PUBLISH AND YOUR PATENT RIGHTS MAY PERISH

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SYMPOSIUM ON WHAT CHEMISTS NEED TO KNOW ABOUT INTELLECTUAL PROPERTY

DIVISION OF CHEMICAL INFORMATION
230TH NATIONAL MEETING
AMERICAN CHEMICAL SOCIETY
WASHINGTON, DC

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COMPLEX SUBJECT

- CONSTITUTIONAL CHARTER
  - “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”

- LEGISLATION SINCE 1790

- FREQUENT RECENT CHANGES IN LAW – 1995, 1999, CURRENT BILL

- MANY COURT CASES

- FULL EMPLOYMENT FOR PATENT LAWYERS
OUTLINE

- BRIEF PATENT TUTORIAL

- PROBLEM AREAS
  - Publication
  - Presentation
  - Use in public or known
  - Sold or offered for sale
PUBLIC POLICY BEHIND PATENTS

- RIGHT TO EXCLUDE OTHERS FROM MAKING, USING, SELLING, IMPORTING FOR LIMITED PERIOD OF TIME
- IN RETURN – PUBLICIZE THE INVENTION
- PROMOTES INNOVATION
- NOT CLASSIC MONOPOLY
A PATENT IS ANY USEFUL PRODUCT OF HUMAN INGENUITY

- PROCESS OR METHOD
- MACHINE
- MANUFACTURE OR APPARATUS
- COMPOSITION OF MATTER
A PATENT IS NOT

- SOMETHING OCCURRING IN NATURE OR LIVING THING
  - But human ingenuity applied to article of nature or living thing may be

- PRINCIPLE OF SCIENCE

- TRANSLATION OR ALTERNATE LANGUAGE
SPECIAL CASE OF COMPUTER PROGRAMS

- AT FIRST NO – MERE TRANSLATION OR ALTERNATE LANGUAGE
- LATER – OK IF IT ASSISTS IN DOING SOMETHING PATENTABLE
- MORE RECENTLY – BROADENED TO INCLUDE “BUSINESS METHODS” – AN ALGORITHM TO MAKE INVESTMENT DECISIONS.
- QUESTION – ARE ALL DECISION TOOLS BUSINESS METHODS?
REQUIREMENTS FOR A PATENT

- PATENTABLE SUBJECT MATTER
- USEFUL
- NOVEL – NO ONE REFERENCE CAN ANTICIPATE THE INVENTION
- NOT OBVIOUS TO ONE ORDINARILY SKILLED IN THE ART – A COMBINATION OF REFERENCES
REQUIRED PARTS OF A PATENT APPLICATION

- WRITTEN DESCRIPTION
- ENABLEMENT
- BEST MODE
- CLAIMS
NOVELTY IS LOST IF

- Prior publication, someone else, before you invented
- Your invention was:
  - published
  - presented
  - used in public or made known
  - sold or offered for sale
- You abandoned the work
- You are not the inventor
- One year grace period in US – future uncertain
PRIOR PUBLICATION BY SOMEONE ELSE

You Can Prove You Invented Before The Publication (Simple Declaration)

You Can Prove Prior Invention To A Patent Or Application (Interference Proceeding)

Both Of These May Disappear In Current Legislation
PUBLICATION BY YOU –
THE BIG PROBLEM

- PUBLICATIONS INCLUDE
  - Articles
  - Abstracts
  - Electronic distribution
  - Thesis when cataloged
PUBLICATION BY YOU –
THE BIG PROBLEM

- TESTS
  - Is invention enabled
  - Publication available to public
  - Good news – peer review is not a problem
  - Bad news – if not disabled by anticipation, may be by obviousness analysis
  - Bad news – if published part of invention, the rest may lose economic value
PRESENTATION BY YOU – ANOTHER PROBLEM

- SHOULD BE SAME CRITERIA IF FOUND OUT

- NOT HELPFUL
  - Abstracts
  - Handouts

- POSTERS?
  - Recent case
  - Brevity hurts
OTHER PROBLEM AREAS

- USED IN PUBLIC OR KNOWN
  - If in completed, enabled form
  - Not if public experimentation

- SOLD OR OFFERED FOR SALE
  - Concrete discussions between marketers, not experimental collaborations
WHAT YOU CAN DO

- IN US – ONE YEAR GRACE PERIOD
  - But out of luck internationally
  - May not survive legislation, treaty

- BEST STRATEGY – CONSULT WITH BOSSES OR YOUR ATTORNEY FIRST AND FILE APPLICATION BEFORE PUBLIC DISCLOSURE

- PROVISIONAL APPLICATIONS

- NON-DISCLOSURE AGREEMENTS IF COLLABORATING
SELECTED INFORMATION RESOURCES

- YOUR ORGANIZATION’S PROCEDURES MANUALS
- US PATENT AND TRADEMARK OFFICE – [WWW.USPTO.GOV](http://WWW.USPTO.GOV)
- WHAT EVERY CHEMIST SHOULD KNOW ABOUT PATENTS, 2nd ED – ACS COMMITTEE ON PATENTS & RELATED MATTERS
- WHAT IS A PATENT?, 2nd ED., AMERICAN BAR ASSOCIATION
HOW TO GET IN TOUCH WITH ME

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