

What Are They Doing?

What does the USPTO do once they get a patent application?

Patent applications are examined to determine whether the invention meets the legal requirements for granting a patent. While there are a lot of details in the process, in the end the patent application has to demonstrate that the invention meets the following basic requirements:

That the Invention Does Something: The standard the USPTO uses is that the invention is a process, machine, manufacture or composition of matter. Laws of nature, physical phenomenon or abstract ideas are not patentable under this standard. A plant found in the wild or a mineral found in the earth would also not be patentable.

Utility: The USPTO requires an invention to have some type of practical value. As a part of having practical value, the invention has to work – otherwise it would have no utility. This operability standard is the basis used by the USPTO to reject applications for inventions involving perpetual motion and cold fusion. Also, by law, inventions specifically related to atomic weapons are prohibited from receiving a patent grant.

Novelty: This means that the invention was not previously known in publically available information. The USPTO uses the term “prior art” to refer to the publically available information.

Non-Obviousness: The USPTO also requires that if an invention is not in the prior art, the difference between the invention and the prior art cannot be obvious to somebody who has “ordinary skill” in the art. Examples of an obvious innovation would include: combining multiple elements each of which is known in the prior art; a simple substitution for known elements (plastic for wood); or something that was obvious to try.

Unity: A patent application can only be for one distinct invention or, at best, a group of very closely related inventions. Take as an example a novel fabric and a loom that was designed to make the fabric. If the only potential use for the loom was to make the fabric, the USPTO would probably allow the application to proceed. If, however, the loom could be used for other purposes, the application would probably face a “restriction” that would require the application to be split into two separate patent applications. About a quarter of textile related patents face restrictions.

Enablement: A patent application has to publically share the how the invention works. The enablement has to include a written description of the invention, the manner and process of making and using the invention, and the “best mode” the inventor is aware of for making and using the invention. The USPTO standard for enablement is that someone skilled in the prior art would be able to make and use the invention.

Claims: Patent applications must always contain at least one claim. A claim is a specific statement of what somebody has to do to infringe on the patent.

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