



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

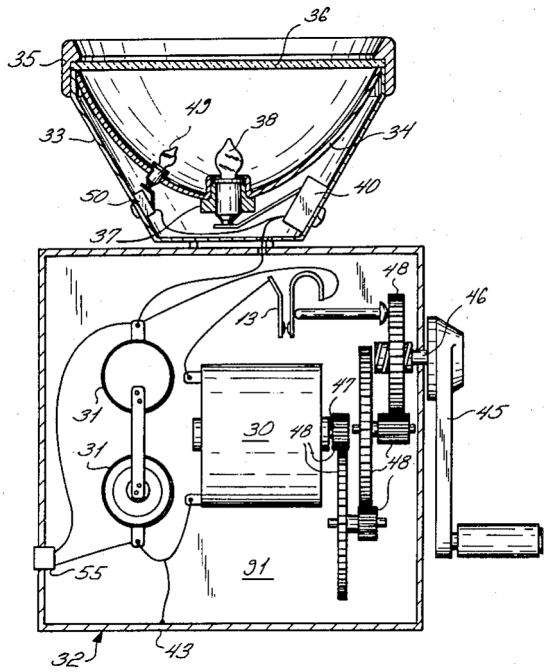
the invention must not have been “known or used by others in this country, or patented or described in a printed publication in this or a foreign country”

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:

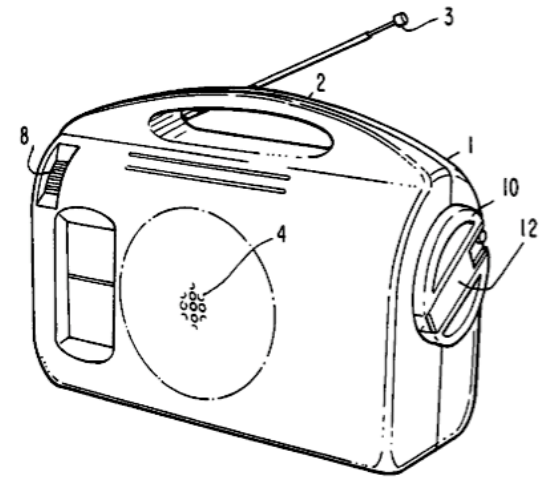


flashlight with
crank and battery



radio

is this patentable?



radio with crank
and a mechanical
storage device

Answer

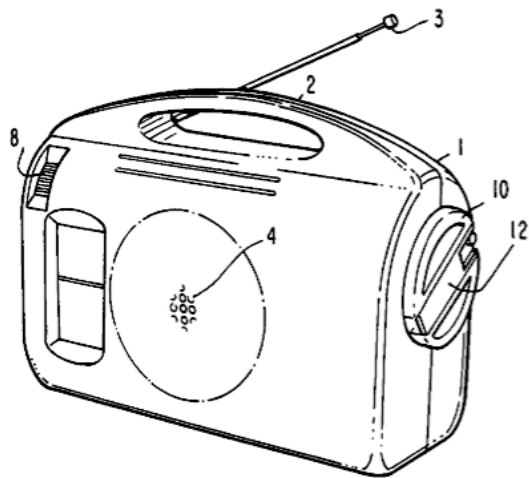
Claim 11 of U.S. Pat. No. 5,917,310 states:

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:



is this patentable?



satellite radio with
crank and a mechanical
storage device

Answer

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

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

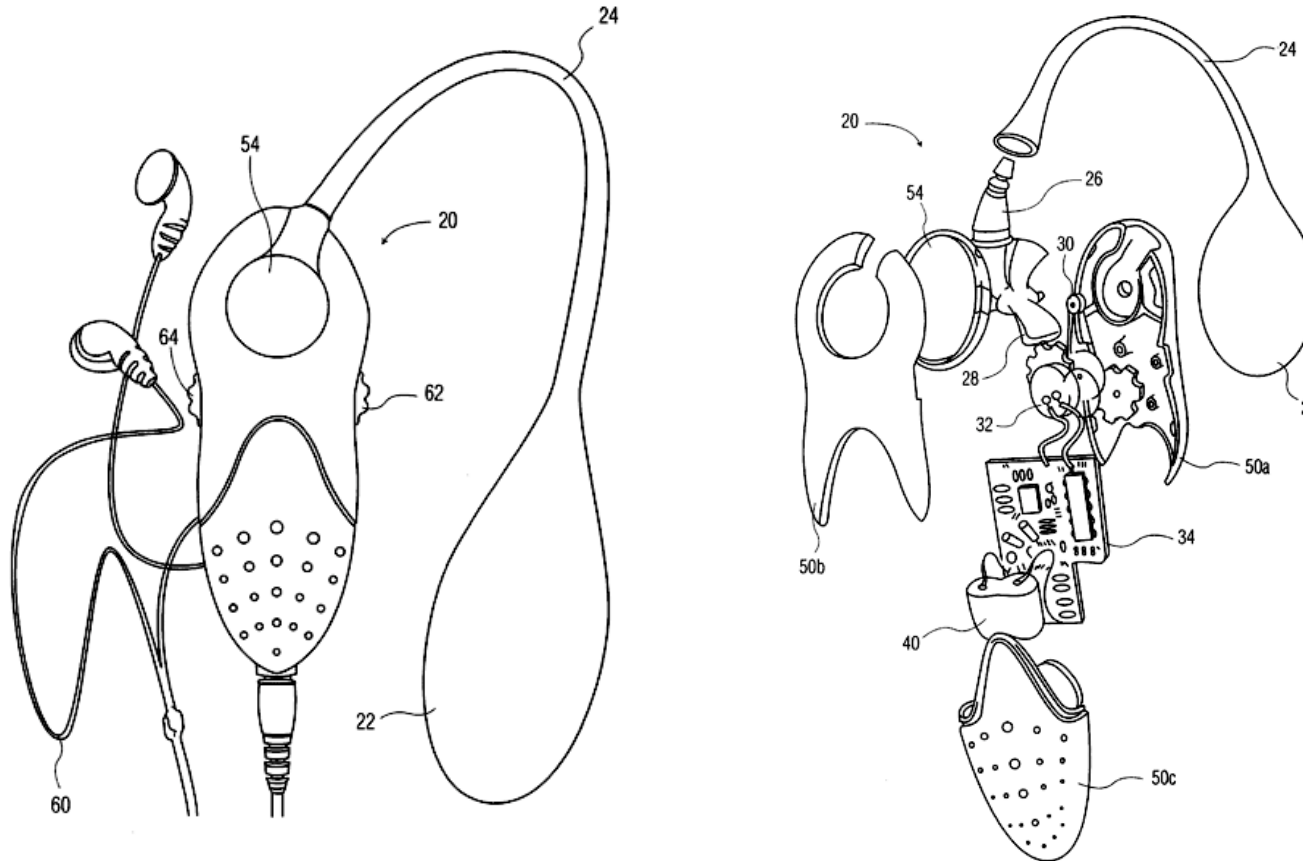
- **makes, uses, ... or sells** any patented invention, within the United States, or **imports** into the United States

any patented invention during the term of the patent ... infringes the patent.”

The term of a patent expires 20 years after the filing date.

GROUP QUESTION

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



radio with air pump and a mechanical storage device

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.

Answers

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

	Infringement	No Infringement
Not Patentable	Satellite Freeplay	Retro radio
Patentable	Solar Freeplay	Air pump radio

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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