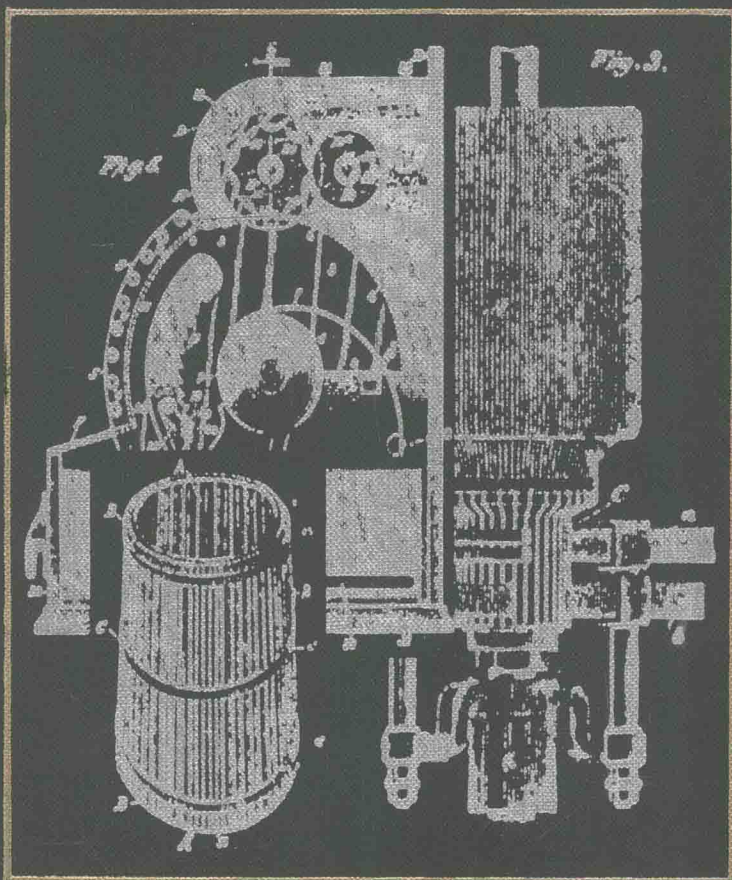


PATENT LAW FUNDAMENTALS

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Second Edition

Patent Law Fundamentals

Second Edition

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PART V

Obtaining Patent Protection

The inventor of a new and useful improvement certainly has no exclusive right to it, until he obtains a patent. This right is created by the patent, and no suit can be maintained by the inventor against any one for using it before the patent is issued. But the discovery of a new and useful improvement is vested by law with an inchoate right to its exclusive use, which he may perfect and make absolute by proceeding in the manner which the law requires.

Taney, Ch. J., *Gayler v. Wilder*, 51 U.S. (10 How.) 477, 493 (1850)

The Constitution empowers the United States to grant patents for inventions. By the wording of the Constitution, this power, however, is not self-executing, but requires Congressional legislation for its implementation. Moreover, the language of the Constitution concerning patents is couched with generality comparable to that of other Constitutional grants of Congressional power, Congress having wide discretion in prescribing the conditions under which patents will be granted.

Consequently, there is a distinction between a bald invention and a patented invention. One who makes an invention, however meritorious, does not, by that act alone, automatically acquire protection. Upon making an invention, the inventor has but an inchoate right to patent protection. Such inchoate right can be perfected by patenting only upon at least apparent compliance with a phethora of elaborate formalities prescribed by Congress and by the Patent & Trademark Office acting on behalf of Congress. Patent protection must be sought or solicited from the government. The process of soliciting patents from the government is often spoken of as "procurement" or as "prosecution."

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The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy, and in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specification and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention.

Brown, J. *Topliff v. Topliff*, 145 U.S. 156, 171 (1892)

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A complete application comprises:¹

- (1) An oath or declaration (see 37 C.F.R. § 1.65).
- (2) Drawings, when necessary (see 37 C.F.R. §§ 1.81 to 1.88).
- (3) A specification, including a claim or claims (see 37 C.F.R. §§ 1.71–1.77).
- (4) The prescribed basic filing fee (see 37 C.F.R. § 1.21).

However, the basic filing fee and the oath (or declaration) may be submitted on a date later than that on which the specification and any required drawings are submitted, provided the required surcharge is paid. Under such circumstances, the filing date of the application is the date on which the specification and any required drawings were received in the Patent & Trademark Office.^{1.1}

The application must be in the English language² except that an application, including a signed oath or declaration, may be filed in a language other than English if it is accompanied by the fee set forth in 37 C.F.R. § 1.17(k). A verified English translation of the non-English language application is required to be filed with the application or within such time as may be set by the Office.^{2.1} The oath or declaration must be in a language understood by the applicant.³ The Patent & Trademark Office will provide, free of charge, the form for the oath or declaration in some fourteen languages. If the oath or declaration is executed on one of these foreign language forms, it need not be accompanied by a verified translation.

All papers which are to become a part of the permanent records of the Patent & Trademark Office must be legibly written or printed in permanent ink.⁴

The specification and claims, and also papers subsequently filed, must be plainly written on but one side of the paper. A wide margin must be reserved on the left-hand side and on the top of

¹ 37 C.F.R. § 1.51.

^{1.1} P.L. 97–247. See § 15.02[2], *infra*, for the dollar amount of the surcharge.

² 37 C.F.R. § 1.52(a).

^{2.1} 37 C.F.R. § 1.52(d).

³ 37 C.F.R. § 1.69.

⁴ 37 C.F.R. § 1.52(b).

each page and the lines must not be crowded too closely together. Legal paper, eight to eight-and-one-half by twelve and one-half to thirteen inches, typewritten and double-spaced with margins of one and one-half inches on the left-hand side and top is deemed preferable. Typewritten or printed papers suitable for use by the Office may be required if the papers originally filed are not correctly, legibly, and clearly written.

Any interlineation, erasure or cancellation, or other alteration, made before the application was signed and sworn to, or declaration made, should be clearly referred to in a marginal note or footnote on the same sheet of paper, and initialed or signed and dated by the applicant to indicate such fact. No such alterations are permissible after execution of the application papers.⁵

§ 13.01. The Oath or Declaration.

As part of his application, each applicant must state:

- (1) that he verily believes himself to be the original and first inventor or discoverer of the process, machine, manufacture, composition of matter, or improvement thereof, for which he solicits a patent; that he does not know and does not believe that the same was ever known or used before his invention or discovery thereof, and of what country he is a citizen and where he resides and whether he is a sole or joint inventor of the invention claimed in his application;
- (2) whether or not any application for patent or inventor's certificate on the same invention has been filed in any foreign country, either by himself, or by his legal representatives or assigns. If any such application has been filed, the country in which the earliest such application was filed must be named, as must the day, month and year of its filing; every such foreign filed application filed more

⁵ 37 C.F.R. § 1.52(c).

than twelve months⁶ before the filing of the application in this country must be identified by country and by day, month, and year of filing.

In every original application, the applicant must further state:

- (3) that to the best of his knowledge and belief the invention has not been in public use or on sale in the United States more than one year prior to his application or patented or made the subject of an inventor's certificate or described in any printed publication in any country before his invention or more than one year prior to his application or patented in any foreign country.

An application for a plant patent must, in addition to the above statements, contain an averment that the applicant has asexually reproduced the plant, and where the plant is a newly found plant, it must also be stated that the plant was found in a cultivated area.⁷

The above statements (1) must be subscribed to by the applicant and (2) must either be sworn to (or affirmed) as provided in 37 C.F.R. § 1.66, or include the personal declaration of the applicant as prescribed in 37 C.F.R. § 1.68.

A declaration made pursuant to 37 C.F.R. § 1.68 must contain *in addition* to the averments made in an oath the following statements:

- (1) that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true;
- (2) a warning that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. § 1001) and may jeopardize the validity of the application or any patent issuing thereon.

Strictly speaking, an oath involves a swearing of the person making the same, and is, in this respect, to be distinguished from

⁶ 37 C.F.R. § 1.153.

⁷ 37 C.F.R. § 1.162.

an affirmation. As used in the *Rules of Practice* (37 C.F.R.), however, the distinguishing characteristic of an oath is the attestation of an authorized official (e.g., a notary public), whether the statement is sworn to or affirmed. A declaration, while it involves an affirmation, is to be distinguished from an oath in that a declaration is executed entirely by the person making the same, there being no attestation by a notary public or other authorized official.

It should be noted that the applicant who elects to submit a declaration in lieu of an oath makes a commitment beyond that made by the applicant who submits an oath, to the effect that all statements made of his own knowledge are true and that all statements made on information and belief are believed to be true. Absent this commitment, an applicant does not vouch for the truth or validity of statements made in his specification. Absent the submission of a declaration, an applicant may make, in his specification, what he knows are spurious statements with impunity. By an oath, essentially all that an applicant commits himself to is that he believes himself to be the original and first inventor of what he claims.⁸ Neither by oath nor declaration does an applicant vouch for the operability of what he claims. Nevertheless, data contained in a patent application, as filed, bears a presumption of correctness.^{8.1}

The oath or declaration must be submitted within a reasonable time after its execution, lest it become stale. As a general rule, if more than five weeks have elapsed between the date of execution of the oath or declaration and the filing of the patent application a new oath or declaration will be required by the Patent & Trademark Office. If no date of execution appears, the applicant is required to file either a new oath or declaration or a certificate from the notary giving the actual date when the oath was taken.⁹

The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required averments have not been made or if it has not been properly subscribed to, a new

⁸ Ex parte Quattlebaum, 84 U.S.P.Q. 377 (P.O. Bd. App. 1948).

^{8.1} Ex parte Marsili, 214 U.S.P.Q. 904, 906 (P.O. Bd. App. 1980).

⁹ M.P.E.P. 602.05. See Ex parte Heinze, 1919 C.D. 67, 265 O.G. 145 (1919).