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INTELLECTUAL PROPERTY LAW

Patents

Patents are used to protect inventions, preventing the unauthorized use by others of an inventor's discoveries. Although "mere ideas" are not patentable, patents come closer than any other form of intellectual property except trade secrecy to protecting ideas, because they can protect the essence of a product or manner of accomplishing a task. This article provides general guidance concerning patents: what they are, how they are protected and commercialized, and how they are enforced. Although this article should not be relied on for specific advice in any situation, since the particular facts of a matter can alter the appropriate advice, we hope you find it useful as an introduction to one of the fields in which we focus our work.

Patents

A. WHAT IS A PATENT?

Patents are the primary source of legal protection for inventions. A patent is a grant from the United States Patent and Trademark Office that prevents the unauthorized production, sale, or use of an invention for a fixed period of time. Although "mere ideas" are not patentable, patents come closer than any other form of intellectual property, aside from trade secrecy, to protecting ideas, because they can protect the essence of a product or manner of accomplishing a task.

B. TYPES OF PATENTS

Patents fall into three general groups:

A. Utility Patents

Utility patents can be granted to the inventors of new and useful machines, compositions of matter, products, and processes, or improvements of any of these. The "machine" and "product" categories of utility patents are generally self-explanatory. However, it is important to note that *kits*, containing a variety of products, may fall within the "products" category. Examples of "compositions of matter" for which patents have been issued include laboratory-created life forms and new drug formulations. "Processes" have included not only methods of making products and machines, but also computer software. In short, utility patents protect the way an invention is used and works. These are what most people mean when they refer to "a patent."

B. Design Patents

Design patents can be granted to the inventors of new, original, and ornamental designs for articles of manufacture. In contrast to utility patents, which protect the functionality of an invention, design patents protect the way an invention looks. Design patents can cover anything from the shape of a dining table, to the appearance of a pair of grass clippers, to the design of a microscope or a computer terminal, or even the icons which appear on the screen as a part of many computer programs. The *ornamental appearance* of all types of products, from socks to lollipops, can be protected by design patents.

Because design patents protect an entirely different aspect of a product than do utility patents, it may be possible to obtain both types of protection for a new device that has a new, ornamental appearance.

C. Plant Patents

Plant patents can be granted to persons who invent or discover and asexually reproduce distinct and new varieties of plants. Plant patents cover new varieties of plants, from ornamental rose bushes and Christmas cactuses to vegetable and other crop plants. This form of patent can be very important to our agricultural and ornamental plant industries and, in some instances, to scientific research.

C. RIGHTS GRANTED BY PATENTS

A. Right to Exclude

A patent grants the owner the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States and the right to prevent others from importing the invention into the United States. Although this often is referred to as a "monopoly," it is more precise to say that a patent grants to the owner a right to exclude.

B. Limitations

Because the patent grants only a right to exclude others from practicing the invention, it does not guarantee to the patent owner any right to actually practice the invention. That is, a patent owner's ability to make the patented product, use the patented process, or sell or offer these for sale is not an absolute right guaranteed by law, nor is it guaranteed within the patent itself. Instead, the owner's right to make, use, or sell the patented invention is dependent upon the rights of others, because someone else could own a prior patent on some essential part or element of the invention. If so, the owner of a patent covering the later invention will not be able to utilize the invention until either the earlier patents have expired, or the owner of the earlier patents grants permission.

For instance, if you were the first inventor of the rocking chair, but someone else already held a valid patent on the basic concept of a chair, your rocking chair could not be produced (unless you obtained permission from the chair patent owner) until the basic chair patent expired. Your patent, however, would prevent the basic patent owner from taking advantage of your improvements; the chair patent owner could not go into the rocking chair business without your permission. If no prior patents covered the invention, then you typically would be able to freely exploit your invention yourself, or license others to use it; and your patent would prevent others from duplicating the invention.

D. REQUIREMENTS FOR PATENTABILITY