

PATENTS

Patent law is one of the few areas of the law in which an attorney has long been allowed to advertise or acknowledge himself as a specialist. To be a patent lawyer, however, the attorney must have an undergraduate degree in some type of engineering, and must have sat for and passed an exam prepared by the United States Patent Office.

Patents can be issued for any useful process, machine, manufacture, or composition of matter, or any new or useful improvement of some already existing process or product. Not every invention is capable of being patented, however. In fact, the process of obtaining a patent can be quite long and involved.

Each patent applicant must establish to the satisfaction of the Board of Patent Examiners that the invention is 1) new, 2) useful and 3) non-obvious.

A product or process is considered new if it has not been the subject of a prior patent, a prior publication, or a prior public use. Indeed, if the inventor were to use the process in public, not disclosing the secret of the invention, but merely showing its benefits, he may find the patent cannot issue because the invention is no longer new.

Before a patent is issued, a search must be made of all existing patents to be sure that the "new" invention or some part of it is not already registered. Many times as several inventors work on their designs for the "better mousetrap", there will be a "race" to the patent office to be the first to make application for a patent for the process or product. You may have noted a notation on products that states "Patent pending". That designation means that the product itself, or the process by which it was manufactured, is the subject of a pending patent application with the United States Patent Office. This puts other applicants on notice that their own application may fail because it is not "new". As you can see, determining whether a product is new is not always easy, and, as you may expect, newness has been the subject of considerable litigation.

Even if you are able to establish that your invention is new, you must also establish that it is useful. Just because something is novel or unique is of no moment if it has no real benefit. By being forced to specify the utility of the invention in the application, the invention becomes less of an idea, with speculative utility, and more of a product or process which has definite uses. By requiring the invention to be useful, moreover, the government does not find itself in the position of having to consider items which are harmful or detrimental, or which are illegal or immoral.

ROTHMAN
&
GORDON
Just Right

Rothman Gordon P.C.
Attorneys At Law
310 Grant Street
Third Floor, Grant Building
Pittsburgh, PA 15219
phone 412.338.1110
fax 412.281.7304
www.rothmangordon.com

Finally, and perhaps, most confusing, an invention must be non-obvious. To evaluate whether an invention is non-obvious, you must be familiar with the "state of the art" concerning that invention at the time of invention. If any person skilled in the subject of which the invention is a part could have created the invention, the invention is obvious, and not patentable. If, however, the invention is a different or unexpected result given the state of the art, then it is non-obvious, and patentable.

If the owner of the invention is able to overcome the hurdles of newness, usefulness and non-obviousness and the patent is issued, he will have the exclusive right to use or market, or even to prohibit the use and marketing, of that particular formula or design for seventeen (17) years. Even if another inventor invented the same product or process without knowledge of the first invention, he could be precluded from merchandising his invention because of the registered patent. Patents also protect the inventor, not only from other legitimate inventors, but from entities using "reverse technology". With reverse technology, someone buys the patented product and then takes it apart or otherwise analyzes it to learn how it works. Knowledge of how the invention works will only be useful at the expiration of the patent period.

At the end of the patent period, the patent owner's exclusive rights expire and the formula or design is available for any entity to use in manufacturing a product. The purpose of the limited exclusive use is to encourage inventions which benefit society by giving the owner of the patent a limited period of time in which to exploit his exclusive rights in the invention. Because the invention is considered to be of benefit to society, however, the exclusivity of rights is limited.

Note that the patent owner may or may not be the inventor of the formula or design. Many times the actual inventor works for a company which, through its agreement with that inventor, pays the inventor to develop new ideas. Any ideas which the inventor develops, however, would be the property of the company, rather than the inventor.

Even if the inventor is not subject to such an agreement, however, he may sell or otherwise transfer his rights in the invention to a third party because the process of obtaining a patent can be both time consuming and costly. When establishing the right to a patent, the applicant must establish how it became the owner of the invention.