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# Intellectual Property Law (Quickstudy: Law)

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## Intellectual Property

### PATENT LAW

#### MAIN SOURCES OF THE LAW

1. U.S. Constitution, Art. I, § 8, clause 8: Congress has the power "to promote the progress of science and the useful arts by securing, for limited times to... inventors the exclusive rights to their discoveries"
2. Federal statutes - [35 U.S.C. § 101 et seq.]
3. Federal regulations - [37 C.F.R. § 1.1 et seq.]
4. Federal judicial precedents

#### WHAT IS A PATENT?

1. A patent is a "negative right," a limited right temporarily to exclude others from making, using, selling, or importing that which falls within the "scope" of the patent
2. Patent holder may exploit a patent but may not infringe the rights of other patent holders
3. Patent generally expires 20 years from non-renewable invention or up to 17 years based on Patent Office delays
4. **COMPARE:** trade secret protection applies to inventions kept from the public; trade secret law protects against others misappropriating the invention but not against others who "independently" create "copies" of the same invention

#### WHAT IS PATENTABLE?

1. **Patentable:** any new, useful process, machine, article of manufacture, or composition of matter or any new useful improvement [35 U.S.C. § 101]
2. **Includes:**
  - a. **Process:** including business, artificial intelligence and mathematical processing-related inventions
  - b. **Product:** a composition of matter, a man-made item (even natural product of human effort), a machine, a non-naturally occurring phenomenon
  - c. **Design:** the non-functional aspects of objects of utility, e.g., auto head ornaments
  - d. **Trademark:** invented to "brand" objects of utility
  - e. **Inventions:** items of design patent is shorter (14 years)
3. **Not patentable:**
  - a. Laws of nature
  - b. Abstract ideas
  - c. Naturally occurring plants or animals
  - d. Things that are *already* known

#### ANALYZE PATENTABILITY

1. Must be "new" (i.e., not published or known to "prior art")
2. "**Prior art**" includes anything found in previously issued patents, published patent applications, published articles, white papers, lecture slides, trade show brochures
3. Disclosure of an invention under a non-disclosure agreement is not "public disclosure"
4. "**Public disclosure**" of invention, even if by itself or related branch, before disclosure for patent unless patent application has been filed
5. Must be "**useful**" (i.e., the invention must have a specific or demonstrable utility) [35 U.S.C. § 102]
6. Must be "**non-obvious**" [35 U.S.C. § 103]
  - a. Invention must have a "**non-obvious step**"
  - b. Does not require a "flash of genius"
  - c. **Obviousness analysis:** does not apply a mechanical rule; must consider whether the invention results from "intuitiveness and creative steps that a person of ordinary skill in the art would employ," including things it would be obvious to try
  - d. **Exemplar:** a skilled mechanic's work on a new invention

#### Statutory bar of obviousness:

1. serves the scope and content of prior art
2. study to differences between the invention and prior art
3. determine the ordinary skill that is part of the art
4. secondary considerations, including **John Derris** factors that examine:
  - a. whether the invention addresses long-standing needs
  - b. extent of resources devoted to solving the problem
  - c. number of people attempting to solve problem
  - d. commercial success (does such the invention displace prior solutions)

#### LEGAL DATE OF INVENTION

1. U.S. patent law protects the person who invents first, not the person who files first (**COMPARE:** foreign patent law systems protect the first person to file)
2. Several ways to establish date of invention:
  - a. The date the invention is recorded in a legally sufficient (e.g., a drawing or specification that is signed by independent witnesses)
  - b. The date the invention was built (called the "**reduction to practice**")
  - c. The date the patent application is filed, treated as "**constructive reduction to practice**" [TIP: **practitioner** suggest filing as early as feasible]

#### APPLICATION FOR PATENTS

1. To apply for a patent:
  - a. 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)
  - b. File with the U.S. Patent & Trademark Office ("PTO") by Express Mail, first-class mail or electronically:
    - i. the application
    - ii. the fee paid
    - iii. the declaration of inventorship
  - c. Application must name the actual inventor(s) (**CAVEAT:** multiple inventors may exist if they contributed to the actual claimed invention, even if some did not work together or did not attend an occasion)
  - d. The patent application is not prepared for the inventor's lack of formal education or ignorance of technical terms
  - e. Invention may represent invention in the patent process or may employ an attorney or agent admitted to practice before the USPTO
  - f. **Practitioner** suggests filing an application before publicly disclosing the invention, even tentatively, however, use safe, volume of invention before submitting the funds to apply and prosecute the patent, given the "limited monopoly" the patent provides; consider, however, holders of foreign novelty if not-of-invention occur prior to patent filing)

#### PROVISIONAL PATENT APPLICATIONS

1. U.S. law permits filing a "provisional application" for a reduced fee and without formal requirements (i.e., claims not required)
2. Provisional applications are not examined and are not made public
3. A provisional application is useful to obtain a priority date recognized in the U.S. and under the Patent Cooperation Treaty (PCT), so long as a U.S. non-provisional or PCT patent application is filed no later than 1 year after the provisional filing

#### PATENT PROSECUTION

1. **Patent prosecution** refers to process of patent application and the prosecution by the USPTO:
  - a. The **Copyrighted Material**

#### 3. Patent Examination evaluates the merits of the application

1. Application should include these elements:
  - a. Title
  - b. Contribution to other patents
  - c. Statement regarding federally sponsored research or development
  - d. Background of invention
  - e. Brief summary of invention
  - f. Brief description of drawings (if any)
  - g. Detailed description of invention
  - h. The claims of the invention
2. **Abstract:** per 37 C.F.R. § 1.72 et seq., 37 C.F.R. § 1.79
3. USPTO publishes application 18 months from first priority date, unless applicant timely requests non-publication
4. **Re-exam:** allows later correction of defects in original patent
5. **Re-invention:** allows a third party to request a "limited examination" of an existing patent
6. **Judicial review:** U.S. Court of Appeals for the Federal Circuit provides appellate review of patent decisions

#### PATENT INFRINGEMENT

1. **Infringement:** where a non-owner 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]
2. **Invention of Infringement:** the issue then exists for bringing suit for infringement, but necessary limited to necessary damages calculated for 60 days prior to filing of lawsuit
3. **First sale rule:** the patent holder's rights do not extend beyond the "first sale" of the patented item, the issue of a patented item may sue to track the item, the issue may repair a patented item, give that the repair does not constitute "making" the item

#### ELEMENTS OF PROOF OF INFRINGEMENT

1. Determine the scope of patent's "claims" (a question of law for a judge; may be determined in **Hickman** pre-trial hearing)
2. Determine if the accused infringement falls within the scope of the "claims" (a question of fact that may be decided by a jury)

#### TYPES OF INFRINGEMENT

1. **Literal infringement:** when the accused item "recites" the "claims" of the patented item
2. **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
3. **The wrapper around:** any changes to the patent application made during the course of 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

#### TYPES OF INFRINGERS

1. **Direct infringer:** one who makes, uses or sells the patented invention without permission
2. **Indirect infringer:** one who offers to infringe
3. **Contributory infringer:** knowingly offers for sale or supplies, items solely used in connection with a patented invention

#### DEFENSES TO INFRINGEMENT ACTION

1. Invalidity of the patent (**NOTE:** an issued patent is presumed valid)
2. **Patent exhaustion:** intellectual exhaustion by the patent owner of the limited monopoly conferred by the patent
3. **Patent misuse:** applies where contractual use of the business method issue from a year prior to the



## Synopsis

A one-stop resource for students, inventors, writers, attorneys and businesses, this 3-panel (6-page) guide contains the latest, most comprehensive information on all aspects of IP law—from patent and trademark application to copyright infringement. Stumped by what Fair Use governs? Eager to learn every aspect of the Lanham Act? Look no further than this no-nonsense resource! Written in our fluff-free format, this guide™s need-to-know information is conveniently divided into sections that correspond to the 3 main areas of IP Law: Patent Law Copyright Law Trademark Law Plus, it includes a special section for easy reference for students and IP professionals: Selected Federal IP Statutes Useful Internet IP Links

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