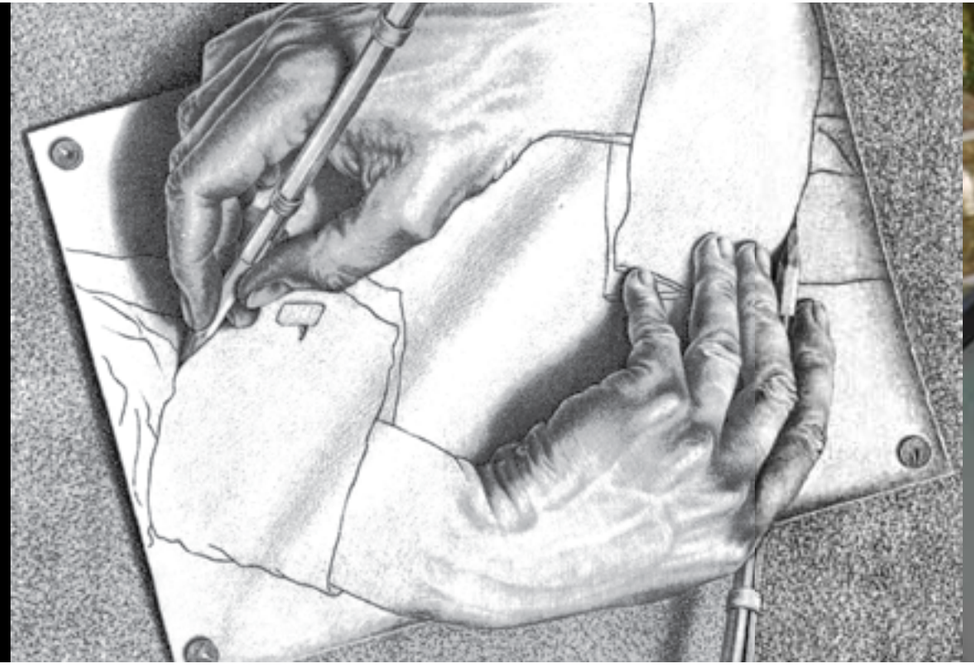
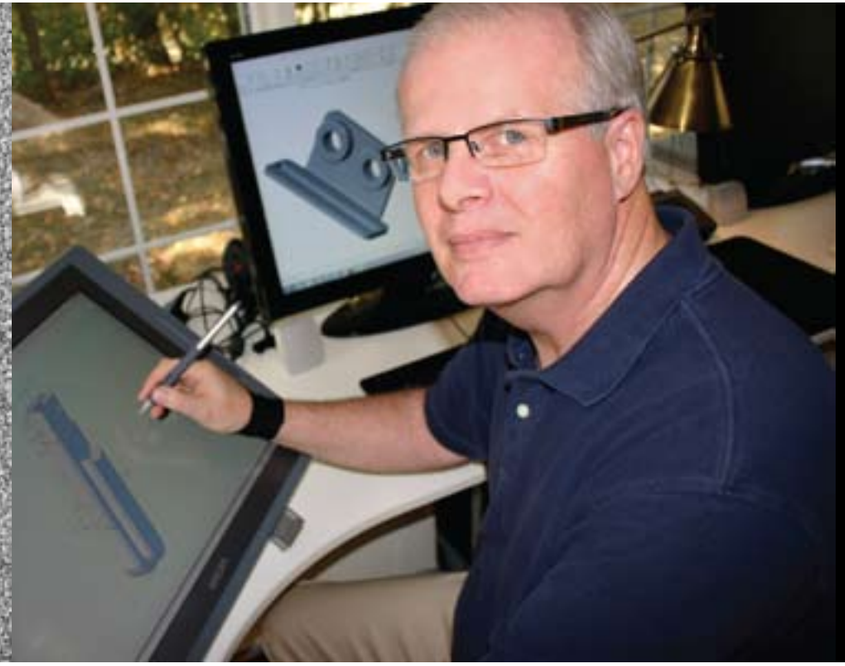
IPWatchdog

Drawn and Quartered

Mastering the Four Patent Requirements

By Gene Quinn





Patent illustrator Jack W. Smith has worked on over 3,000 projects for top law firms, corporations and inventors during his 40 year career.

In 1987 he founded Patent-Illustrators.com

Photo by Crary Brouhard.

Inventors are creative people who observe a problem and envision a solution. Practically anyone can be an inventor because the first step on the path to inventing is the generation of an idea.

Unfortunately, ideas can't be patented. For many, the path to invention stops there. But it doesn't have to.

Patents are not only for breakthrough innovations. In fact, it is far more common to have patents awarded to improvements on existing products, which often already enjoy market success.

There are four primary patentability requirements. An invention must be:

- Patentable subject matter
- Useful
- Novel (i.e., new)
- Non-obvious

If you satisfy these requirements, you are entitled to a patent on your invention so long as you adequately describe the invention. The law that governs adequate description is found at 35 USC § 112.

If you can adequately describe your idea with enough specificity, you have migrated past the idea boundary – you have something that can be patented if it is unique.

The adequate description requirement historically has had three major parts:

- Enablement
- Best mode
- Written description

The enablement requirement asks inventors to describe their inventions in a manner that would allow others in the industry to make and use the invention. Detailed procedures for making and using the invention may not be necessary.

You don't need to provide blue-prints or an idiot-proof description. But you're always better off shooting for the maximum level of detail. The more you describe the broader your rights can be. And as a practical matter, it's never a good idea to assume others will understand what you have disclosed.

According to the best mode requirement inventors must disclose their preferred way of carrying out the invention at the time of filing. There was no requirement that the preferred embodiment be updated as the patent application worked its way through the PTO.

However, with recent passage of the America Invents Act, the best mode requirement essentially has been eradicated from U.S. patent law.

Failure to disclose the best mode was grounds for invalidating a patent claim in litigation. Under the America Invents Act, claims that are issued can no longer be challenged after the fact for a failure to disclose the best mode.

But from a practical standpoint you really should be disclosing your preferences because if they are preferences that make the invention better, you will want to claim them to obtain exclusive rights over them.

If you don't disclose them, you cannot claim them. So best mode, although on the way out of U.S. patent law, should live on in spirit and practice.

The written description requirement serves as a "quid pro quo" in which the public is given meaningful disclosure in exchange for being excluded from practicing the invention for a limited time.

The written description requirement is a so-called four-corners requirement.Whatever you disclose within the four corners of the patent application is what you possess, nothing more. Leave it out and it is not yours even if it seems clear you accidentally left something out.

The written description requirement also is what the patent law uses to make sure that you are not claiming more than what you really have invented.

Samuel Morse of Morse code fame sought a patent on every use of electromagnetism. What he invented, however, was a revolutionary device that utilized electromagnetism to relay messages across long distances. So he received a patent on the specific implementation, not the theoretical.

Too often I see inventors who come up with the idea and want to cut through the middle steps and file a patent application. These inventors get frustrated and give up because they skip the middle steps and don't have an invention.

Anyone can have an idea. But those who work to put meat on the bones and put flesh on their ideas are the ones who can claim the mantle of inventor.

> Patent drawings are worth a thousand words and much more. The best part of drawings is that they are extremely cheap compared with the cost of creating a prototype. A patent illustrator typically charges between $50 to $250. Average price is $180.