



An Introduction to Patent Law

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ALL Businesses Have Intellectual Property Issues

- **They often don't know that they even own or are using intellectual property**
- **They often don't know (or care) that they are using the intellectual property of others**
- **Their advisors often don't know, either**

ALL of Businesses Have Intellectual Property Issues

**When you can identify IP issues you
can:**

- **Identify valuable assets**
- **Identify problems early, saving money**
- **Create new assets**

What is “Technology”?

“A USEFUL THING”

What's the connection?

***USEFUL* =**



INTELLECTUAL PROPERTY

Patents

Trademarks

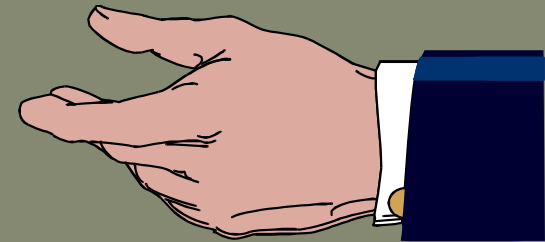
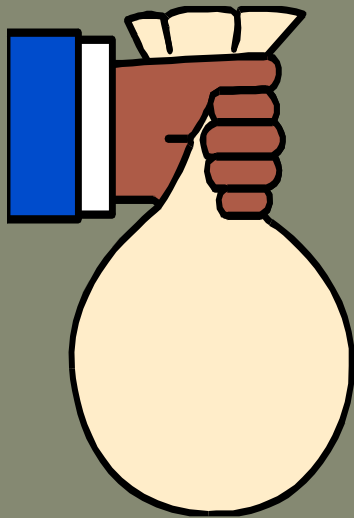
Copyrights

Trade Secrets

BUNDLES OF RIGHTS

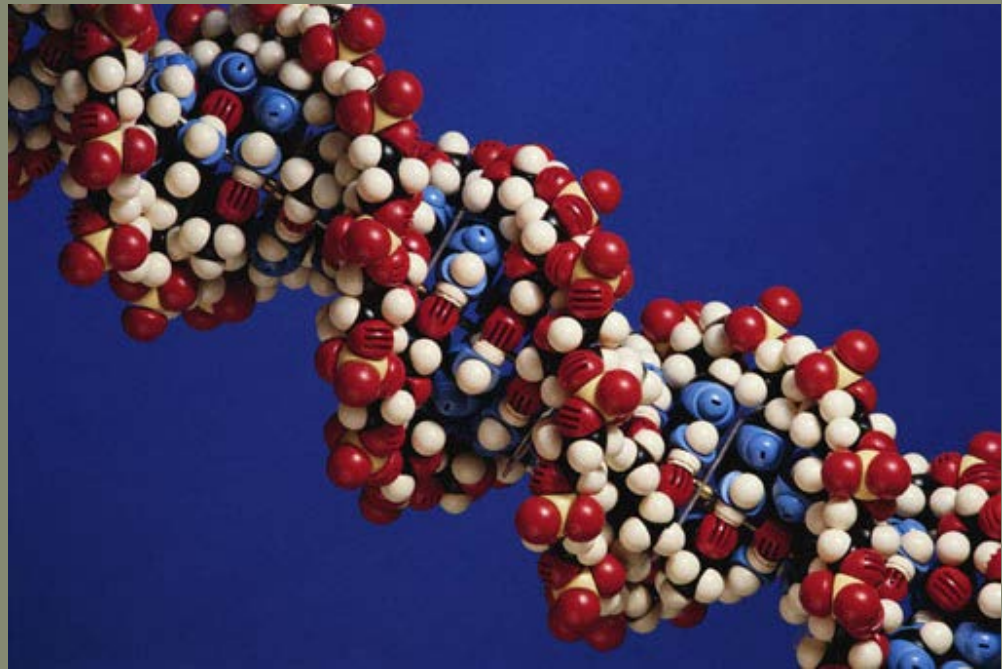


RIGHTS ARE DEALT WITH AS PROPERTY





PATENTS



WHOSE LAW?

- **U.S. patents are governed by federal law, which preempts state law**
- **There can be no state patents**
- **Each country has its own patent laws**
- **In some cases, the laws differ, particularly between the U.S. and the rest of the world – filing dates can be paramount***

***U.S. law has changed, making filing dates critical**

The Law is Changing!



Leahy-Smith America Invents Act

Getting patents – changes for applicants

- Prior art and “disclosures”
- The “first inventor to file” system
- Third party filing of prior art
- Prioritized examination

Changes at the Patent Office

- Funding caps, fee increases, and “micro-entities”
- Satellite offices

Using patents – changes for patentees

- Post grant review and inter partes review
- Virtual marking
- Prior user defenses

WHAT CAN BE PATENTED?

- **Processes**
- **Machines**
- **Articles of manufacture**
- **Compositions of matter**
- **Processes involving uses of known things**
- **Improvements in any of the above**

“COMPUTER” OR “BUSINESS METHOD” PATENTS*

- **Methods formerly thought unpatentable**
- **Methods of doing business**
- **Marketing plans**
- **Storage, retrieval and manipulation of data**
- **Old methods or technology enhanced by digital technology**

***Limited by recent case law**

WHAT DEFINES A PATENT?

- **Written “claims” describe a useful, novel and non-obvious invention**
- **The claims may describe a combination of parts which combine to form an apparatus or compound**
- **The claims may describe steps in a method**

THE PATENT PROCESS



PROCEDURE IN THE U.S. PATENT OFFICE

- **File a patent application with the United States Patent and Trademark Office**

DISCLOSURE

- **Must teach those of ordinary skill how to make and use the invention**
- **Must disclose the preferred embodiment of the invention**
- **Must be clear**
- **Should be written so that ordinary people (judges, jurors, the public) can understand the invention**

SECRECY OF PATENT APPLICATIONS:

- **Inventors must elect confidentiality, as well as consider the effects of such an election on foreign patent rights; otherwise, all patent applications are published**

PROCEDURE (continued)

- **Patent Office conducts search of prior art (mainly U.S. and foreign patents, but can include any publication anywhere in the world)**

DEFINITION OF PRIOR ART

- **Includes anything on sale or in public use or disclosed in a printed publication anywhere in the world***
- **This includes sales, public uses, or publications by anyone, including the inventor**

***Reflects a change in the law**

DEFINITION OF PRIOR ART

- **Duty of Candor – An inventor and the inventor’s attorney must disclose to the U.S. Patent Office all relevant prior art known to them**

PROCEDURE (continued)

- **The patent examiner issues an office action; makes determination as to whether invention as claimed is “novel” and “nonobvious” over the prior art**
- **If patent examiner believes the invention meets these criteria, the examiner will grant a patent**

TERM OF PATENTS

- **20 years from the filing date of the patent application**
- **Must maintain the patent by paying maintenance fees or annuities (in other countries)**
- **Must use the patent (in some countries other than the U.S.)**

Marking

- **A key requirement to maximize damages in infringement actions**
- **Must mark patented goods according to the statute***

***Virtual marking now available**

HOW TO SCREW IT UP:

- **Fail to file the patent application (U.S.) within 1 year of:**
 - **the first printed publication of the invention**
 - **the first offer for sale of the invention, or**
 - **the first public use of the invention**
- **Fail to file first. The first to file prevails, **NOT** the first to invent***

***Reflects a change in the law**

HOW TO SCREW IT UP:

- **In most foreign countries, fail to file a patent application before any of the aforementioned events occur (no 1-year period)**
- **The Patent Cooperation Treaty allows for filing in one country to qualify as filing in others, and provides one year to make the decision to designate other countries; **but, filing in other countries must comply with the laws of those countries****

HOW TO PRESERVE RIGHTS:

- **File a “provisional patent application”**
- **A provisional is simply a complete, detailed disclosure of the invention**
- **It provides the inventor with a provisional filing date for one year**
- **The inventor must convert the provisional application to a normal patent application within the year**

WHAT DOES THE PATENT GIVE THE INVENTOR?

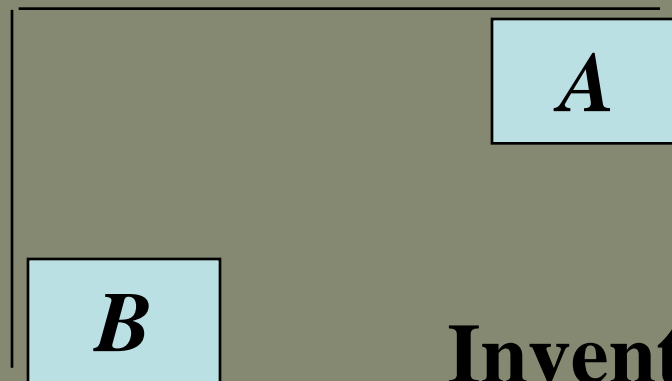
- The **exclusive right to prevent others from making, using or selling the invention**
- **Not the exclusive right of the inventor to make, use or sell the invention**
- **Not a right to make money on the invention**



INFRINGEMENT

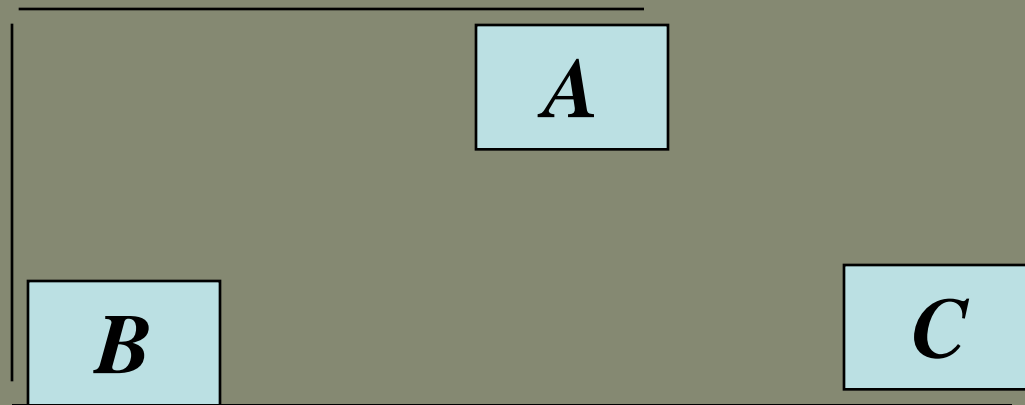
To prove infringement, the patent owner must prove that the accused technology has all of the elements of one or more of the claims of the patent

A SIMPLIFIED EXAMPLE



Invention 1
comprises part A
connected to part B

A SIMPLIFIED EXAMPLE



**Invention 2 comprises part A
connected to part B, which is
connected to part C**

A SIMPLIFIED EXAMPLE

- **If Invention 1 is patented, Invention 2 infringes the patent on Invention 1 because Invention 2 still has part A connected to part B, as in Invention 1, despite the fact that the Invention 2 inventor added a feature, part C.**
- **However, Invention 2 may be patentable, if the A-B-C combination is novel and non-obvious. But, the owner of Invention 2 needs a license from the owner of Invention 1 in order to make, use or sell Invention 2.**

A SIMPLIFIED EXAMPLE



**Invention 3 comprises part A
connected to part C**

A SIMPLIFIED EXAMPLE

- **Invention 3 infringes neither Invention 1 nor Invention 2, since part B has been eliminated, and now Invention 3 does not have all of the features of Invention 1 or Invention 2.**
- **In order to “design around” an existing patent, one must eliminate an element of the claimed invention.**

***CONTROLLED
DISCLOSURE***

JONES 
WALKER

INFORMATION



Bundles of Rights



Remember, in any commercial situation we are dealing with bundles of rights. If we have not developed the rights, there is nothing to own, transfer or protect!



THANK YOU!

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