Patentability of an Invention

and

Infringement of a Patent

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Quick Background :: Jeffrey Schox, Esq.

- Patent Attorney on 200+ patent applications
- Founder of a patent law firm with 50 startup clients
- Engineer with BS•ME and MS•EE degrees
- Lecturer at Stanford Law School
- Inventor on five patent applications
- Angel Investor with Keiretsu Forum
QUESTION

What is the relationship: Patentability and Infringement?
Sections of a Patent

1. Drawings and the Detailed Description
   • form the Technical Section of the patent
   • enable the reader how to make and use the invention

2. Claims
   • form the Legal Section of the patent
   • define the rights of the patent
QUESTION

What are the requirements for a Patent?
Requirements for a Patent

**useful**
the invention, when made, must perform some useful function

**novel**
the invention must not have been “known or used by others in this country, or patented or described in a printed publication in this or a foreign country”

**not obvious**
“the differences between the subject matter sought to be patented and the prior art ... [must not] have been obvious at the time the invention”
GROUP QUESTION

If the prior art includes:

- flashlight with crank and battery
- radio
- radio with crank and a mechanical storage device

is this patentable?
Answer

Claim 11 of U.S. Pat. No. 5,917,310 states:

A portable electric device comprising:
• a generator having a rotatable shaft;
• a gear train ... coupled to said rotatable shaft;
• a mechanical energy storage device....;
• a handle coupled to said source, whereby rotating said handle adds mechanical energy to said source;
• a power control circuit coupled to said generator and configured to prevent an uncontrolled release of said mechanical energy from said source by controlling a voltage output of said generator; and
• a radio coupled to said power control circuit.
QUESTION

If the prior art includes:

satellite radio with crank and a mechanical storage device

is this patentable?
Answer

The difference between a terrestrial and satellite radio wave receiver is probably not a patentable difference.
Abstraction

- Patentable
- Schematics
- Detailed flow charts
- Implementation/Code lines

Valuable
Summary

An invention may be **patentable** if claims can be written that distinguish the invention from previous inventions.
QUESTION

What actions are considered an infringement of a patent?
Infringement of a Patent

“Whoever without authority

- makes, uses, ... or sells any patented invention, within the United States, or imports into the United States any patented invention during the term of the patent ... infringes the patent.”

The term of a patent expires 20 years after the filing date.
Steps of an Infringement Analysis

The determination of whether an accused product or method infringes a claim of patent includes two steps:

1. Interpreting the claim, and
2. Comparing the interpreted claim with the accused product or method.
GROUP QUESTION

Does selling of this radio infringe U.S. Patent No. 5,917,310?

radio with air pump and a mechanical storage device
U.S. Pat. No. 5,917,310 states:

11. A portable electric device comprising:
   • a generator having a rotatable shaft;
   • a gear train ... coupled to said rotatable shaft;
   • a mechanical energy storage device....;
   • a handle coupled to said source, whereby rotating said handle adds mechanical energy to said source;
   • a power control circuit coupled to said generator and configured to prevent an uncontrolled release of said mechanical energy from said source by controlling a voltage output of said generator; and
   • a radio coupled to said power control circuit.
Answer

The radio with the air pump does not include:

A portable electric device comprising:
• a generator having a rotatable shaft;
• a gear train ... coupled to said rotatable shaft;
• a mechanical energy storage device....;
• a handle coupled to said source, whereby rotating said handle adds mechanical energy to said source;
• a power control circuit ... and configured to prevent an uncontrolled release of said mechanical energy from said source ...; and
• a radio coupled to said power control circuit.

Therefore, selling the radio does not literally infringe Claim 1 of U.S. Patent No. 5,917,310.
Summary

A product (or method) may infringe a patent if it contains all of the elements of a single claim of the patent.
GROUP QUESTIONS

1. Is this radio **patentable**?
2. Does selling the radio **infringe** U.S. Patent No. 5,917,310?

radio with a mechanical energy storage device, a crank, and a solar energy collector.
Questions

1. Nothing in the prior art teaches the following element:
   • a control circuit ... for enabling said generator and said panel to charge said capacitor....
   Therefore, the generator device is **patentable**.

2. The radio, however, includes every element of Claim 11 and therefore **infringes** U.S. Patent No. 5,917,310.
QUESTION

What is the relationship: Patentability and Infringement?
### Answer

<table>
<thead>
<tr>
<th>Patentable</th>
<th>Infringement</th>
<th>No Infringement</th>
</tr>
</thead>
<tbody>
<tr>
<td>Satellite Freeplay</td>
<td>Retro radio</td>
<td></td>
</tr>
<tr>
<td>Solar Freeplay</td>
<td>Air pump radio</td>
<td></td>
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</tbody>
</table>

Patentability and Infringement are **unrelated** issues.
Summary

An invention may be **patentable** if claims can be written that distinguish the invention from previous inventions.

A product that incorporates the invention may **infringe** an existing patent if it contains all of the elements of a single claim of the patent.
The End.

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