



Strasburger
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Business & Law Newsletter

BUSINESS & LAW NEWSLETTER • JULY 31, 2007 • STRASBURGER & PRICE, LLP

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PROTECTING YOUR INVENTION

PART IV: THE PATENT

The intellectual property of a company may not only be its most important asset but may be a new company's only asset. One of the ways to protect a company's intellectual property assets is by obtaining a patent covering the invention. There are three types of patents, the utility patent, the design patent and the plant patent. All inventions fall into one of those three categories. As will be discussed below the utility patent is the most common type of patent and includes every type of invention from a new type of paper clip to a sequence of cloned DNA. The design patent includes the ornamental features of an object and a plant patent includes those crop plants produced by asexual reproduction.

However, before discussing each type of patent it might be helpful to decide just exactly what is patentable. According to the Supreme Court of the United States "anything made by man is patentable" as long as it meets certain criteria. In order to fulfill those requirements, the invention must be novel, not obvious to a person of ordinary skill in the art and have utility. The first and last criteria usually cause few problems in determining patentability. The invention is either new (novel) and has some function (utility) or it does not. The requirement that an invention be nonobvious causes the most problems in determining whether an invention is patentable. The Supreme Court has recently "clarified" the nonobviousness requirement in an opinion that will be debated by patent practitioners and the Patent Office for years to come. Rather than engage in a long soporific discussion of the "clarified" nonobviousness requirements, this writer would suggest that those interested in obtaining more details about this requirement drink a strong cup of coffee and contact their patent lawyer.

In addition to the requirement that, in order to be patentable, the invention must be novel, nonobvious and have utility, Congress has determined that there are certain types of inventions which are not patentable. Those patents include inventions of mathematical algorithms and natural processes. Congress reasoned that these types of inventions are not inventions at all and therefore not



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patentable Think of the chaos if Sir Isaac Newton had patented gravity rather than simply eating the apple that fell out of the tree and allegedly conked him in the head. For years afterward, everyone would have to pay a royalty to Mr. Newton every time they took a step and did not bounce off of the planet due to the gravitational pull of the earth. Put in a more modern context, today's newspaper reported that a scientist had discovered the genes causing multiple sclerosis. The genes, in and of themselves, are not patentable. They are natural processes. What might be patentable would be a treatment for Multiple Sclerosis that may follow this discovery.

As mentioned above, the utility patent is the type of patent into which most inventions would be included. The utility patent application is a formal legal document that must comply with all of the requirements of the Patent Office. Those requirements occupy a hundred pages or so in the Manual of Patent Examining Procedure. The patent application must be prepared with care, must thoroughly describe the invention and set forth with some precision exactly what is being claimed. If the utility patent application overcomes all of the hurdles placed in its path, the inventor will receive a patent which grants to him for a period of 20 years measured from the date of filing the utility patent application, the right to prevent others from making, using or selling his invention in the United States. As such, the utility patent has become an important asset to be protected and managed by its owner.

The design patent is a patent issued to an inventor of an ornamental design of an object. It is the appearance of the object, rather than its function which is patentable. The utility patent application may be many pages long and contain long detailed descriptions of the invention. In contrast, the design patent application may be only one or two pages long. The design patent application will have several drawings showing different views of the new ornamental design. It is these drawings of the ornamental design which describe the design of the object to be patented. Once a design patent is issued the inventor has a period of 14 years from the date of filing the application to exploit his patent.

One might ask, who cares about design patents? The design patent is not used with anywhere near the same frequency as a utility patent application. However, a design patent can give the inventor a way to benefit in a particular market. Suppose you are the inventor of a new type of clock and you have obtained a patent for your new timepiece. However, someone else has patented many of the great designs into which your new timepiece invention would fit. Without those designs your timepiece invention is worthless. You, as inventor of the timepiece must enter into an agreement with the inventor of the designs for the timepiece in order to exploit the timepiece invention. The inventor of the patented designs then gets to benefit economically from the invention of the new timepiece.

The plant patent application is almost what it sounds like. One can obtain a patent for a certain type of plant by filing a plant patent application. The type of plant which is patentable through a plant patent application are those plants grown under tillable conditions and are generated by asexual reproduction. About 30 years ago the courts clarified the definition of what is patentable to “anything made by man”. Thus, a utility patent application could be used to patent a plant that is generated by either sexual or asexual reproduction from tillable conditions. What is not patentable is some plant occurring normally in nature out in the wild. Many of the varieties of corn, wheat, sorghum, cotton and other crops grown today are patented by either a plant patent or utility patent.

Whatever your business, the intellectual property held by the business is a vital asset that must be protected in order to fully realize its value. One of the best ways to protect your invention is by obtaining a patent through which you can prevent others from making, using or selling your invention in the U.S.

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