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Intellectual Property Law (Quickstudy: Law)

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INTELLECTUAL PROPERTY

PATENT LAW

MAIN SOURCES OF THE LAW

- U.S. Constitution, Art. I, § 8, cl. 8; creates upon Congress the power "to promote the progress of science and the useful arts by securing for limited times to... inventors the exclusive right to their discoveries"
- Federal statutes - [35 U.S.C. § 100 et seq.]
- Federal regulations - [37 C.F.R. § 1.01 et seq.]
- Federal judicial precedents

WHAT IS A PATENT?

- A patent is a "negative right": a limited right temporarily to exclude others from making, using, selling or importing that which falls within the "claims" of the patent
- Patent holder may exploit a patent but may not infringe the rights of other patent holders
- Patent generally enjoys 20-year term, non-renewable; extension of up to 5 years based on Patent Office delays
- COMPARE:** trade secret protection applies to inventions *only* after you make public; trade secret law protects against others misappropriating the invention but not against others who "independently conceive" of the same invention

WHAT IS PATENTABLE?

- Patentable:** any new, useful process, machine, article of manufacture, or composition of matter in any new, useful improvement [35 U.S.C. § 101]
- Includes:
 - Process including business, artificial intelligence and mathematical processing-related inventions
 - Product: a composition of matter; a manufactured item (even natural product of nature often is a machine, a non-naturally occurring plant)
 - Design: the ornamental aspects of objects of utility, e.g., auto head ornaments
 - Substance: invented to "essentially" objects of utility
 - Distinctive form of design patent is about 14 years
- Not patentable:**
 - Laws of nature
 - Abstract ideas
 - Naturally occurring plants or animals
 - Things that are *supernatural* (spirits)

ANALYZE PATENTABILITY

- Must be "new" i.e., not published or known to public [35 U.S.C. § 102] must not be found in "prior art"
- "Prior art" includes anything found in previously issued patents, published patent applications, published articles, white papers, lecture slides, even sales brochures
- Disclosure of an invention under a non-disclosure agreement is not "public disclosure"
- "Public disclosure" of invention, except by theft or contract breach, strips eligibility for patent unless patent application has been filed
- Must be "novel" i.e., the invention must reach a specific or identifiable utility [35 U.S.C. § 103]
- Must be "non-obvious" [35 U.S.C. § 103]
 - Invention must have an "inventive step"
 - Does not require a "flash of genius"
 - Obviousness analysis does not apply a mechanical rule:** must consider whether the invention results from "obviousness and common sense" that a person of ordinary skill in the art would employ," including things it would be obvious to try
 - Biologically related machine's work on a new invention

Statutory bar of obsolescence

- Survey the scope and content of prior art
- Analyze differences between the invention and prior art
- Determine the ordinary skill that is part of the art
- Secondary considerations, including **Johns-Dacey** factors that account:
 - Whether the invention addresses long-unmet needs
 - Absent of resources devoted to solving the problem
 - Number of people attempting to solve problem
 - Commercial success (does reach the invention displaced prior solutions)

LEGAL DATE OF INVENTION

- U.S. patent law protects the person who *invents first*, not the person who files first [COMPARE: foreign patent law systems protect the first person to file]
NOTE: check for legislative changes in U.S. law
- Several ways to establish date of invention:
 - The date the invention is recorded in a tangible medium (e.g., a drawing or specification filed if signed by independent witnesses)
 - The date the invention was first used in the "substantial practice"
 - The date the patent application is filed, treated as "constructive reduction to practice"[TIP: produce supporting filing or early use records]

APPLICATION FOR PATENTS

- To apply for a patent:
 - Prepare a clear written description of the invention (general application), which provides a "full teaching" of the invention so that another could make or implement it
 - File with the U.S. Patent & Trademark Office ("USPTO"), by Express Mail, first-class mail or electronically
 - File appropriate:
 - the application
 - the fee
 - the declaration of inventorship
 - Application must name the actual inventor(s) [CAUTION: multiple inventors may arise if they contributed to the actual claimed invention, even if some did not work together or did not attend meetings]
 - The patent application is not processed for the inventor's lack of formal education or ignorance of technical terms
 - Inventors may represent themselves in the patent process or may employ an attorney or agent admitted to practice before the USPTO
 - Producer suggests filing an application before publicly disclosing the invention, some inventors, however, test sales volume of invention before committing the funds to apply and prosecute the patent, given the "initial monopoly" the patent provides, consider, however, *forever* of foreign novelty if relevant invention never prior to patent filing

PROVISIONAL PATENT APPLICATIONS

- U.S. law permits filing a "provisional application" for a reduced fee and without formal requirements (i.e., claims not required)
- Provisional applications are not examined and are not made public
- A provisional application is useful to obtain a priority date recognized in the U.S. and under the Paris Convention Treaty (PCT), or long as a U.S. non-provisional or PCT patent application is filed not later than 1 year after the provisional filing

PATENT PROSECUTION

- Patent prosecution refers to process of patent application and the examination by the USPTO.

Patent Examiner evaluates the merits of the application

- Application should include these elements:
 - Title
 - Cross-reference to other patents
 - Statement regarding federally sponsored research or development
 - Background of invention
 - Brief summary of invention
 - Brief description of drawings (if any)
 - Detailed description of invention
 - The claims of the invention
- Statutory bar: 37 C.F.R. § 1.72 et seq., 37 C.F.R. § 1.77
- USPTO publishes applications 18 months from first priority date, unless applicant timely requests non-publication
- Re-issue:** allows later correction of defects in original patent
- Re-examination:** allows a third party to request a judicial examination of an existing patent
- Judicial review: U.S. Court of Appeals for the Federal Circuit provides appellate review of patent decisions

PATENT INFRINGEMENT

- Infringement:** when a non-owner of a patent makes, uses, imports, offers for sale or sells a substantially identical invention, design or process without the owner's authorization [35 U.S.C. § 271]
- Scope of Infringement:** no two identical copies, but bringing into the marketplace, but necessary limited to necessary damages calculated for 6 to 9 years prior to filing of lawsuit
- First sale rule:** the patent holder's rights do not extend beyond the "first sale" of the patented item, the buyer of a patented item may use it to sell the item, the buyer may repair a patented item, provided the repair does not amount to "making" the new

ELEMENTS OF PROOF OF INFRINGEMENT

- Determine the scope of patent's "claims" (a question of law for a judge; may be determined in **Markman** pre-trial hearing)
- Determine if the accused infringer's falls within the scope of the "claims" (a question of fact that may be decided by a jury)

TYPES OF INFRINGEMENT

- Literal infringement:** when the accused item overlaps the "claims" of the patented item
- Under the "doctrine of equivalents," the accused item infringes the patent if the item performs substantially the same function in substantially the same way to accomplish substantially the same result
- File wrapper estoppel:** any changes to the patent application made during the course of prosecution cannot be argued or pleaded after the patent issues, changes made to narrow the claims prior to issuance of the patent cannot later be challenged

TYPES OF INFRINGERS

- Direct infringer:** one who makes, uses or sells the patented invention without permission
- Indirect infringer:** encourages others to infringe
- Contributory infringer:** knowingly offers for sale or supplies items which only can be combined with a patented invention

DEFENSES TO INFRINGEMENT ACTION

- Inability of the patent
- Patent misuse:** unlawful extension by the patent owner of the limited monopoly conferred by the patent
- First sale defense:** applies where conventional use of the business method more than a year prior to the



Synopsis

A one-stop resource for students, inventors, writers, attorneys and businesses, this 3-panel (6-page) guide contains the latest, most comprehensive information on all aspects of IP law—from patent and trademark application to copyright infringement. Stumped by what Fair Use governs? Eager to learn every aspect of the Lanham Act? Look no further than this no-nonsense resource! Written in our fluff-free format, this guide™s need-to-know information is conveniently divided into sections that correspond to the 3 main areas of IP Law: Patent Law Copyright Law Trademark Law Plus, it includes a special section for easy reference for students and IP professionals: Selected Federal IP Statutes Useful Internet IP Links

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