

PATENT BASICS: Protect Your Invention

Gary Con XIV - 25Mar22



Hibbs Law, LLC

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- ▲ Intellectual Property boutique firm **founded in 2013**
- ▲ **Bar Admissions:** Illinois, US Northern District IL, US Patents & Trade Office
- ▲ **Focus Areas:** Patents, Trademarks, Copyrights, Unfair Competition, Trade Secrets, Infringement Enforcement/Litigation, Licensing, Entity Formation, Regulatory Compliance, and Business Transactions.
- ▲ **Clientele:** Small business, medium corporations, individuals
- ▲ **Expertise**
 - ▲ **Genna:** Biotechnology, Genetics, Small Business, Government,
 - ▲ **Emily:** Regulatory, International Law, Trademark, Copyright, Privacy
- ▲ **Gaming Experience:**
 - ▲ **Genna:** TTRPG, MTG, WH40K, FPS
 - ▲ **Emily:** Browser-based RPG games
- ▲ Substantial dedication to **pro bono** legal services (20-30% of time)



Legal Disclaimer

- ▲ **Nothing** in this presentation is meant to imply or suggest that an attorney-client relationship is created through this presentation or related communications.
- ▲ After a private initial client meeting, a signed **letter of engagement** would be the official step to create that relationship with Hibbs Law, LLC
- ▲ Legal analysis is largely fact-based and involves a full examination of all details and factors. **General rules** presented, or questions asked and answered, are posed as hypotheticals, and should not be relied on as legal advice. The most common answer to a ‘simple’ legal question is: “It depends.”



Presentation Outline

- ▶ Part 1: Statutory Requirements: Sections 101, 102, and 103
 - ▶ Sec 101: one invention, subject matter, utility;
 - ▶ Sec 102: prior art, public disclosures;
 - ▶ Sec 103: non-obviousness.
- ▶ Part 2: Application Components:
 - ▶ Filing Date requirements;
 - ▶ Sec 112 Enablement;
 - ▶ Types of applications.
- ▶ Part 3: Patent Prosecution



Part 1: Statutory Requirements: Title 35, Sections 101, 102, and 103

- ▶ Sec 101: one invention, subject matter, utility;
- ▶ Sec 101: patentability;
- ▶ Sec 102: prior art, public disclosures;
- ▶ Sec 103: non-obviousness.



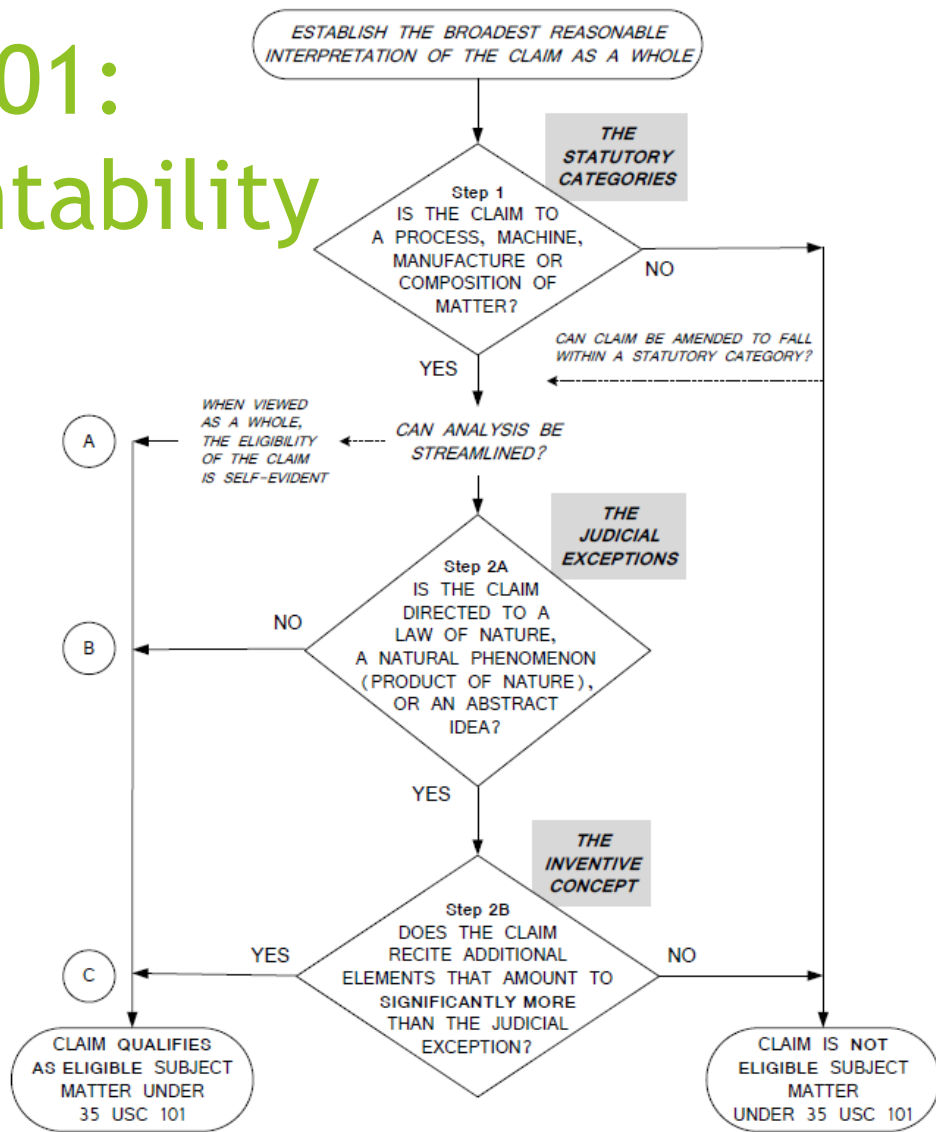
Sec 101: one invention, subject matter, utility, novelty

- ▶ 101: “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”
- ▶ Process/Methods –an act or series of acts/steps
- ▶ Machine—concrete thing, consisting of parts or devices/combination of devices
- ▶ Manufacture—article (hand or machine) produced from raw or prepared materials, new form, quality, property, or combination
- ▶ Composition of Matter—all compositions of two or more substances and all composite articles whether chemical union, mechanical mixture, gases, fluids, powders, or solids.
- ▶ Subject matter exception: abstract ideas, mental processes, laws of nature, and physical phenomena.

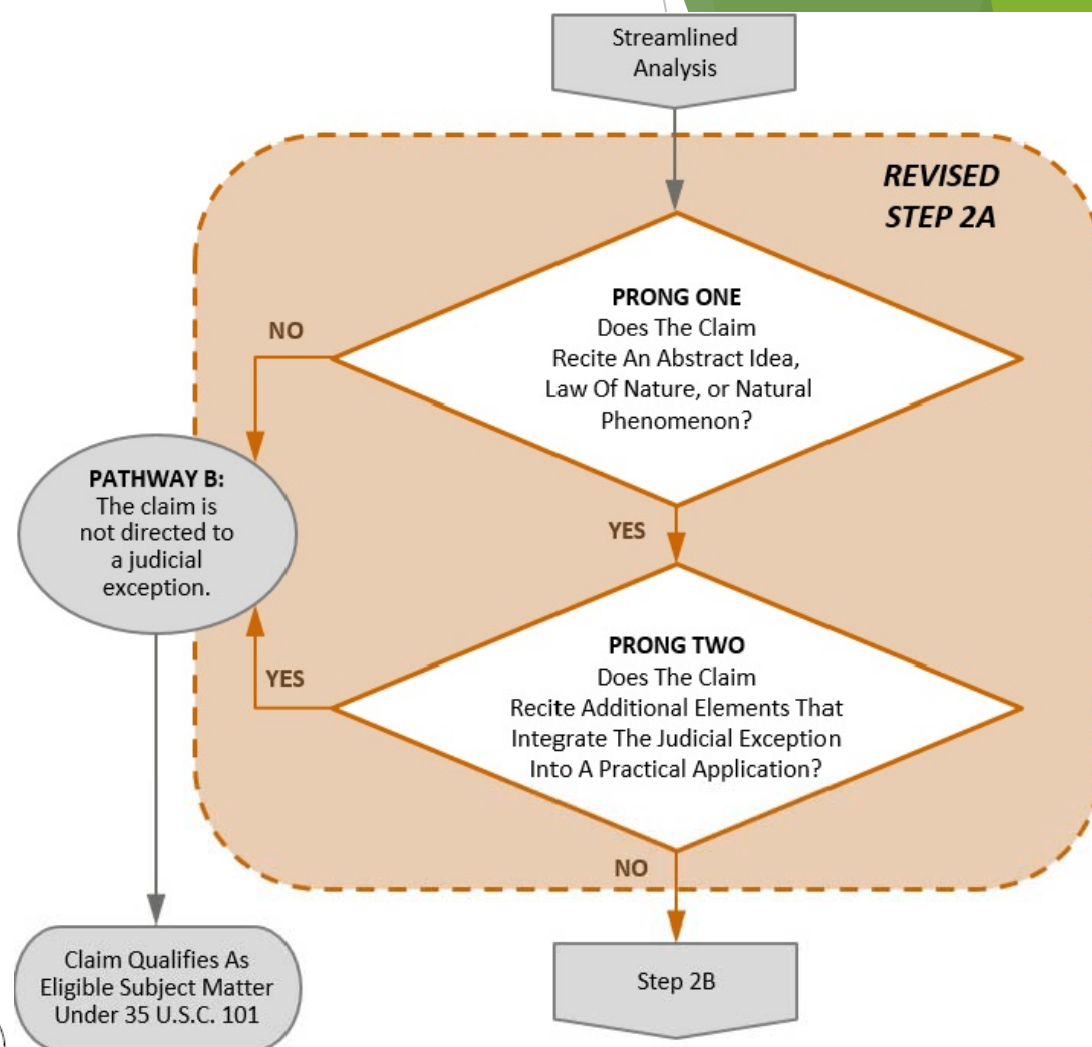


Sec 101: Patentability

SUBJECT MATTER ELIGIBILITY TEST FOR PRODUCTS AND PROCESSES



A **B** **C** → THE PATHWAYS TO ELIGIBILITY



Sec 102: prior art, public disclosures; anticipation.

102(a) “NOVELTY; PRIOR ART.—A person shall be entitled to a patent unless—

- (1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; or
- (2) the claimed invention was described in a patent issued under section 151, or in an application for patent published or deemed published under section 122(b), in which the patent or application, as the case may be, names another inventor and was effectively filed before the effective filing date of the claimed invention.”

102(b) EXCEPTIONS.—

- (1) DISCLOSURES MADE 1 YEAR OR LESS BEFORE THE EFFECTIVE FILING DATE OF THE CLAIMED INVENTION
- (2) DISCLOSURES APPEARING IN APPLICATIONS AND PATENTS

One year deadline before filing date for inventor’s disclosures; Third-party disclosures (not taken from inventor) will be PA against the application.

102(c) Joint Research Agreement and Assignment specifics.



Sec 103: non-obviousness

Sec 103: No patent allowed “...if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.”

Graham v. John Deere Obviousness (MPEP 2100):

- (A) Determining the scope and content of the prior art; and
 - (B) Ascertaining the differences between the claimed invention and the prior art; and
 - (C) Resolving the level of ordinary skill in the pertinent art.
- ▶ “**secondary considerations,**” may include evidence of commercial success, long-felt but unsolved needs, failure of others, and unexpected results.



Part 1: Wrap-up

- ▶ 'One' invention;
- ▶ Any utility;
- ▶ Subject matter;
- ▶ Patentability;
- ▶ Keep track of time, document and journal;
- ▶ Save non-obviousness evidence; and
- ▶ Download and prepare the forms ahead of time.



Part 2: Application Components

- ▶ Basic overview of application components
- ▶ Minimum requirements for an official filing date
- ▶ Enablement
- ▶ Brief explanation of types of applications



Basic overview of application components & effective filing date

- ▶ **Filing date** can be crucial: minimum filing requirement of the specification with or without claims, drawings if necessary; Oath/Declaration, Fee, and Drawings can be filed later for surcharge.
 - ▶ Provisional appl also requires ADS identifying it as provisional.
- ▶ Forms can be downloaded from uspto.gov (see handout).



Enablement under Sec 112

- ▶ Specification needs to enable a POSITA to be able to make the invention.
- ▶ When it comes to writing your specification, more is better.
- ▶ Follow the subparts: title, priority, background, brief summary, brief description of drawings, detailed description of invention, claims, & abstract.



Brief explanation of types of applications

- ▶ Provisional (12mo placeholder)
- ▶ Non-provisional (aka everything else)
 - ▶ Utility
 - ▶ Design
 - ▶ Plant
- ▶ Continuing applications: continuation, divisional, & continuation-in-part



Part 2: Wrap Up

- ▶ Effective Filing Date is important
- ▶ More is better for your specification
- ▶ Use the guides and MPEP on uspto.gov
- ▶ Be prepared for obviousness rejections



Part 3: Patent Prosecution

- Missing Parts
- Office Actions (non-final and final)
- RCE
- PTAB
- Allowance and Issue fee



QUESTIONS?



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