

OBTAINING A PATENT

LEGAL ISSUES IN THE UNITED STATES

09 APRIL 2018

As you consider filing for a Patent in the United States, you should take several issues into account.

RIGHTS CONFERRED BY A VALID US PATENT

A US patent grants the patent holder a limited monopoly which allows the holder of a patent to exclude all others from making, using, selling, or importing any invention that is described by the claims of the patent. A patent does not give you a right to make products that embody your invention as other patents might be applicable to these products. Your patent rights are also limited in terms of duration and enforcement.

Duration

The precise duration of a patent is determined by two factors:

- › the subject matter of the patent
- › delays introduced by the United States Patent and Trademark Office (USPTO).

Subject Matter

There are 3 main types of patents:

- › **Utility Patents** (for novel processes or products) – A utility patent term lasts for 20 years from the date of filing.

- › **Plant Patents** (limited to plants that have been created through human engineering) – A plant patent term lasts for 20 years from the date of filing.
- › **Design Patents** (for non-functional ornamental features) – A design patent term lasts for 14 years from the date of filing.

USPTO Delays

Beyond the base term of the patent, up to five years in extensions may be added to the term of the patent based on delays experienced at the United States Patent and Trademark Office.

Enforcing a US patent

Only the entity possessing the exclusionary rights granted by the patent may bring suit to recover damages sustained as a result of infringement. The rights granted under a patent are not self-enforcing; that is, the burden of discovering infringement and subsequently filing suit to recover the damages caused thereby is entirely on the entity attempting to enforce the patent. However, in the event of infringement, the entity can be entitled to one or more of the following legal remedies:

- › injunctive relief (court orders infringer to stop)
- › seizure and destruction of infringing goods
- › compensatory damages (lost profits)



Australian Government

Australian Trade and Investment Commission



- › triple damages (where infringement is willful)
- › court costs
- › legal fees

Failure to identify a product as protected by a specific patent can limit the damages that can be collected.

REQUIREMENTS FOR OBTAINING A US PATENT

Obtaining a US patent requires:

- › utility
- › novelty
- › non-obviousness
- › enabling description.

Who can file a patent

In order to file a patent application, the filing party must show some tangible interest in the claimed invention. This interest exists where the filing party is the inventor or the assignee.

Utility (US Code, Title 35, Section 101)

The utility standard requires that the claimed invention falls within one of the four patent-eligible subject matters while not falling within one of the three exceptions:

- › **Eligible subject matter:** Processes, machines, manufactures, or compositions of matter.
- › **Ineligible subject matter:** Abstract ideas, laws of nature, and natural phenomena (as recently decided in *Alice Corp. v. CLS Bank Int'l*, merely reciting an abstract idea or process performed by a computer is not patent-eligible).

Novelty (US Code, Title 35, Section 102)

Novelty requires that the invention is new and has not been disclosed, used, or sold by another before the filing of the application. An invention is not novel when even one previous patent, publication, or product includes all the

claim limitations. However, the applicant is given a one-year grace period for the inventor's prior use. Also, with the passage of the America Invents Act (AIA), the effective filing date will control which law applies.

- › **Grace Period:** the inventor can file an application for up to one year after publicly disclosing, using, selling, or offering to sell his invention. After this grace period, an application cannot be filed for the invention.
- › **Pre-AIA:** If the application was filed before March 16, 2013, the Pre-AIA version of the novelty requirement applies, requiring that the inventor was the first to invent.
- › **AIA:** If the application was filed on or after March 16, 2013, the AIA version of novelty applies, requiring the inventor was the first to file on the claimed invention. This brought US patent law more in line with patent law in other countries.

Non-Obviousness (US Code, Title 35, Section 103)

Non-obviousness requires that the invention would not have been obvious to a person skilled in the art. Rejections based on obviousness can involve the combination of two or more prior disclosures (such as articles, papers, or products) that together teach the limitations of the claimed invention.

Enabling Description (US Code, Title 35, Section 112)

An enabling description requires the patent application contains detail sufficient to enable one skilled in the art to practice the invention without undue experimentation.

THE PATENT APPLICATION

There are three options for applying to obtain a US patent:

- › provisional application
- › non-provisional application
- › national phase filing.

Provisional patent application

The USPTO permits filing a provisional patent application for a reduced fee, which is exempt from some formal requirements (such as the inclusion of claims). The provisional application is not actually examined by the USPTO and will not be published (but will be available to the public if a subsequent non-provisional application claims priority to the provisional application). These are often used to reserve a priority filing date, provided the non-provisional application is filed before the provisional application expires one year after its filing. Provisional applications confer the ability to mark products with 'patent pending.'

Non-provisional application

A non-provisional application typically includes:

- › one or more figures
- › a specification that describes the invention by reference to the figures
- › one or more claims that precisely describe the desired scope of the invention.

A non-provisional application is typically examined by the USPTO 13–18 months after the filing date, although there are procedures for requesting faster examination. Any non-provisional application filed within one year of a provisional application may claim priority to the filing date of the provisional application.

A non-provisional application may be linked to an earlier application in order to get the benefit of the earlier application's filing date. The later filing is said to be a child of the earlier filing. Examples of such filings include:

- › **Continuation/divisional applications** – Child of an earlier non-provisional application claiming a different invention with a different set of claims but using the same specification and figures.
- › **Continuation-in-part (CIP) applications** – Child of an earlier non-provisional application claiming a different invention with a different set of claims and with specification and figures that often have additional material not included in the earlier filings. This additional material will get the later filing date, but the overlapping

material between the two cases gets the earlier filing date.

National phase filing

The USPTO permits filing based on an earlier foreign application.

- › **Direct national phase:** the earlier foreign application is an application filed in the patent office of another country for procuring patent rights in the other country.
- › **National phase filing off a PCT application** – PCT applications are placeholder foreign applications that are filed pursuant to the Patent Cooperation Treaty. PCT applications preserve the applicant's right to pursue a US filing for up to 30 months from their priority date.

THE LIFECYCLE OF A PATENT APPLICATION

Submit a non-provisional patent application

Submitting a non-provisional patent application is the first step in prosecution. However, a provisional application may be filed to which the later-filed non-provisional application can claim priority.

Receive 'office action' (response) from USPTO

Typically, 13–18 months after the non-provisional application has been filed, the application will be examined by a USPTO patent examiner. The examiner will review the application and search the database for any prior applications or issued patents ('prior art') that anticipate or render obvious the claimed inventions (the claims). The examiner will then issue an 'office action' detailing the results of the examiner's search as well as specifying whether any of the claims have been 'allowed' (meaning they are not precluded by any prior art, and meet the utility and enablement requirements). It is quite common for most or all of the claims to be initially rejected by the examiner. There are the following two types of office actions:

- › **Non-final** – Examination on the merits has not come to an end. The applicant needs to prepare a response to the non-final office action to amend the claims and/or present arguments to overcome the examiner’s rejection.
- › **Final** – Examination on the merits has come to an end. The applicant needs to present additional arguments, appeal the case, or pay additional fees to re-open examination to present additional amendments.

Receive notice of allowance

Once the applicant overcomes the examiner’s rejections with arguments and/or claim amendments, the examiner issues a notice of allowance. The applicant then has to pay the issue fee to have the USPTO grant an issued patent for the application.

Patent issues and maintenance

Once the patent issues, the patent owner has to pay maintenance fees to keep the patent

alive. These fees are to be paid at 3.5, 7.5 and 11.5 year marks from when the patent issues.

DISCLAIMER

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