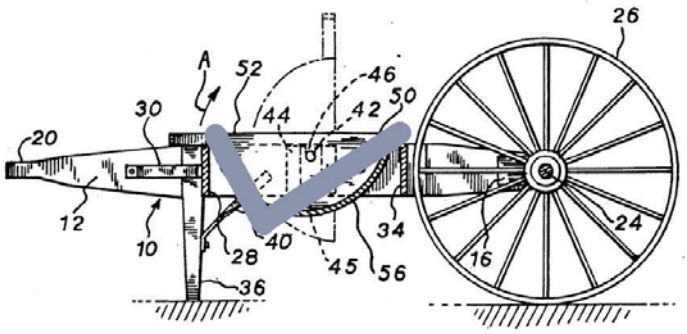
- To look at the five elements of patentability through the “lens” of the claims we must first know how to read and interpret the claims
  - This requires “parsing” the claim for purposes of comparison
  - This also requires claim “construction” to determine the legal meaning of the claim

Example Utility Patent - *5,190,351*

Claim 1	Label	Identifier
1. A wheelbarrow . . . comprising		
a frame having two . . . rails . . . and at least one cross brace . . .	frame [10]	A
an axle . . .	axle [24]	B
a wheel . . . [with] minimum diameter of 30 inches	wheel [26]	C
a pair of mounting brackets . . . mounted . . . Intermediately . . .	brackets [42, 44]	D
a box having a semicylindrical closed bottom, upstanding side walls having a C-shaped bottom edge . . . Including a pair of axially aligned pivot posts . . .	box [50]	E
a support . . .	support [36, 38]	F

Example Utility Patent - *5,190,351 - claims*

- Infringement preview as a vehicle to examine claim scope . . .
- What happens if a competitor makes the exact same wheelbarrow with the following shaped box:



Patent Bargain – challenges to the traditional justifications

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Patent Bargain – challenges to the traditional justifications

- Economists question whether patents in fact promote disclosure of inventions that would otherwise be kept secret: (i) secrecy is not always practical; (ii) secrets can be reverse engineered; (iii) if long term secrecy is achievable, why settle for 20 years of patent term; (iv) greater enforcement difficulty for inventions that can be practiced in secret. But, the patent system facilitates licensing, allowing "risk-free" disclosure of the idea/information in order to close the transaction.
  - ***Disclosure of ideas that otherwise might [illegible] kept cloistered and protected under the state law of trade secrets***
    - obtained by providing exclusive rights to the patentee for a limited time to create
- ***Incentives to generate sufficiently new ideas***
  - [illegible]

Other incentives may be enough: (i) head start; (ii) keep up with rivals. Patent incentives may distort economic activity: (i) overspending to develop technology more quickly than optimal; (ii) divert research funds from nonpatentable to patentable items; (iii) hinder nonpatent holders from improving patented technologies; (iv) force competitors to spend time and effort to find duplicative solutions to technological problems to avoid infringement