

Patent 101: Patent Process FAQs for Inventors

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Patent attorneys and patent agents ('patent practitioners') deal with the best and brightest engineers and scientists on a daily basis.

As inventors, these engineers and scientists understand the technology associated with their inventive concepts and are able to impart that understanding to the practitioner who drafts a patent application. The better the engineers/scientists understand the inventive concept and associated technology, the better the patent application produced by the practitioner.

During the process of drafting, filing, and prosecuting a patent application, inventors that are new to the patent process often have many questions related to the content and process of the patent application. A few of the more common questions and related answers are:

What is Rule 56 and why do I have to provide the Patent Office with publications I am aware of which are related to my inventive concept? Isn't it the Examiner's job to search and find the most relevant references related to my inventive concept?

Yes, the Examiner does perform a search for all relevant references including articles, patent applications, and issued patents. However, each person associated with the filing and prosecution of the patent also has a duty to disclose anything that they are aware of related to the inventive concept.

In particular, Rule 56 refers to Chapter 37 of the Code of Federal Regulations, Section 1.56 (37 CFR 1.56), which essentially states that a patent, by its very nature, is affected with a public interest. Thus, the public interest is best served, and the most effective patent examination occurs, when, at the time an application is being examined, the Patent Office/Examiner is aware of, and evaluates, the teachings of all information "material" to patentability. Rule 56 provides that each person (lawyer, inventor, patent owner, etc.) associated with the preparation, filing, and prosecution of a patent application has a duty to disclose to the Patent Office all "material" information of which the person is aware.

In other words, any one associated with the preparation, filing, and prosecution must disclose the "material" references they are aware of to the Patent Office, but they do not have a duty to search out the relevant references—so, you don't have to, and perhaps should not, go looking for them!

Determining whether a reference is "material" is a difficult task because like minds may differ as to the materiality of any particular reference. Thus, when in doubt, disclose any references you are aware of to your patent practitioner. The practitioner will submit the references to the Patent Office and the Examiner will determine the relevance of the references.

The duty under Rule 56 is ongoing. This means that if more potentially "material" references are discovered by any person associated with the filing and prosecution of the patent application after the patent application has been filed, but before the patent application issues as a patent, these newly discovered references must also be disclosed to the Patent Office.

What is the purpose of a 'Summary' section in a patent application?

A patent application has multiple sections, which may include:

- Claim of Priority;
- Field;
- Background;
- Summary;
- Description of the Figures;
- Detailed Description; and,
- Claims and Abstract.

The Summary is a technical portion of the patent application which many practitioners use to ensure that each recitation of the claims is supported in the patent application. Thus, many times, the Summary is just a recitation of the claims in paragraph form.

Inventors get caught up in the Summary when reviewing the patent application because it appears to be stating elements of the inventive concept without any examples or support. However, this is a result of having a direct correlation to the numbered claims at the back of the application. The Detailed Description contains all the examples and details to enable embodiments of the inventive concept discussed in the patent application.

When reviewing the patent application provided by the practitioner, read the Summary last so all of the substantive comments are made in the Detailed Description.

How do I determine if my inventive concept is patentable over the references cited by the Examiner in an Office Action issued by the Patent Office?

Focus on the claims! Often times an inventor new to the patent process will read the references cited by the Examiner and communicate to the patent practitioner that many of the details of the inventor's inventive concept are not discussed in these references. Most of the time, the inventor is correct. However, at least one of the details of the inventive concept that are not discussed in the references cited by the Examiner has to be in the claims.

In other words, it's not good enough that a patent application, as a whole, discusses novel and inventive ideas not discussed in the cited references. At least one of these novel and inventive ideas has to be in the claims of the patent application before the claims can be deemed patentable over the cited references.

Thus, if these novel and inventive ideas were not included in the claims as filed, the claims must be amended to include at least one of the novel and inventive ideas responsive to the Office Action issued by the Examiner.

Before providing feedback on the Office Action to your patent practitioner, review the claims pending in the patent application. If the differences between your inventive concept and the one discussed in the cited references does not appear to be present in the claims, communicate this to your patent practitioner when providing feedback on the Office Action.

Can I patent software?

The simple answer is yes! However, there is an ongoing debate about where to draw the line with software in view of

eligible subject matter for patents. In other words, the question is: Does the patent application claim a law of nature, natural phenomenon, or an abstract idea? If so, then the claims in the patent application are considered to be ineligible for patenting.

The Patent Office is trying to stop people from getting a patent on things that occur naturally in the world. As those who develop software know, a lot of hard work goes into developing software code and, therefore, by definition, software code does not occur naturally in the world. However, because software code is not "tangible," meaning it exists in a black box, there has been a tendency to classify software inventive concepts as abstract ideas, whatever that means.

Since the case law in this area is still developing, patent practitioners are constantly changing their approach to drafting applications with respect to software. Some practitioners focus on the inventive aspects of the software code that are directed to an identifiable improvement in computer functionality. Other practitioners focus on features of the software that amount to "significantly more" than the abstract idea.

For example, portions of the application may focus on features that take the software code beyond the abstract by addressing a solution to a known problem, claiming steps to achieve a desired outcome (instead of the outcome itself), tying the software code to a particular machine (more than a general processor), or specifically calling out the transformation of an article to a different state or thing.

Even given all of these methods of dealing with the evolving law on software patents, the determination of whether software is eligible subject matter is highly subjective.

Conclusion

Engineers and scientists new to the patent world should not hesitate to ask their patent practitioner questions before, during, and after review of the draft patent application. Having a road map and ground rules as to what is expected from all parties involved can make the process more efficient and enjoyable and the end result the best product possible.

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