

WIGGIN AND DANA

Counsellors at Law

PRIMER ON PATENT LAW

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PRIMER ON PATENT LAW

I. WHAT IS A PATENT?

- A. Legal document issued by the U.S. government that authorizes the patent owner to prevent others from making, using, or selling the invention.
- B. Quid Pro Quo: Government gives a “limited monopoly” in the claimed subject matter in exchange for a complete description of how to make and use the invention.

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- C. Authority to grant patents comes from the U.S. Constitution at Article I, Sec. 8, clause 8.

“The Congress shall have power...To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”

- D. Patent consists of an abstract, specification (background, summary, detailed description), drawings, claims. Claims most important. Biotech patents often include a “Sequence Listing”.

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E. Patent rights arise when the patent is issued and end 20 years from it's filing date. The information in the patent is dedicated to the public when the patent lapses or expires.

II. PATENTABLE SUBJECT MATTER

A. What can be patented?

1. Machines – sewing machine, pliers, telephone, computer, protein sequencer.
2. Compositions of Matter – new compounds or chemicals, pharmaceuticals, nucleic acids, proteins, antibodies.

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3. Articles of Manufacture – Broom, lamp, bottle.
4. Processes – Method of purifying a protein or nucleic acid; method of screening for useful drugs; business methods
5. Improvements on the above.
6. Designs.
7. Plants (asexually reproducing).

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- B. What cannot be patented?
 1. Laws of Nature
 2. Naturally occurring compounds (i.e., as they exist in nature)
 3. Abstract ideas
 4. Technology already known

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C. Types of Patents

1. Utility Patents cover machines, compositions of matter, processes, and improvements thereto. Biotech patents are usually utility patents.
2. Design patents cover the ornamental design or layout of an article (e.g., tire treads, style of a chair, etc.).
3. Plant patents cover asexually reproducing plants. Sexually reproducing plants are not covered under the patent laws. Instead covered under the Plant Variety Protection Act.

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4. Provisional Patent Application: informal; must meet written description requirements.

III. REQUIREMENTS FOR PATENTABILITY

- A. Useful – the invention must have a utility.
Generally a low standard
- B. Novel – the invention must be different than what has come before (i.e., not in the “prior art”)
- C. Not Obvious – the invention must not be obvious in view of the prior art, e.g., claiming a pen with blue ink instead of black ink (prior art).

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- D. The application must fully describe how to make and use the invention, and describe the best mode to carry out the invention.

All patent applications must meet these criteria, including Biotech patent applications. Failure to meet any of these criteria will prevent a patent from being issued.

IV. HOW DOES ONE OBTAIN A PATENT?

- A. Must apply for a patent at the U.S. Patent and Trademark Office (USPTO, an administrative agency of the U.S. Department of Commerce)

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1. Attorney/Agent prepares patent application based in information provided by the inventors.
2. USPTO assigns a Patent Examiner to examine (review) the application for compliance with statutory criteria (subject matter, novelty, obviousness, clarity).
3. Examiner rejects application for not meeting one or more statutory criteria.
4. Attorney/Agent prepares response/amendment to Examiner's rejections.

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5. Examiner allows application.
6. Patent Issues.

Generally, the entire process takes about 18-24 months. Cost ranges from \$5,000 -- \$50,000+ depending on the situation.

Patents can be enforced through the Federal courts.

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VI. USE OF PATENTS

A. Rights of the Patent Owner:

“Whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.”

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- B. Owner can make, use or sell the patented invention himself, and prevent others from making, using, or selling the patented invention.
- C. Owner can License the rights to make, use or sell the patented invention to someone else (ownership does not change).
- D. Owner can Assign the rights in the invention to someone else (ownership changes)

VII. FOREIGN PATENTS

- A. Patents have a territorial effect. A U.S. patent is enforceable only in the U.S., its territories, and possessions.

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- B. There is no “World Patent” that gives protection worldwide. Must obtain patents in individual countries or territories. Each country has its own patent laws with which your application must comply. Prosecution done with the aid of a Foreign Associate.
- C. The Patent Cooperation Treaty (PCT) provides preliminary examination of international application prior to entering the patent process for individual countries.

What is a Trademark or Service Mark?

- A **trademark** is a word, phrase, symbol or design, or a combination of words, phrases, symbols or designs, that identifies and distinguishes the source of the goods of one party from those of others.
- A **service mark** is the same as a trademark, except that it identifies and distinguishes the source of a service rather than a product.

Registration is Not Required

- You can establish rights in a mark based on legitimate use of the mark. However, owning a federal trademark registration on the Principal Register provides several advantages, e.g.,
- Constructive notice to the public of the registrant's claim of ownership of the mark;
- A legal presumption of the registrant's ownership of the mark and the registrant's exclusive right to use the mark nationwide on or in connection with the goods and/or services listed in the registration;
- The ability to bring an action concerning the mark in federal court;
- The use of the U.S registration as a basis to obtain registration in foreign countries; and
- The ability to file the U.S. registration with the U.S. Customs Service to prevent importation of infringing foreign goods.

Trademark symbols TM, SM and ®

- Use "TM" (trademark) or "SM" (service mark) designation to alert the public to your claim, regardless of whether you have filed an application with the USPTO.
- Use the federal registration symbol "®" **only** after the USPTO actually *registers a mark*, and **not** while an application is pending.

Types of TM Applications

- “Use” Application – Actual use of the Mark in Commerce.
- “Intent to Use” – Applicant intends to Use the Mark in Commerce at a future date.

Mark Distinctiveness

- A mark must be distinctive (i.e. capable of distinguishing the product or service from others.)
- Trademarks are classified according to their level of distinctiveness and are afforded protection according to their classification.

Mark Distinctiveness

- Arbitrary or fanciful marks (most distinctive) have no relation to the goods (e.g. Apple for computers) and fanciful marks are coined or invented names (e.g. Kodak film).
- As long as they are not confusingly similar to other marks, arbitrary or fanciful marks are afforded the highest level of protection.

Mark Distinctiveness

- Descriptive marks (medium distinctiveness) describe an attribute, function or use, characteristic, purpose or quality of the goods or services (e.g., “Video Buyer’s Guide”)
- Descriptive marks are only eligible for trademark protection if they acquire secondary meaning (consumer recognition of the term as a trademark.)

Mark Distinctiveness

- Generic Marks (least distinctive) are the common name for the product or service (e.g., “DESK”, “COLA”, “PERFUME”).
- Generic marks are incapable of protection under trademark law because others need to use the common name to compete effectively.
- Marks can turn generic unless used properly:
ASPIRIN; CELLOPHANE; LINOLEUM;
ESCALATOR

USPTO Examination

- Examining Attorney examines TM application for technical and legal criteria.
- Registration usually refused due to lack of distinctiveness.
- Attorney argues and/or amends the mark or description of goods/services.
- Registration allowed.

Owner's Rights in the Registered Mark

- Rights in a federally-registered trademark can last indefinitely if the owner continues to use the mark on or in connection with the goods and/or services in the registration and files all necessary documentation in the USPTO at the appropriate times.
- In general, the owner of a registration must periodically file:
 - Affidavits of Continued Use or Excusable Nonuse; and
 - Applications for Renewal.
- Cf: Patents have limited lifetime