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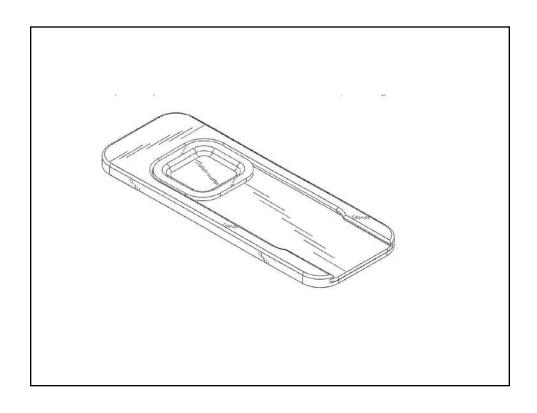


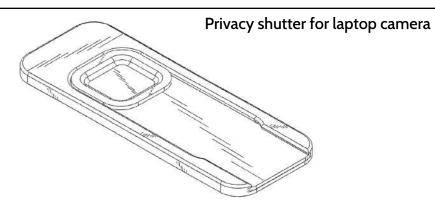
Five requirements for a valid patent:

- Patentable subject matter
- Novelty
- Nonobviousness



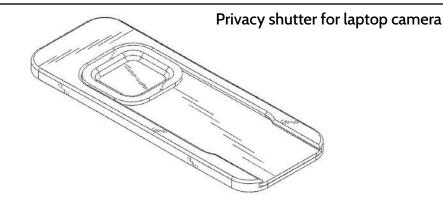
Disclosure





There have been other laptop-camera privacy shutters before, which all function the same way. But this is the first to have this particular shape with rounded corners, beveling, and so forth. The applicant states this makes it more aesthetically appealing, and thus more useful and valuable for consumers.

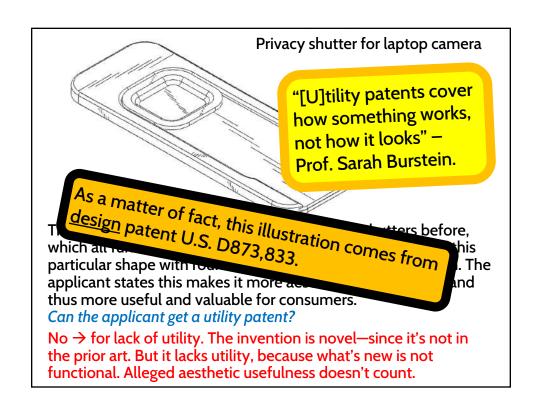
Can the applicant get a utility patent?



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Can the applicant get a utility patent?

No \rightarrow for lack of utility. The invention is novel—since it's not in the prior art. But it lacks utility, because what's new is not functional. Alleged aesthetic usefulness doesn't count.



MPEP on Utility

A rejection on the ground of lack of utility is appropriate when (1) it is not apparent why the invention is "useful" because applicant has failed to identify any specific and substantial utility and there is no well established utility, or (2) an assertion of specific and substantial utility for the invention is not credible. Such a rejection can include the more specific grounds of inoperativeness, such as inventions involving perpetual motion.

MPEP on Utility A rei Hey! What's app inve the "MPEP"? faile منانين Why it's the Manual of Patent Examining Procedure! It's a giant set of instructions for how patent examiners are to do their job in dealing with patent applications that have come into the PTO. It tells examiners when to allow claims, when to reject claims, what basis to use, how to interact with applicants, etc. It is, of course, a publicly available document. And it is super useful for patent attorneys and patent agents trying to help inventors get patents!

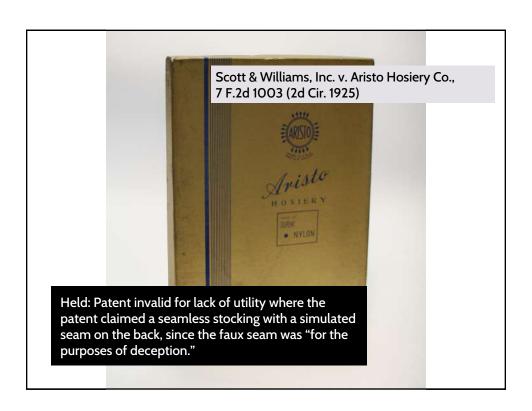
Kinds of Utility

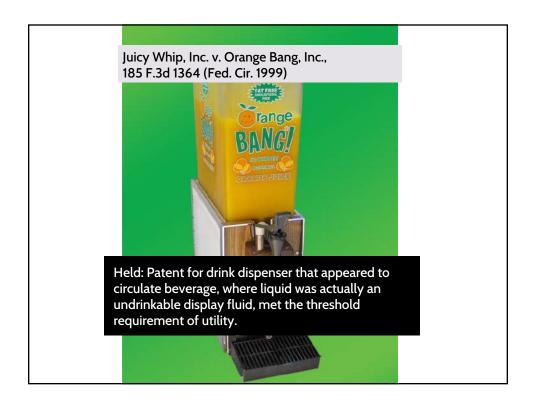
- Moral utility (policy/legality)
- Operability (general utility)
- Specific Utility (practical utility)
- Substantial Utility (practical utility)

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Moral utility

- The invention must "not be frivolous or injurious to the well-being, good policy, or sound morals of society."
- Many argue this doctrine is dead.
- If an invention can be put to at least one lawful use, it will be considered "useful" in this sense.





Juicy Whip v. Orange Bang (Fed. Cir. 1999)

"[Y]ears ago courts invalidated patents on gambling devices on the ground that they were immoral ..., but that is no longer the law ... Congress never intended that the patent laws should displace the police powers of the States, meaning by that term those powers by which the health, good order, peace and general welfare of the community are promoted ... we find no basis in section 101 to hold that inventions can be ruled unpatentable for lack of utility simply because they have the capacity to fool some members of the public."

MPEP on Moral Utility

A rejection under 35 U.S.C. 101 for lack of utility should <u>not</u> be based on grounds that the invention is frivolous, fraudulent or against public policy. *See* Juicy Whip Inc. v. Orange Bang Inc. (Fed. Cir. 1999).

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Operability (a/k/a general utility, a/k/a "credible operability")

- 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).





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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 welldefined and particular benefit to the public." In re Fisher, 421 F.3d 1365, 1371, (Fed. Cir. 2005).

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

Specific Utility

Examples of <u>insufficient</u> 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

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→ Sufficient to identify a specific utility.

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Substantial Utility

(can be thought of as a subset of specific or practical utility)

There 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 <u>satisfied</u> 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.

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



