Industry & Invention
Patent

Utility Patents
Usefulness (Utility)

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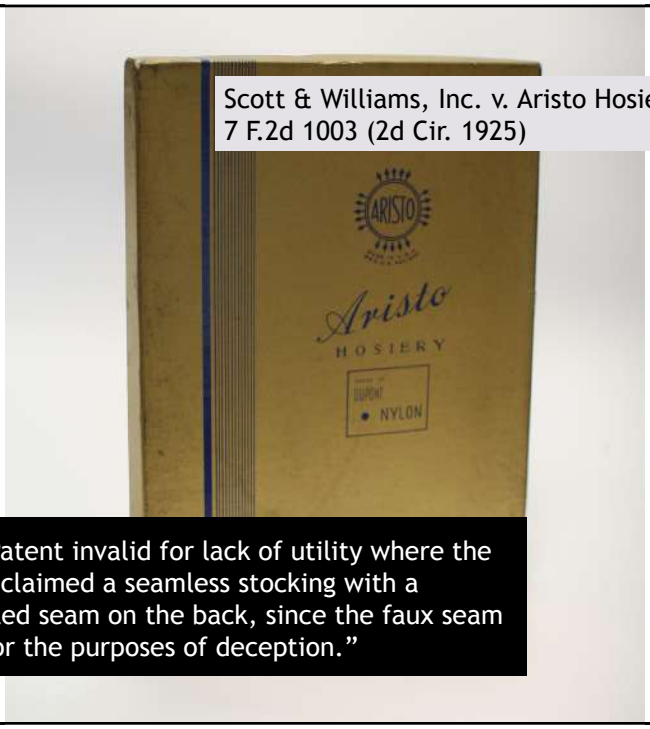
Kinds of Utility

- Beneficial Utility
- Operability (General Utility)
- Specific Utility (Practical Utility)
- Substantial Utility (Practical Utility)

Beneficial Utility

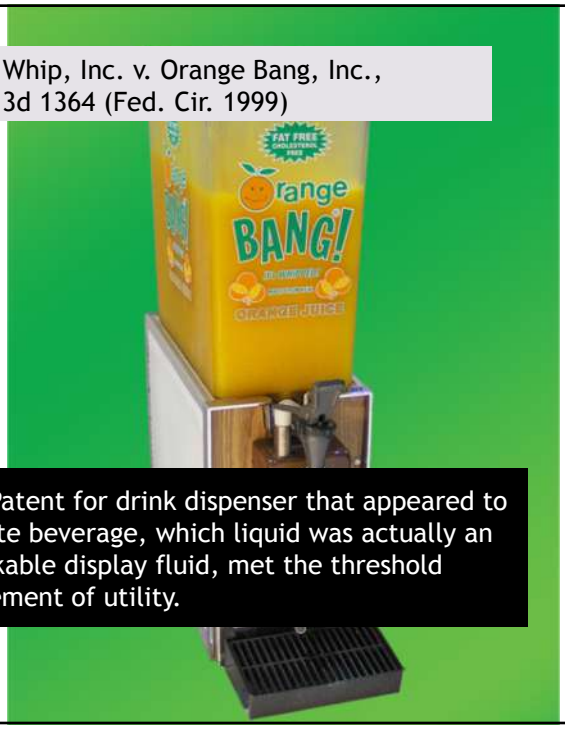
- The invention must "not be frivolous or injurious to the well-being, good policy, or sound morals of society."
- This doctrine appears to be completely dead.



Scott & Williams, Inc. v. Aristo Hosiery Co., 7 F.2d 1003 (2d Cir. 1925)

Held: Patent invalid for lack of utility where the patent claimed a seamless stocking with a simulated seam on the back, since the faux seam was "for the purposes of deception."

Juicy Whip, Inc. v. Orange Bang, Inc., 185 F.3d 1364 (Fed. Cir. 1999)



Held: Patent for drink dispenser that appeared to circulate beverage, which liquid was actually an undrinkable display fluid, met the threshold requirement of utility.

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Operability (a/k/a General Utility)

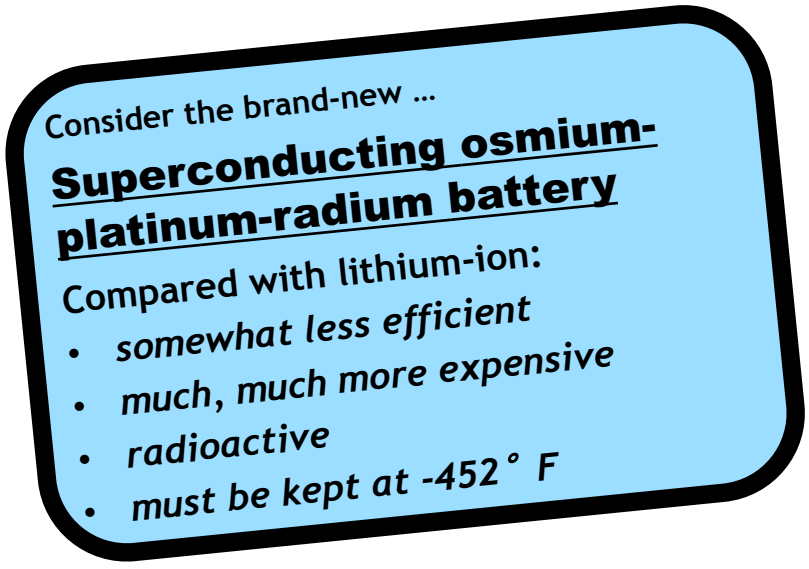
- An invention that is "inoperative" (i.e., it does not operate to produce the results claimed by the patent applicant) is not a "useful" invention in the meaning of the patent law.
- "An inoperative invention, of course, does not satisfy the requirement of 35 U.S.C. 101 that an invention be useful." – In re Harwood, 390 F.2d 985, 989 (CCPA 1968)

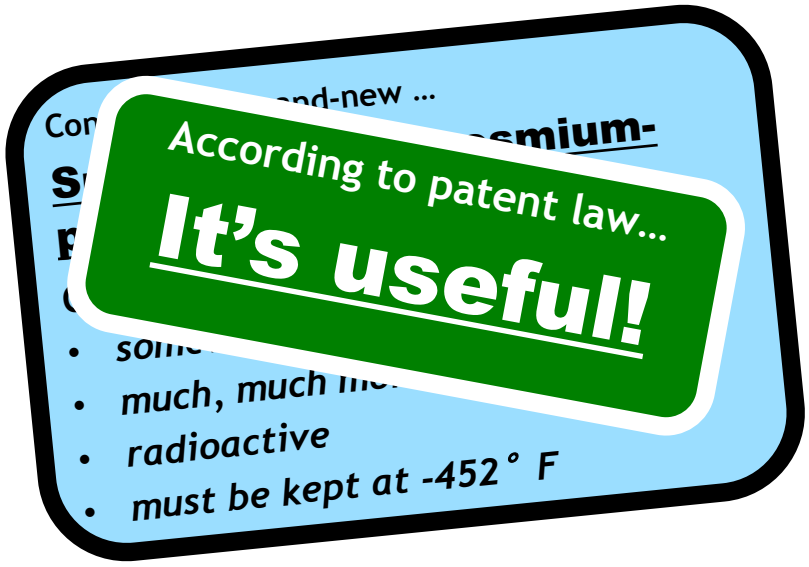
Operability

- Rejections on the basis of inoperability are rare. The threshold is low.
- "To violate § 101 the claimed device must be totally incapable of achieving a useful result." – Brooktree Corp. v. Advanced Micro Devices, Inc., 977 F.2d 1555, 1571 (Fed. Cir. 1992)

Operability

"A small degree of utility is sufficient ... An invention does not lack utility merely because the particular embodiment disclosed in the patent lacks perfection or performs crudely ... A commercially successful product is not required ... Nor is it essential that the invention accomplish all its intended functions ... [P]artial success [is] sufficient to demonstrate patentable utility ..." – E.I. du Pont De Nemours and Co. v. Berkley and Co., 620 F.2d 1247, 1260 n.17, (8th Cir. 1980).





Specific Utility (a/k/a Practical Utility)

It is not enough for the applicant to declare usefulness generally. There must be a specific thing the invention does that is useful – i.e., a showing of specific utility.

Specific utility is rarely an issue with most inventions. However, specific utility is key hurdle to patentability in:

- chemistry
- biotechnology

Specific Utility

A "specific utility" is specific to the subject matter claimed and can "provide a well-defined and particular benefit to the public." In re Fisher, 421 F.3d 1365, 1371, (Fed. Cir. 2005).

This contrasts with a general utility that would be applicable to the broad class of the invention.

Specific Utility

Examples of insufficient statements of specific utility:

- A newly synthesized compound that can be used as a paperweight.
- A newly synthesized compound that may be useful in treating unspecified disorders.
- A newly synthesized compound that has "useful biological" properties.
- A polynucleotide whose use is disclosed simply as a "gene probe" or "chromosome marker," without disclosure of a specific DNA target.

Specific Utility

Examples from diagnostics:

Ex. 1: Applicant makes a general statement of diagnostic utility, such as diagnosing an unspecified disease.

➔ Insufficient.

Ex. 2: Applicant discloses a specific biological activity and reasonably correlates that activity to a disease condition.

➔ Sufficient to identify a specific utility.

Substantial Utility

(can be thought of as a subset of Specific or Practical Utility)

Must be a current, real-world benefit to the invention.

As with specific utility, this is a key hurdle for

- chemistry
- biotechnology

Substantial Utility

The substantial utility requirement blocks patents where someone has created a new compound or found a new gene, but doesn't yet know what it's good for.

"[A]n application must show that an invention is useful to the public as disclosed in its current form, not that it may prove useful at some future date after further research. Simply put, to satisfy the 'substantial' utility requirement, an asserted use must show that the claimed invention has a significant and presently available benefit to the public." – In re Fisher, 421 F.3d 1365, 1371 (Fed. Cir. 2005)

But note that this does not mean current commercial availability is required.

Specific Utility in the Therapeutic or Pharmacological Context

Nelson v. Bowler, 626 F.2d 853 (CCPA 1980):

- Nelson satisfied the practical utility requirement in identifying the synthetic prostaglandins as pharmacologically active compounds.

Specific Utility in the Therapeutic or Pharmacological Context

Nelson v. Bowler, 626 F.2d 853 (CCPA 1980):

"Knowledge of the pharmacological activity of any compound is obviously beneficial to the public. It is inherently faster and easier to combat illnesses and alleviate symptoms when the medical profession is armed with an arsenal of chemicals having known pharmacological activities. Since it is crucial to provide researchers with an incentive to disclose pharmacological activities in as many compounds as possible, we conclude that adequate proof of any such activity constitutes a showing of practical utility."

Specific Utility in the Context of Research Tools

A research tool, such as a gas chromatograph, is useful and meets the utility requirement.

However, where the invention's use in research is to research the invention itself, then the utility requirement is not met.

Methyldiethylbenzoacrinobutadine

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Useful for testing to see if it might have the ability to reduce tumors.

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Useful for testing to see if it might have the ability to reduce tumors.

Not good enough.

Methyldiethylbenzoacrinobutadine

Has been found to shrink tumors in laboratory animals. Not tested on humans at all.

Methyldiethylbenzoacrinobutadine

Has been found to shrink tumors in laboratory animals. Not tested on humans at all. **Good enough.**

Methyldiethylbenzoacrinobutadine

In powder form, can fill up the space in a cylinder-shaped void.

Methyldiethylbenzoacrinobutadine

In powder form, can fill up the space in a cylinder-shaped void.

Not good enough.

Methyldiethylbenzoacrinobutadine

Has been shown to be pharmacologically active in laboratory studies, and is useful for further research in determining whether it might be a useful chemotherapy agent.

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