

The Limited Monopoly™

Patentability and Infringement - Two Separate Concepts

by John Hammond, PE and Robert Gunderman, PE

We occasionally see our clients interchange the concepts of patentability and infringement with regard to their inventions and/or issued patents. They are separate matters; thus a summary of the distinction between these two concepts is a good topic for this column. This month, we will cover patentability. Next month, we will continue with a discussion of infringement. We'll explain both using a hypothetical invention as an example.

First – The Basics

A patent is a property right that is granted by a government. It is the right to exclude others from making, using, or selling the invention described and claimed in the patent for a fixed period of time. Hence the term “limited monopoly” – the grant is limited to the term of the patent, after which the public is free to make and use the invention without obligation to the patent owner.

In the United States, the patent grant is made directly to the inventor, who may then assign his rights in the patent. Assignments are typically made to either the inventor's employer, or a company willing to buy the patent. The term of a U.S. patent is 20 years from the filing date of the patent application.

Patentability – Determining the “Right to Exclude”

Here in the U.S., patentability is a determination made by the United States Patent and Trademark Office. (Although if the patent is the subject of an infringement lawsuit, the determination may be overturned in a court of law.) For an invention to be patentable, it must be useful, novel, and unobvious.

Let's consider each of these three criteria individually, using a hypothetical invention shown in the nearby sketch as an example. Our invention is a “Portable Communication Station,” which we'll call the “Podiator.” In preparing a patent application for the Podiator, we would provide a complete written description and drawings showing how to make and use the invention. The application would conclude with one or more claims that distinctly describe the invention. The claims are what is considered by a patent examiner in determining patentability.

Our first independent claim might read as follows:

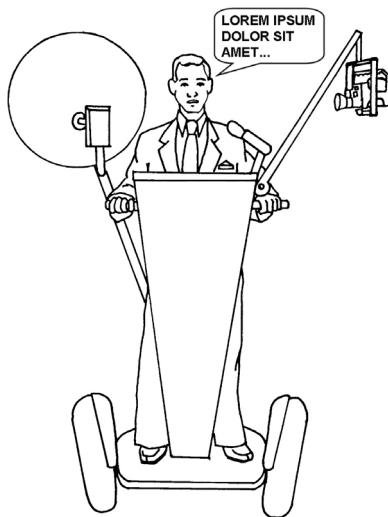
A portable communication station comprising:

- a. a frame including upper and lower sections;
- b. a platform joined to the lower section of the frame;
- c. a pair of wheels joined to the lower section of the frame;
- d. a motor operatively connected to at least one wheel;
- e. a steering controller;
- f. a podium joined to the frame;

“Inventors and patent owners frequently interchange the concepts of patentability and infringement with regard to their inventions and issued patents.”

- g. an audio-video recording device; and
- h. a wireless transmission antenna connected to the recording device.

So on to the first criterion – is it useful? We think so. Who could use it? Well, politicians for one. In this age of the 24/7/365 campaign, it's a must have. And how about our CEOs? They could practice MBWA¹ (well, actually MBRA²), while simulcasting their motivational messages to employees worldwide. So now we have established the Podiator as at least being



useful, if not The Next Big Thing.

Now the second criterion – is it novel? In performing examination, the patent examiner would perform a detailed search of the patent and non-patent literature, looking for a single reference that discloses the invention as described in our claim. If no reference could be found that described an invention having *all* of the limitations a. – h. recited in our claim (a fairly likely outcome), then the invention would be meet the criterion of novelty.

Finally, the third criterion – is it unobvious? The governing statute, 35 U.S.C. 103, states that a patent cannot be obtained if the differences between the claimed invention and the prior art are such that the subject matter as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made.

So let's start by considering what is described in just the limitations a. – e. Perhaps you recognize that part of the invention – limitations a. – e. describe the Segway® Personal

Transporter. So, all we have done is attach a podium, a video camera, and a satellite dish to a Segway® PT. As engineers, doesn't it seem obvious to us that that could easily be done? Of course it does.

However, we are rendering our judgment through the benefit of hindsight, once we have seen the invention. In determining obviousness, a patent examiner is not permitted to use the hindsight resulting from having studied the patent application. Instead, the examiner must consider a number of factors, including whether all of the elements of the claim are taught by a combination of two or more references, whether there is a suggestion in the references to combine the elements to make the claimed invention, and whether there is a motivation for someone “of ordinary skill in the art” to combine them.

There are some additional factors³ that an examiner must consider that are beyond the scope of this writing. Suffice it to say that unobviousness is the most subjective of the three criteria for patentability, and that it is a criterion that has continued to evolve through court decisions ever since the original “103” statute was enacted in 1952.

It's difficult to be certain without actually filing the patent application, but we think that there is a good chance that the Podiator as described in our claim would be found to be unobvious. Hence it would meet all three criteria – useful, novel, and unobvious – and thus it would be patentable.

To Be Continued

Next month, we will continue this column with a discussion of infringement, how it relates to patentability, and the importance of having the broadest claims possible in your patent application. Stay tuned.

1. Management By Walking Around.
2. Management By Rolling Around.
3. Known as the “Graham factors” from the case of *Graham v. John Deere*, 383 U.S. 1, 17 – 18, 148 USPQ 459, 467 (1966).

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Patentability and Infringement - Two Separate Concepts (Part 2)

by John Hammond, PE and Robert Gunderman, PE

We occasionally see our clients interchange the concepts of patentability and infringement with regard to their inventions and/or issued patents. They are separate matters; thus a summary of the distinction between these two concepts is good subject matter for this column. Last month, we covered the patentability half of our topic. This month, we will continue with a discussion of infringement below. We'll explain again using our hypothetical invention as an example.

Our "Invention" as a Case Study

First, let's review our hypothetical invention shown in the nearby sketch, and the scenario at hand. Our invention is a "Portable Communication Station," which we call the "Podiator." Assume that we are at the point where we have submitted a patent application for our invention, and that our efforts have been successful. The Patent Office has found our invention to be patentable (for the reasons discussed last month), and our U.S. patent has just issued for the Podiator.

In our patent, let's also assume that our first independent claim reads as follows: A portable communication station comprising:

- a. a frame including upper and lower sections;
- b. a platform joined to the lower section of the frame;
- c. a pair of wheels joined to the lower section of the frame;
- d. a motor operatively connected to at least one wheel;
- e. a steering controller;
- f. a podium joined to the frame;
- g. an audio-video recording device; and
- h. a wireless transmission antenna connected to the recording device.

Various dependent claims could follow our independent claim, reciting further features that our Podiator might include. For example, a dependent claim might include GPS, i.e. "The station of claim 1, further comprising a global position measurement device."

Lastly, and best of all, let's assume that the Podiator has become The Next Big Thing. The deluxe model (as described in the above claim) is being snapped up by politicians, CEOs, and traveling self-improvement hucksters as fast as we can make them.

Infringement - The Definition...

A patent owner's protection from patent infringement is found in 35 U.S.C. 271(a), which states, "Whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States, or imports into the United States any patented invention during the term of the patent therefore, infringes the patent." Let's start with a few key points regarding patent infringement.

First, for there to be patent infringement, there has to be an issued patent. A pending

"As a general rule of thumb, the fewer the words, the broader the claim: less is more when it comes to claim breadth."

patent application is not sufficient; there is no "right to exclude" available until a patent is granted. Additionally, the USPTO is not responsible for enforcing patents and pursuing infringers. There is no government "patent police" station where you can file an infringement complaint and have the infringer brought to justice. Infringement is a civil matter, and is adjudicated in a court of law.

Patent infringement litigation is difficult and expensive, and should only be undertaken with the advice of a competent attorney. More than likely, it will require several attorneys with

claim. If Bokshed makes a station that lacks any one element recited in our claim, they do not infringe.

A key point here is that claiming our invention by including *all* of the limitations f, g, and h (in order to be patentable over the Segway® PT) would be a fundamental error (and one that no competent patent practitioner should make). Such a claim is too narrow. It is quite likely that had we claimed the machine by reciting elements a. – e. and only the podium (element f), or only the camera or only the antenna, such a claim would be found patentable. Such a claim would also be broader – it is important to understand that the fewer the elements in a claim, the broader it is. (As a general rule of thumb, the fewer the words, the broader the claim: less is more when it comes to claim breadth.) Additional limitations such as a camera, an antenna, or an onboard GPS system could be recited in subsequent dependent claims. That way, our broadest claim would cover the Bokshed machine that includes only the podium along with elements a. – e., and we would have a case.

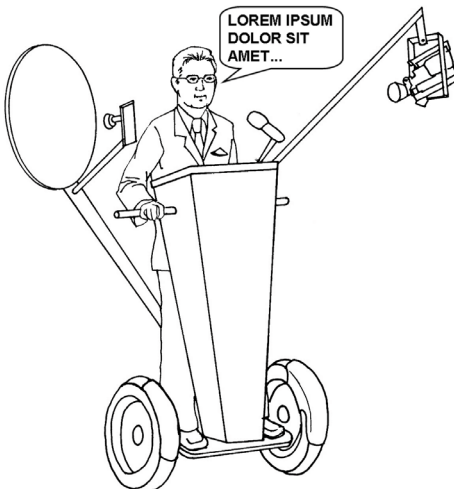
Distilling it Down

Here is a simplified way to keep the concepts of patentability and infringement straight. If you *add* elements together (even if they are known individually), and you produce an invention that is useful, novel, and unobvious, your invention is patentable. On the infringement side, if you *subtract* an element recited in a patent claim, i.e. make the invention without at least one element recited in the claim, you may avoid infringing the claim. In either case, it is best to seek the advice of a qualified practitioner. For matters pertaining to patentability, you may consult a patent agent or an attorney; and for infringement matters, an attorney (preferably a specialist) is required.

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a combination of expertise in patent law and litigation, and may also include scientists and/or engineers who can provide expert testimony. Given the time and expense, it is not surprising that most infringement cases are settled before trial.

... And Our Example

Now back to our example, using the Podiator. Suppose we suddenly discover that a competitor, Bokshed Inc., is making and selling a knockoff of the Podiator, which has every one of the elements a. – h. of our above claim. We have a solid case that Bokshed is infringing our patent, and strong action is warranted.

Suppose instead, however, that Bokshed is making a simplified version of the Podiator that includes only the podium, and not the "audio-video recording device" or the "wireless transmission antenna." In other words, their machine only includes elements a. – f. of our claim. In that case, Bokshed is not infringing our patent, which is for the *invention as claimed*, i.e. a portable communication station including all of the elements a. – h. of our