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THE REQUIREMENTS FOR OBTAINING A PATENT

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The United States patent process works under a first to invent system and thus an inventor who first conceives a useful, new and non-obvious machine, manufacture, composition of matter or any new and useful improvement before others may obtain a patent. However, there are very specific conditions under which a patent is granted. The object of this article is to provide a brief explanation of those requirements, although contacting a patent attorney or patent agent for clarification is always recommended.

There are four substantive requirements for patentability: patentable subject matter, utility, novelty, and non-obviousness. Patentable subject matter is almost always easily fulfilled if the invention is a machine, manufacture, composition of matter since patentable subject matter has been found to include practically everything man-made; however, there are some important exclusions. Specifically, abstract ideas, laws of nature, mathematical formulas and physical phenomena cannot be patented. While a mere concept of an idea itself cannot be patented without a reduction to practice, this does not mean an inventor must have an actual reduction to practice or a working prototype, but must only be required to describe his/her invention. (The filing of a patent application then becomes a constructive reduction to practice.) Rather, the key is the point of conception of the invention, which is defined as the formation in the mind of the inventor of a permanent and definite idea of the complete and operative invention as it will thereafter exist. Laws of nature, mathematical formulas and physical phenomena cannot be patented because they are considered to inherently exist and thus cannot be invented.

The second requirement for patentability is utility and this is also generally easily satisfied. The utility requirement ensures the patented invention will serve a useful purpose. This has also been extended to include operativeness. Thus if an invention will not operate to perform its intended purpose then it would not be useful. However, utility and usefulness has been interpreted very broadly. Thus, inventions for things such as games or other entertainment devices have been found to be useful and therefore patentable.

The third requirement of patent law is that the invention be new or novel. Specifically, an invention cannot be patented if: "(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 application for patent in the United States…" 35 U.S.C. §102 More generally speaking this means that if all of the

features of your invention are found in a device used in this country, or disclosed in a patent or printed publication (including on the internet), then you may not obtain a patent because the invention already exists. The majority of the time this is determined if a patent attorney, during a patent search, or an Examiner at the United States Patent and Trademark Office, during prosecution of the patent, finds a previously filed patent which discloses all of the features of your invention. Additionally, if you have been marketing your invention and offering it for sale for more than a year, or have published its details such as in an advertisement or article or other publishing means, then it is no longer considered new and novel and thus is not patentable; however, small improvements in the invention which have not been offered for sale for more than a year may still be patentable.

If you can prove that you invented your invention before the filing date of a reference that is used by virtue of the fact that it was filed or published prior to your filing date, you can 'swear behind' the reference by showing proof that you invented your invention before the invention was known through the reference. However, it is often difficult to show that you invented before the reference unless you have kept good records or can prove your prior invention date through witnesses. Further, you can only go back one year – if the reference effective date is more than a year before your filing, you will not be able to swear behind it.

The fourth requirement for obtaining a patent is referred to as non-obviousness and is generally viewed at the most difficult hurdle to overcome in getting a patent. The test is whether a person of ordinary skill in the art or field of the patent as filed would find it obvious to solve the problem by using essentially the same means or mechanisms. This is easily illustrated by a recent case in which a company attempted to patent peanut butter and jelly sandwiches with crimped edges instead of crust; they were awarded a patent, but subsequently, competitors complained and a reexamination was undertaken – during the reexamination, the patent was disallowed. Since crimping is often used in creating ravioli to prevent the stuffing from falling out and ravioli and sandwiches are both food, and thus in the same field of art, it would have been obvious to apply the process of crimping from ravioli to sandwiches. This situation most often arises when two or more issued patents or published patent applications contain all of the elements of the invention which is being filed (bearing in mind that if one invention contained all the limitations then it would relate to novelty). For example, if your invention comprises parts A, B and C in a specific field, one source of prior art in the same field contains elements A and B, and a second source of prior art in the same field contains parts B and C, then an Examiner is likely to conclude that your invention is not patentable because it would be obvious it combine the first (A, B) and second (B, C) sources to arrive at your invention (A, B, C).

If your invention is patentable subject matter, useful, novel and non-obvious then you would be able to obtain a patent. However, reasonable minds can often disagree over these terms, particularly what would be obvious to combine, and thus obtaining a legal opinion is always recommended.

When you obtain a patent, the United States government is effectively granting you a monopoly, since you have the right to prevent others from making in, using in, selling in, offering for sale in, or importing your invention into the United States. In return for this grant of patent rights, which extend from the date of filing of your patent application for 20 years, you are required to fully disclose your invention such that anyone could make it from your description and drawings. Further, you must disclose within your patent application the 'best mode' of making your invention; that is, at the time of the application what is known to you as the best and complete way of practicing (making or using) your invention.

If you have any questions about this article, or are interested in trying to obtain a patent please feel free to contact Williamson Intellectual Property Law, LLC of Atlanta, Georgia. Alternatively, feel free to read other articles on similar subjects relating to both foreign and United States patent, trademark and copyright law.

For more information on the patent process, please visit Patent Information.

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