

Overview of the US Patent System Basic Requirements for Obtaining a Patent

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By statute, an invention must satisfy three requirements in order to be patentable. The invention must be:

- a. novel;
- b. useful, and
- c. non-obvious in light of the prior art.

Novelty

A patent can only be issued for a novel invention. An invention is not novel if it is described or is inherent in a single prior art reference, such as another patent or publication. A single prior art reference that discloses all elements of a claimed invention is said to "anticipate" the invention. 35 U.S.C. § 102 sets forth criteria that prohibit the granting of a patent. Let's examine those two most important criteria likely to come into play for a typical business.

a. 35 U.S.C. § 102(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. 35 U.S.C. § 102(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.

Usefulness

The requirement of "usefulness" (more often referred to "utility") is an issue that rarely comes in to play under the current patent system. In fact, the issue will likely arise in the case of two situations. One situation is that the assertion of utility in the patent application is not credible. The second situation arises if no assertion of utility is made. Essentially, the utility requirement exists to prevent people from patenting theoretically appealing, but practically impossible things such as anti-gravity devices or perpetual motion machines. Simply put, an invention has well established utility if:

- a. person of ordinary skill in the art would immediately appreciate why the invention is useful based upon the characteristics of the invention; or
- b. the utility claimed in the patent application is specific, substantial and credible.

Non-Obviousness

35 U.S.C. § 103(a) extends the prohibitions against patenting to inventions that, though not disclosed in a single reference, are obvious in view of the prior art. An invention may be obvious in view of a single prior art reference or in view of a combination of those references. In determining whether references make an invention obvious, a court or the PTO must consider the prior art from the standpoint of a person having skill in the relevant art.

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