

Key Concepts in IP Policy: How Patents are Granted and How they can be Opposed

Pre-Grant: Patent Application and Examination

U.S. law sets criteria that must be met and confirmed through a rigorous process of review **before** a patent can be granted:

When a patent application is filed with the **U.S. Patent & Trademark Office**, “there are a number of legal requirements that must be met, including *novelty* (35 U.S.C. 102), *utility* and *eligibility* (35 U.S.C 101), *non-obviousness* (35 U.S.C. 103), and *written description* (35 U.S.C. 112)...”

- **Eligibility:** Does the claimed invention or discovery fit the statutory definition of a new and useful *process*, *machine*, *manufacture* or *composition of matter*, and avoid judicial carve-outs?
- **Patentability:** Has the claimed invention or discovery been shown to be *new*, *useful*, and *non-obvious* to a “Person of Ordinary Skill in the Art” (POSA)?
- **Enablement:** Was the invention adequately disclosed (described) in the application such that the POSA could follow the steps to re-create the invention?



A patent examiner, “review[s] the contents of the application to determine if it meets all legal requirements for a patent to be granted. The examination consists of a study for compliance with legal requirements... and a search through U.S. patents, publications of patent applications, foreign patent documents, and available literature.”

“This is to see if the claimed invention is new, useful, and non-obvious, and if the application meets patent statute requirements and rules of practice.”



U.S. Patent & Trademark Office

“Patent Process Overview”

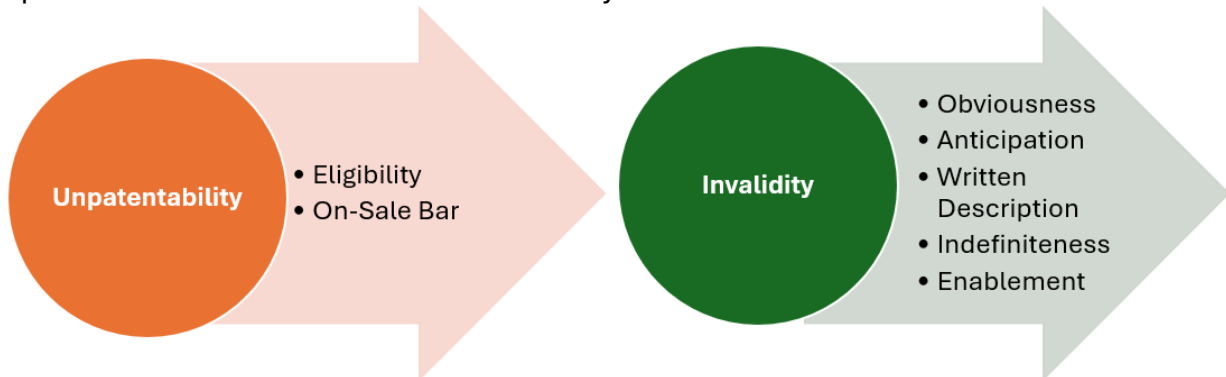
Post-Grant: Dispute Adjudication and Resolution

Patents granted by the U.S. Patent & Trademark Office via its rigorous examination process carry a statutory presumption of validity. Nevertheless, U.S. law provides opportunities for the public to oppose a patent **after** it has been granted:

Why? A third party may believe there were factual errors in the application or examination that should have caused the application to be rejected.



When? An opposition proceeding could be initiated if a party believed the patent was either unpatentable or invalid based on the statutory criteria.



Where? Parties may challenge granted patents either in the federal district courts or in administrative proceedings at the Patent Trial and Appeal Board, with both tracks appealable to the Court of Appeals for the Federal Circuit.



Judicial:
District Court
Litigation

OR



Administrative:
USPTO Patent Trial
and Appeal Board