

UTILITY, DESIGN AND PLANT PATENTS

There are three categories of patents granted by the **U.S. Patent and Trademark Office** (the **USPTO**): **utility** or mechanical patents, **design** patents and **plant** patents. They cover different types of inventions, have somewhat different requirements for issuance, and are valid for different lengths of time. This brochure will explain these three patents and their individual conditions and attributes.

UTILITY PATENTS

Utility patents are by far the most common patents, and are what is usually meant when the simple term patent is mentioned. While they are often called mechanical patents, they can cover **many types of inventions** beside mechanical devices. Products of all types, chemical compositions and processes, manufacturing methods, electronic circuitry, computer software and biotechnology as well as business methods are but a few of the types of inventions which can be protected by utility patents.

The principal attribute of a utility patent is that it describes and claims the structure, composition, or operation of a product or process invention. In other words, it defines **what the invention is** and **how it works**. A utility patent includes a **specification** which provides a detailed description of the invention, including identifying the **best mode** (best version) which is then contemplated by the inventor. It usually includes **drawings** illustrating the various components or steps of the invention. The specification may also include descriptions of different versions, or **embodiments**, of the invention. Chemical and biological inventions often require inclusion of many **examples** to illustrate fully all variations of the invention and its operation. Manufacturing methods and end uses must also be described if those have not been previously known. The specification and drawings remain substantially unchanged as the application moves through the examination process before an Examiner in the USPTO.

At the end of a utility patent are **claims** which define the invention in **legal terms**, much like a property deed uses legal terms to define a piece of real estate. There are normally a number of different claims, each of which defines the invention in a slightly different manner. The **broadest** claims, called **independent** because they do not refer to any other claims, define various embodiments of the invention in the most generic manner. The remaining **dependent** claims further define the invention in more detail. They may specify particular components or steps in more detail, add more components or steps to the inventive combination, or otherwise **narrow** the broad generic definitions in different ways.

There are usually many more dependent than independent claims in a utility patent.

It is the **claims** which define the patent owner's legal rights in the **patented invention**. The law gives the patent owner the right "**to prevent others from making, using, selling, offering for sale or importing**" the patented invention during the life of the patent. Therefore the claims are a critical part of the patent, since the patent cannot be infringed by products or processes which are not within the scope of at least one of the claims of the patent. Commonly claims are often changed and narrowed significantly during the USPTO examination process, usually to differentiate over prior inventions cited by the Patent Examiner or meet objections raised by the Examiner, so that the scope of the **amended claims** which appear in the final issued patent is often significantly more **limited** than what that patent's specification might suggest.

Regular applications for patents may be preceded by a **provisional** patent application which does not contain claims, but is required to meet the enabling disclosure requirement. A provisional patent application lapses after one year, and the related regular application with claims must be filed during that year to secure the benefit of the provisional filing date.

The life or term of a utility patent is **20 years** from the initial filing date of the first patent application from which the patent claims priority.

DESIGN PATENTS

Design patents differ from utility patents in that a design patent covers **only** the **ornamental appearance** of a **useful product**. The design patent, therefore, covers what the product **looks like**, **not** what it is or what it does, and therefore cannot be used for anything which does not have an ornamental appearance. Design patents can, however, be granted on new versions of old classes of products, if they have **unique and innovative appearances** as compared with the prior products in that class. For instance, bottles as a class are old, but a newly designed bottle which has a unique and distinctive shape or decoration may be the subject of a design patent.

The design elements which are claimed to be unique and distinctive must be **ornamental** and not **functional** in the structure of the product. Elements of a product's design which have an appearance dictated by the operation or structure of the product are functional and must be ignored in determining what is a patentable design. For instance, a shoe must have a certain basic shape to fit one's foot, so anything ornamental about a shoe design must be something more than just the basic functional shoe shape.

Design patents, since they are directed to the product's ornamental appearance, are composed almost entirely of **drawings** of the product showing different views of the product's appearance. The minimal text in the specification merely identifies each figure in the drawings, and there is only a single claim which is in wording dictated by the USPTO

rules. Examination of a design patent application involves the Examiner's comparison of the appearance of the claimed design with the appearances of similar designs of previous products. Any prior product which looks similar to the claimed product may affect the patentability of design of the claimed product, even though the old and new products may be intended for different uses.

Design patents have a term of **14 years** from the date of the patent's issuance.

PLANT PATENTS

Plant patents are a small category of patents which protect **certain types of plants**, such as flowers, fruits, shrubs and vines. A plant patent consists of a text describing the **botanical characteristics** of the plant, including size, flower and leaf colors and shapes, growth habit, and growing seasons and locations. It also includes color photographs or paintings of the plant and a single formalized claim. The inventor is the person who has first reproduced and grown the plant.

Plant patents have a term of **20 years** from the initial filing date of the first patent application from which the patent claims priority. About 10,000 plant patents have been issued.

RULES RELATING TO ALL PATENTS

The details of patent application prosecution and enforcement litigation are too lengthy to set out here. Please refer to our firm's brochures on those subjects. However, there are several aspects of patents which are common to all patents and can be briefly described.

During examination, the **Patent Examiner** evaluates an invention to determine whether it meets the law's requirements that to be patentable, it must be **useful, novel and unobvious**. **Useful** means that it must have some actual utility (or, for a design patent, the basic product must have utility). Thus written materials, art works, music and literature cannot be the subject of patents; rather they are protected by copyright laws. **Novel** (or new) means that the invention cannot have been previously known. **Unobvious** means that, even if the invention was not itself known before, it still must be sufficiently **different** from similar inventions which were known that a person familiar with those kinds of inventions would consider the new invention to be more than just an **obvious variation** of the previous inventions. It is the issue of obviousness which arises most frequently during patent examinations at the USPTO.

The law also requires that the patent application describe the invention in sufficiently **clear, detailed and concise terms** that someone familiar with that type of invention could understand how the invention is constructed and operates, what its best version is and would be able to reproduce the invention from the patent's description and drawings.

Patent drawings are **not** mechanical drawings or shop drawings, but rather are usually illustrations or diagrams of the invention and its components, showing what it looks like, how it's assembled and how it works.

Under U.S. law, a patent owner cannot assert rights against a potential infringer until a patent is actually **issued**. The terms patent pending or patent applied for merely indicate that a patent application has been filed at the USPTO and is under examination, but do **not** give the applicant any legal rights against others who may make, use, sell, offer for sale or import the invention while the application is pending in the USPTO.

FOREIGN CONSIDERATIONS

The information above relates **only** to **U.S. patents**. There is **no** single international patent. Foreign patent laws often differ in important respects from U.S. patent laws. Patents issued by one country do **not** usually provide any legal rights in any other country, and the terms, permissible subjects and requirements for patents **vary** from country to country.

While almost every country issues the equivalent of utility patents, many do **not** issue equivalents of design or plant patents. However, in some foreign countries there are other legal protections for inventions, such as inventor's certificates, petty patents, or industrial designs, which do not have any equivalents in the U.S.

Gordon & Rees's brochure entitled Foreign Patent Considerations provides general information about foreign patents. A Gordon & Rees attorney can provide specific information about the procedures and costs involved in seeking patent protection in various countries or regions of the world.

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