9. BECOMING CONVERSANT WITH PATENT AND TRADEMARK ISSUES
What is a Trademark/Service Mark?

- **Trademark:** Any word, name, symbol, device, or any combination thereof that permits consumers to identify and distinguish the goods/services of one manufacturer/retailer from those of another.

- **Service mark:** Any word, phrase, symbol or design, or a combination thereof, that identifies and distinguishes the source of a service.
What is a Trademark?

- **Less Traditional Examples:**
  - Single colors: “Tiffany blue”
  - Sounds: NBC chimes
  - Smells: tennis balls that smell like cut grass
  - Trade dress: The elements regarding the packaging or display of an item that conveys a “source” related impression
    - Coca-cola bottle

Trademark Law: Purposes

- **Benefit Consumers:**
  - Consumers use TMs to identify goods/services that represent a certain quality or value
  - Permits educated purchasing

- **Benefit Merchants:**
  - Goodwill of consumers
  - Repeat sales
  - Advertising tool
  - Helps with Marketing of new products
Selecting New Trademarks: Brainstorming New Names

- **Two Legal Issues When Selecting a Mark:**
  1. Will use of the mark subject you to an infringement suit by another (or will another be able to stop you from using a particular mark)?
  2. How much protection will the mark provide against future uses by others of similar marks?

Selecting a Mark

- **Brainstorm new names:**
  - Avoid descriptive and generic names;
    - Descriptive = describes a quality, characteristic or nature of the good/service
    - Generic = the common name for the good/service
  - Preferably choose arbitrary (real word, no connection to the good/service), fanciful (made up), or suggestive names (suggests something about but does not specifically describe the good/service);
  - ALWAYS have proposed marks searched before using (and before spending money on printing)
Selecting a Trademark

The Distinctiveness Continuum

Least Distinctive

Most Distinctive

Generic
Descriptive
Suggestive
Arbitrary
Fanciful

Computer Repair
Shaken Bake
Chicken of the Sea
Apple
Clorox

Genericide: Dangers of Improper Use of a Trademark

Cellophane
Thermos
Aspirin
Clearing Rights

• **Knock-Out Search – very quick**
  - USPTO Database
  - Google search or other search engine
    - Doesn’t indicate if mark IS available, but may indicate mark is NOT available

• **Full Search – standard about 1 week**
  - Trademark search agency
  - Includes phonetics, synonyms
  - Large common law database
  - Websites/Domain names

What to Consider When Reviewing Search Results

• If conflicting mark is found in the search report, consider the following:
  - Are the goods similar?
  - Are they in the same trade channels?
  - Do the marks have similar looks, sounds, and meanings?
  - Is the mark famous?
  - Is the mark descriptive?
  - Is the mark strong or weak?
  - Is the conflicting mark still in use?
Selecting a Mark: The Process

Brainstorming – work with marketing and legal to create a list of potential marks

Registrability/Protectability – determine whether the marks are registrable (strong, non-descriptive, etc), and determine the appropriate classification

Availability/Search – determine whether someone else is using the mark

Registration – file for federal/state registration

Federal Registration of Trademarks

• Benefits – Why Register?
  ▪ Nationwide Exclusivity
  ▪ Federal Court Jurisdiction
  ▪ Prima Facie: Ownership, Validity, Exclusive Rights, Continuous Use
  ▪ Constructive Notice
  ▪ Statutory Remedies (Treble Damages)
  ▪ Bar Infringing Importations
  ▪ Incontestable after 5 Years
Should You Register?

• **Registration Rules of Thumb:**
  - If using mark for only a short period of time (e.g., < 2 years), probably not worth registering mark
  - If trying to develop brand name recognition in mark and plan on using mark for a long period of time, register the mark
  - If planning on expanding geographic coverage, then worth registering

Factors for Federal Registration

• **Likelihood of Confusion Factors:**
  1. Strength Of Mark
  2. Similarity of Marks
  3. Proximity of Goods/Services
  4. Bridging The Gap
  5. Actual Confusion
  6. Sophistication of Buyers
  7. Channels of Trade
Use of Trademarks

- **Avoid Improper Use:**
  - Never as a noun, always as an adjective
  - Use proper symbol designating status
  - Company-wide education (seminars, guidebooks)
  - Police marks in trade publications, magazines, general press
  - Send cease and desist letters to those misusing mark and follow up to ensure compliance

Proper Marking: TM, SM, & ®

- **TM/SM:**
  - Anyone who claims rights in a mark may use the TM (trademark) or SM (service mark) designation with the mark to alert the public to the claim.
  - Not necessary to have a registration, or even a pending application, to use these designations.

- **®:**
  - May only be used when the mark is registered in the PTO.
  - Improper to use this symbol at any point before the registration is issued.
Trademark Summary

- Use Properly!
  - Mark appropriately with notice symbol
  - Always as adjective, never as a noun
  - Choose arbitrary, fanciful or suggestive marks, never descriptive or generic marks
  - Police use of the mark

- Register marks worth registering

- ALWAYS clear the rights to use a mark
Patent Quotes

I knew that a country without a patent office and good patent laws was just a crab, and couldn't travel any way but sideways or backways.

Mark Twain
"A Connecticut Yankee in King Arthur's Court"

An inventor is a man who looks around upon the world, and is not content with things as they are; he wants to improve whatever he sees; he wants to benefit the world; he is haunted by an idea; the spirit of invention possesses him, seeing materialization.

Alexander Graham Bell

Patent

• What is it?
  • Grant from government
  • Right to exclude others from practicing the claimed invention

• How do you get one?
  • File with the U.S. Patent Office (or foreign office)
  • Disclose everything about the invention
    – Including “best mode” known for practicing

• How long does it last?
  • Constitution: “for limited times”
  • 20 years from filing date for utility patents
  • 14 years for design patents
Parts of a Patent

- Drawings – illustrate the invention
- Specification – describe the invention
- Claims – define the scope of the patent ranging from very short…:

What is claimed is:

1. Element 95.

U.S. Patent No. 3,156,523 (Nov. 10, 1964):
Synthetic element “Americium” (atomic number 95)

Parts of a Patent

…to very long:

U.S. Patent No. 6,953,802
– Claim 1:
  • 22 pages
  • >17,000 words
Patents: Subject Matter (35 U.S.C. 101)

• **Utility**
  - "anything under the sun made by man"
  - any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.

• **Design**
  - Ornamental design of an article of manufacture

• **Plant**
  - Granted to an inventor who has invented or discovered and asexually reproduced a distinct and new variety of plant, other than a tuber propagated plant or a plant found in an uncultivated state

• **Excluded**
  - Abstract ideas, laws of nature, naturally-occurring phenomena
  - Need to provide useful, concrete, and tangible result

Patents: Subject Matter (35 U.S.C. 102)

• **Statutory Bars**
  - **U.S. (new AIA rules):** 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
  - **Foreign countries:** mostly “absolute” novelty or 6-month statutory bar period

• **Not anticipated by prior art**
  - Each and every element of the claimed invention not taught in a single piece of prior art
Patents: Subject Matter (35 U.S.C. 103)

- Differences between claimed invention and the prior art cannot be obvious to one of ordinary skill in the art
  - Secondary Factors:
    - Education level of inventor/others in field
    - Type of problems encountered in field
      - Rapidity of problems being solved
    - Sophistication of the technology
    - Skepticism of experts
    - Commercial success

Patents: Enablement/Best Mode (35 U.S.C. 112)

- Written description: full description of the invention concluding with at least one claim
- Enablement: Must enable others of ordinary skill in the art to practice the invention without undue experimentation
- Best Mode: Cannot conceal the best mode (best way) of practicing the invention
Patents: Utility Applications

• Provisional Application
  – Valid for 12 months
  – Establishes priority date
  – Will not be reviewed or issue as a patent

• Non-Provisional Application
  – Reviewed by the patent office
  – May issue as a patent

Foreign Protection

• If Filed In U.S.:
  – Paris Convention Priority
    • 1 Year From Filing Date (provisionals count)
  – Wait for Foreign Filing License
    • Certified copy of U.S. Application

  ▪ National Filings Without Priority
    – Need Local Counsel (except PCT Stage 1)

  ▪ Conventions
    – PCT
    – EPO
    – National Filing
Questions
Trademarks

I. TRADEMARK LAW REVIEW

A. What is a Trademark/Service Mark?

- Any word, name, symbol, device, or any combination thereof that permits consumers to identify and distinguish the goods/services of one mfg./retailer from those of another

B. What is Trade Dress?

- The elements regarding the packaging or display of an item that conveys a “source” related impression

- Protection of Trade Dress Without Federal Registration:
  - Section 43(a) of the Lanham Act protects a product’s trade dress:
    - “Any person who, on or in connection with any goods or services [...] uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which (A) is likely to cause confusion, or to cause mistake, or to deceive [...] as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

    (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities,

    shall be liable in a civil action by any person who believes that he or she is likely to be damaged by such an act.”

- Federal Registration of Trade Dress:
  - “When an applicant applies to register a product's design, product packaging, color, or other trade dress for goods or services, the examining attorney must consider two issues: (1) functionality; and (2) distinctiveness. See TrafFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23, 58 USPQ2d 1001, 1004-1005 (2001); Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 775, 23 USPQ2d 1081, 1086 (1992)

II. **Use in Commerce**

- **What is “Use in Commerce”**
  
  o It is axiomatic in trademark law that the standard test of ownership is priority of use. To acquire ownership of a trademark, it is not enough to have invented the mark first or even to have registered it first; the party claiming ownership must have been the first to actually use the mark in the sale of goods or services.

  o “The Lanham Act authorizes trademark registration only for marks that are ‘used in commerce.’ 15 U.S.C. § 1051. In the context of the restaurant ‘services’ at issue in this case, ‘use in commerce’ is defined by Section 45 of the Lanham Act as:

    ‘bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark....

    [A] mark shall be deemed to be in use in commerce ... on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.’ 15 U.S.C. § 1127 (emphasis added).”

- **What Constitutes Use?**
  
  o Must be more than “casual and transitory”

    ▪ “Under familiar trademark principles, the right to exclusive use of a trademark derives from its appropriation and subsequent use in the marketplace. The user who first appropriates the mark obtains an enforceable right to exclude others from using it, as long as the initial appropriation and use are accompanied by an intention to continue exploiting the mark commercially.” *LaSociete Anonyme des Parfums Le Galion v. Jean Patou, Inc.*, 495 F.2d 1265, 1271 (2d Cir. 1974).

    ▪ Furthermore, because “the right to a particular mark grows out of its use,...[t]o prove bona fide usage, the proponent of the

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2 Trademark Manual of Examination Procedures, § 1202.02 – Registration of Trade Dress.
3 Buti v. Impressa Perosa S.R.L., 139 F.3d 98, 102 (2d Cir. 1998)
A trademark must demonstrate that his use of the mark has been deliberate and continuous, not sporadic, casual or transitory.” *Id.* at 1271-72.

- Distribution of T-shirts, cards, and key chains during a trademark owner’s business trips to the U.S. did not constitute sufficient “use in commerce” for a café in Italy. *Buti v. Impressa Perosa S.R.L.*, 139 F.3d 98 (2d Cir. 1998).

- Advertising and Promotion?
  
  o Advertising and promotion are generally insufficient to qualify as use of a trademark for registration purposes, but may assist in establishing common law rights

  o Few thousand sample cameras with mark shipped out with thousands of letters prompting order information, as well as trade show usage sufficient to support jury finding of priority of use. *Watec Co., Ltd. V. Liu*, 403 F.3d 645 (9th Cir. 2005).

- Lessons Learned:
  
  o If not regularly using the mark on goods shipped in interstate commerce in order to establish priority of use through traditional means, and doing pre-market advertising and promotion:
    
    ▪ Keep records of extent of advertising and promotion
    ▪ Use the mark prominently in the ads/promotions
    ▪ Ensure that the ads/promotions reach the target consumers
    ▪ Track any customer inquiries garnered through the campaign

**III. LICENSEE USE**

**A. What is Licensee Use?**

- “Section 5 of the Trademark Act, 15 U.S.C. 1055, states, in part, as follows:
  
  o Where a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant for registration, and such use shall not affect the validity of such mark or of its registration, provided such mark is not used in such manner as to deceive the public.”

*Trademark Manual of Examination Procedures, § 1201.03 – Registration of Trade Dress."

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“Section 45 of the Act, 15 U.S.C. 1127, defines ‘related company’ as follows:

The term "related company" means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.”

Thus, §5 of the Act permits applicants for registration to rely on use of the mark by related companies. Either a natural person or a juristic person may be a related company.”

B. Issues Related to Licensee Use

Does the design of the goods on which the mark is used also inure to benefit of Licensor?

Perhaps not. MAGNA DOODLE licensee continued making identical product after expiration of license but with different mark. The court held that no trade dress protection inured to Licensor as license did not expressly provide for this, there was no consistent “trade dress” usage over the years, the “trademark” definition does not encompass “trade dress”, and that it would be contrary to industry practice. See Pilot Corporation of America v. Fisher-Price, Inc., 344 F. Supp. 2d 349 (D. Conn. 2004).

Lessons Learned:

- If establishing use through license, and if product configuration is a potential additional source (in addition to word mark/logo), make sure it is expressly recited in License Agreement

- Example, Professional Sports Team has licensee (Vendor A) to produce unique Mascot branded seat backs. Few years later (after license terminates), Team goes to vendor B to have same seat back produced, and is sued by Vendor A (who didn’t get the renewal) over the design of the seat back (could involve copyright, design patent, trade dress, etc,…)

IV. TRADEMARK INFRINGEMENT V. FREE SPEECH

Univ. of Alabama Brd. Of Trustees v. New Life Art, Inc. (Daniel Moore):

Sports artist Daniel Moore painted and sold pictures of Crimson Tide (Univ. of Alabama) football games without permission (also sold much smaller paintings on mugs, cups, calendars, and other items). Univ. of Alabama argued that the colors of the uniforms in the paintings were trade

5 Trademark Manual of Examination Procedures, § 1201.03 – Registration of Trade Dress.
6 Id.
dress marks, and sued for trademark infringement. Moore claimed the paintings were protected speech.

- U.S.D.C. Northern District of Alabama held that while the colors of the uniforms “may be a weak trade dress mark,” and the paintings may cause a likelihood of confusion, the defendant does not infringe the University’s trade dress mark. The court concluded:

  “(2) That the defendants have not and will not infringe on any trademark or trade dress mark of the plaintiff by creating, manufacturing, producing, selling, distributing or otherwise dealing in paintings and/or prints which are of the same or larger size and equal or greater quality than the limited edition paintings and prints that the defendants have heretofore created and produced.” Univ. of Alabama Brd. Of Trustees v. New Life Art, Inc.. 05-CV-00585 at 28-29 (N.D.Al. Nov. 2, 2009).

- Case is currently on appeal.

V. FAN SITES & PUBLICATIONS

- The Ohio State Univ. v. Thomas et al.:

  - Commercial publisher in Ohio created website called “Buckeye Illustrated” and announced plans to distribute a “Buckeye Gameday” magazine with coverage of Ohio State’s sports teams. Ohio State sued for trademark infringement, unfair competition, and cyberpiracy, sought TRO and preliminary injunction.

  - The court conducted a “likelihood of confusion” analysis and dismissed the defendant’s fair use arguments. Granted TRO, and granted preliminary injunction forbidding defendants from using domain names or publications with Ohio State trademarks.

  - Fair Use Defense:

    - “Defendants argue that the intent behind the choice of domain name of the allegedly infringing website and the names of the allegedly infringing publications “stem[] not from a desire to mislead or steal customers or even advertisers away from the Ohio State University’s athletic web site,” but instead stem “from a desire to simply identify what the website or magazine focuses on: news about Ohio State athletics.” (Doc. # 5 at 5.) Defendants

8 The Ohio State Univ. v. Thomas, 10-CV-753 (S.D.Oh. Aug. 2010).
conclude that because of this, their use is a “fair use.” This Court disagrees.”

- “The problem for Defendants, and the reason why this defense is unavailable to them, is that the terms and logos they have chosen to use are not being used “otherwise than as a mark.” The fair use affirmative defense only permits others to use a protected mark to describe aspects of their own goods, provided the use is in good faith and not as a mark. For example, in *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 920-21 (6th Cir. 2003), the court held that an artist’s use of Tiger Woods’s name on the back of the envelope containing the artist’s print and in the narrative description of the print was “purely descriptive,” and that there was “nothing to indicate that [it was] used other than in good faith.” Woods’s name, the court noted, was used only to describe the content of the print, and all of the materials accompanying the print clearly identified the artist himself as the source of the print. *Id.* In the instant action, however, the marks at issue are not used in the descriptive sense, but instead are used as marks.”

o Bad Publicity:

  - “Ohio State Abuses Trademark Law to Suppress a Fan Magazine and Website”

o Lessons Learned:

  - Monitor use of your trademarks
  - Balance protection of trademarks with opportunities and bad publicity

VI. TRADEMARKS AND SOCIAL MEDIA

A. User Names

- Most social media sites are aware of the need to protect trademark holders from infringement of the mark by third parties. Below are provided excerpts from

9 *Id.* at 17.
10 *Id.* at 18.
Twitter and Facebook’s terms of service as examples that are intended to protect the trademark holder’s rights.

- From the Twitter Terms of Service:
  - “We reserve the right at all times (but will not have an obligation) to remove or refuse to distribute any Content on the Services and to terminate users or reclaim usernames. Please review the Twitter Rules (which are part of these Terms) to better understand what is prohibited on the Service.”
  - From the Twitter Rules: “Trademark: We reserve the right to reclaim user names on behalf of businesses or individuals that hold legal claim or trademark on those user names. Accounts using business names and/or logos to mislead others will be permanently suspended.”
  - Indeed, Twitter provides an entire website devoted to its Trademark Policy: “Using a company or business name, logo, or other trademark-protected materials in a manner that may mislead or confuse others or be used for financial gain may be considered a trademark policy violation. Accounts with clear intent to mislead others will be suspended; even if there is not an explicit trademark policy violation, attempts to mislead others may result in suspension.”

- From the Facebook Terms of Service:
  - “If you select a username for your account we reserve the right to remove or reclaim it if we believe appropriate (such as when a trademark owner complains about a username that does not closely relate to a user's actual name).”

1. **Example #1 – Tony LaRussa:**
   - In May 2009, Tony La Russa – manager of the St. Louis Cardinals – sued twitter for trademark infringement and other claims over the user account “TonyLaRussa,” which included La Russa’s photo. From the CMLP: “Anthony La Russa, manager of the St. Louis Cardinals, sued Twitter after an unknown Twitter user created an account at twitter.com/TonyLaRussa and pretended to post updates as La Russa. The fake Twitter page included La Russa’s photo and a handful of vulgar and apparently Cardinals-related

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13 *Twitter Terms of Service*, Twitter (May 20, 2010), http://twitter.com/tos.
updates. One line of the ‘profile’ suggested it was all a fake: ‘Bio Parodies are fun for everyone.’”

According to La Russa’s attorney, they tried to contact Twitter “for a week,” but there was no response. The account was removed the same day the complaint was filed, and the case quickly settled.

At least one commentator, however, has suggested that the La Russa account was a parody impersonation account, which is expressly permitted by Twitter:

- “Twitter users are allowed to create parody, commentary, or fan accounts. Twitter provides a platform for its users to share and receive a wide range of ideas and content, and we greatly value and respect our users' expression. Because of these principles, we do not actively monitor users' content and will not edit or remove user content, except in cases of violations of our Terms of Service.”

- “Each user is responsible for the content that they provide. Accounts with clear intent to deceive or confuse are prohibited as impersonation accounts and subject to suspension.”

However see the following:

- “Username: The username should not be the exact name of the subject of the parody, commentary, or fandom; to make it clearer, you should distinguish the account with a qualifier such as ‘not,’ ‘fake,’ or ‘fan.’”

- “Name: The profile name should not list the exact name of the subject without some other distinguishing word, such as ‘not,’ ‘fake,’ or ‘fan.’”

- Example of a Parody Impersonation Account:

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22 Id.
23 Id.
24 Id.

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• In April 2009, Danyelle Freeman, a food critic and former restaurant critic for New York Daily News, sent a cease and desist letter to Adam Rucinsky, the owner of a Twitter account (“restaurantgirl”) that parodies Freeman.25

• According to the CMLP: “In the cease-and-desist letter, Freeman’s counsel asserted that Rucinsky’s publishing activities infringe her trademark in “Restaurant Girl” and violate her right of publicity. It also suggested that using Freedman’s name and likeness in connection with false statements ‘may constitute defamation.’”26

2. Example #2 – Oneok, Inc:

  o In September 2009, the natural gas distributory Oneok, Inc. sued Twitter for trademark infringement, alleging that Twitter allowed someone to use the user name ONEOK, which is a trademark belonging to the company.27 The account also included Oneok’s diamond logo.
  o The suit was dropped the next day after Twitter suspended the account.28

26 Id.
I knew that a country without a patent office and good patent laws was just a crab, and couldn't travel any way but sideways or backways.

Mark Twain
"A Connecticut Yankee in King Arthur's Court"

An inventor is a man who looks around upon the world, and is not content with things as they are; he wants to improve whatever he sees; he wants to benefit the world; he is haunted by an idea; the spirit of invention possesses him, seeing materialization.

Alexander Graham Bell

Patent

- What is it?
  - A patent is not a right to practice or use the invention. Rather, a patent provides the right to exclude others from making, using, selling, offering for sale, or importing the patented invention for the term of the patent, which is usually 20 years from the filing date subject to the payment of maintenance fees. A patent is, in effect, a limited property right that the government offers to inventors in exchange for their agreement to share the details of their inventions with the public. Like any other property right, it may be sold, licensed, mortgaged, assigned or transferred, given away, or simply abandoned.

  - A patent being an exclusionary right does not, however, necessarily give the owner of the patent the right to exploit the patent. For example, many inventions are improvements of prior inventions that may still be covered by someone else's patent.

- How do you get one?
  - A patent is requested by filing a written application at the relevant patent office (e.g., the United States Patent and Trademark Office). The person or company filing the application is referred to as "the applicant". The applicant may be the inventor or its assignee. The application contains a description of how to make and use the invention that must provide sufficient detail for a person skilled in the art (i.e., the relevant area of technology) to make and use the invention. Drawings illustrating the invention may also be provided.

  - The application also includes one or more claims. The claims set out what the applicant is seeking to protect in that they define what the patent owner has a right
to exclude others from making, using, or selling, as the case may be. In other words, the claims define what a patent covers or the "scope of protection".

- After filing, an application is often referred to as "patent pending" and those words may be used on marketing material or on the actual device that is the subject of the application. While this term does not confer legal protection, and a patent cannot be enforced until granted, it serves to provide warning to potential infringers that if the patent is issued, they may be liable for damages.

- For a patent to be granted, the patent application must meet the patentability requirements of that country. Most patent offices examine the application for compliance with these requirements. If the application does not comply, objections/rejections are communicated to the applicant or their patent agent or attorney and one or more opportunities to respond to the objections/rejections to bring the application into compliance are usually provided.

- Once granted the patent is subject in most countries to renewal fees to keep the patent in force. These fees are generally payable on a yearly basis, although the US is a notable exception. Some countries or regional patent offices (e.g. the European Patent Office) also require annual renewal fees to be paid for a patent application before it is granted.

- How long does it last?
  - 20 years from filing date for utility patents: 35 USC 154
  - 14 years from issue date for design patents 35 USC 173
35 U.S.C. 101 Inventions patentable

*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.*

- Excluded
  - Abstract Ideas
- Need to provide useful, concrete and tangible result
  - Laws of Nature
- Naturally occurring phenomena
- Design Patents
  - Ornamental design of an article of manufacture
- Plant Patents
  - granted to an inventor who has invented or discovered and asexually reproduced a distinct and new variety of plant, other than a tuber propagated plant or a plant found in an uncultivated state
35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent

(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.

(b) Exceptions.—

(1) Disclosures made 1 year or less before the effective filing date of the claimed invention.—A disclosure made 1 year or less before the effective filing date of a claimed invention shall not be prior art to the claimed invention under subsection (a)(1) if—

(A) the disclosure was made by the inventor or joint inventor or by another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(B) the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(2) Disclosures appearing in applications and patents.—A disclosure shall not be prior art to a claimed invention under subsection (a)(2) if—

(A) the subject matter disclosed was obtained directly or indirectly from the inventor or a joint inventor;

(B) the subject matter disclosed had, before such subject matter was effectively filed under subsection (a)(2), been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor; or

(C) the subject matter disclosed and the claimed invention, not later than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

(c) Common Ownership Under Joint Research Agreements.—Subject matter disclosed and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person in applying the provisions of subsection (b)(2)(C) if—

(1) the subject matter disclosed was developed and the claimed invention was made by, or on behalf of, 1 or more parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;
(2) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(3) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(d) Patents and Published Applications Effective as Prior Art.— For purposes of determining whether a patent or application for patent is prior art to a claimed invention under subsection (a)(2), such patent or application shall be considered to have been effectively filed, with respect to any subject matter described in the patent or application—

(1) if paragraph (2) does not apply, as of the actual filing date of the patent or the application for patent; or

(2) if the patent or application for patent is entitled to claim a right of priority under section 119, 365(a), or 365(b), or to claim the benefit of an earlier filing date under section 120, 121, or 365(c), based upon 1 or more prior filed applications for patent, as of the filing date of the earliest such application that describes the subject matter.

In the United States, an inventor will be barred under Section 102(a)(1) if prior to the effective filing date of the claimed invention, the claimed invention was:

1. patented; or
2. described in a printed publication; or
3. in public use, or
4. on sale; or
5. otherwise available to the public [catch-all provision].

There are certain exceptions to the bar to patentability described above, which are set forth in Section 102(b)(1). These exceptions apply where a disclosure is made one year or less before the effective filing date of the claimed invention by:

1. inventor(s) or someone who obtained subject matter from the inventor(s); or
2. by another after the invention had been publicly disclosed by the inventor(s) or someone who obtained the subject matter from the inventor(s)

Note: such disclosure will destroy international patent rights

In the United States, an inventor will be barred under Section 102(a)(2) if the claimed invention was described in a patent or published application by another inventor before the effective filing date of the claimed invention.

There are certain exceptions to the bar to patentability described above, which are set forth in Section 102(b)(2). These exceptions apply where:

1. the subject matter was obtained from the inventor(s); or
2. the subject matter was described after public disclosure by the inventor(s) or someone who derived from the inventor(s).
In U.S. patent law, anticipation occurs when one prior art reference or event discloses all the features of a claim and enables one of ordinary skill in the art to make and use the claimed invention; the claim is then said to lack novelty. The term "features" in this context refers to the elements of the claim or its limitations.

A prior art reference must not only disclose every feature of a claim, but must also disclose the features arranged or combined in the same way as the claim.
35 U.S.C. 103 Conditions for patentability; non-obvious subject matter

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, 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. Patentability shall not be negated by the manner in which the invention was made.

"Non-obviousness" is the term used in US patent law to describe one of the requirements that an invention must meet to qualify for patentability, codified in 35 U.S.C. §103. One of the main requirements of patentability is that the invention being patented is not obvious, meaning that a "person having ordinary skill in the art" would not know how to solve the problem at which the invention is directed by using exactly the same mechanism. The Graham Factors, shown below, are used by courts to determine if the claimed invention is nonobvious.

Teaching-suggestion-motivation (TSM) test
Further, the combination of previously known elements can be considered obvious. As stated by Winner Int'l Royalty Corp. v. Wang, 202 F.3d. 1340, 1348 (Fed. Cir., 2000), there must be a suggestion or teaching in the prior art to combine elements shown in the prior art in order to find a patent obvious. Thus, in general the critical inquiry is whether there is something in the prior art to suggest the desirability, and thus the obvious nature, of the combination of previously known elements.

This requirement is generally referred to as the "teaching-suggestion-motivation" (TSM) test and serves to prevent against hindsight bias (In re Kahn, Fed. Cir. 2006). As almost all inventions are some combination of known elements, the TSM test requires a patent examiner (or accused infringer) to show that some suggestion or motivation exists to combine known elements to form a claimed invention. Some critics of the TSM test have claimed that the test requires evidence of an explicit teaching or suggestion to make a particular modification to the prior art, but the Federal circuit has made clear that the motivation may be implicit, and may be provided for example by an advantage resulting from the modification. In other words, an explicit prior art teaching or suggestion to make a particular modification is sufficient, but not required for a finding of obviousness.

The TSM test has been the subject of much criticism. The U.S. Supreme Court addressed the issue in KSR v. Teleflex (2006). The unanimous decision, rendered on April 30, 2007, overturned a decision of the Federal Circuit and held that it "analyzed the issue in a narrow, rigid manner inconsistent with §103 and our precedents," referring to the Federal Circuit's application of the TSM test. The court held that, while the ideas behind the TSM test and the Graham analysis were not necessarily inconsistent, the true test of nonobviousness is the Graham analysis. However, according to Chief Judge Michel, the
TSM test remains a part of the Federal Circuit's analysis, though it is applied mindful of the decision in KSR.

Graham factors

The factors a court will look at when determining obviousness and non-obviousness in the United States were outlined by the Supreme Court in *Graham et al. v. John Deere Co. of Kansas City et al.*, 383 U.S. 1 (1966) and are commonly referred to as the "Graham factors". The court held that obviousness should be determined by looking at:

1. the scope and content of the prior art;
2. the level of ordinary skill in the art;
3. the differences between the claimed invention and the prior art; and
4. objective evidence of nonobviousness.

In addition, the court outlined examples of factors that show "objective evidence of nonobviousness". They are:

1. commercial success;
2. long-felt but unsolved needs; and
3. failure of others.

Other courts have considered additional factors as well. See *Environmental Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 697-98, 218 USPQ 865, 869 (Fed. Cir. 1983) (considering skepticism or disbelief before the invention as an indicator of nonobviousness); *Allen Archery, Inc. v. Browning Mfg. Co.*, 819 F.2d 1087, 1092, 2 USPQ2d 1490, 1493 (Fed. Cir. 1987) (considering copying, praise, unexpected results, and industry acceptance as indicators of nonobviousness); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 679, 7 USPQ2d 1315, 1319 (Fed. Cir. 1988) (considering copying as an indicator of nonobviousness).

(a) In General.— The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

(b) Conclusion.— The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

(c) Form.— A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

(d) Reference in Dependent Forms.— Subject to subsection (e), a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

(e) Reference in Multiple Dependent Form.— A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

(f) Element in Claim for a Combination.— An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Under the patent law in the United States, the patent specification must be complete enough so that a person of "ordinary skill in the art" of the invention can make and use the invention without "undue experimentation". There is no precise definition of "undue experimentation". The standard is determined based on the art of the invention.

In the "predictable arts", such as mechanical inventions and software inventions, very little description is required. A mere flow chart of a piece of software, for example, is
adequate. Source code is not normally required. In the “unpredictable arts”, such as chemistry and pharmaceuticals, a very complete description is required.

In a 2005 U.S. court case, several of Jerome H. Lemelson patents covering bar code readers were held to be invalid because the specification was not complete enough for a person of ordinary skill in the art of electrical engineering to have made and used the claimed invention at the time the patent was filed (1954) without undue experimentation. In this case the court held that a person of ordinary skill in the art was a degreed electrical engineer with two years of experience as of the filing date of the original patent application, 1954. One of the challenges of this court case, which was decided in 2005, was to find experts on the state of the art who were alive in 1954.

Best mode

In the United States, the sufficiency of disclosure requirement is complemented by an additional requirement, generally not found in other national patent jurisdictions: the "best mode requirement". According to the requirement, the disclosure must also contain the inventor's "best mode" of making or practicing the invention. For example, if an inventor knows that a liquid should be heated to 250 degrees for optimal performance, but discloses in the patent that the liquid should be heated to "above 200 degrees", then the inventor has not disclosed his "best mode" for carrying out the invention. The best mode must be disclosed for the entire invention, and not only its innovative aspects.

The "best mode requirement" only applies to what the inventor knows or could have known at the time the application was filed, not as to what was subsequently discovered.

Although the inventor must set forth the best mode under Section 112, best mode is no longer a basis for invalidity or unenforceability during litigation in view of the amendments made to the Patent Act by the AIA.

Enablement

The patent law in the United States further requires, among other things, that the patent specification "contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same." 35 U.S.C. 112(1). The requirement "to enable" a person of ordinary skill in the art to make and use the invention is colloquially referred to as the "enablement" requirement. A patent that does not meet the enablement requirement may be declared invalid by a court.[citation needed] Enablement is determined as of the filing date of the patent, and patent-owners cannot use experiments conducted post-application to establish the validity of their patents.