

# How do you know if your ideas are patentable?

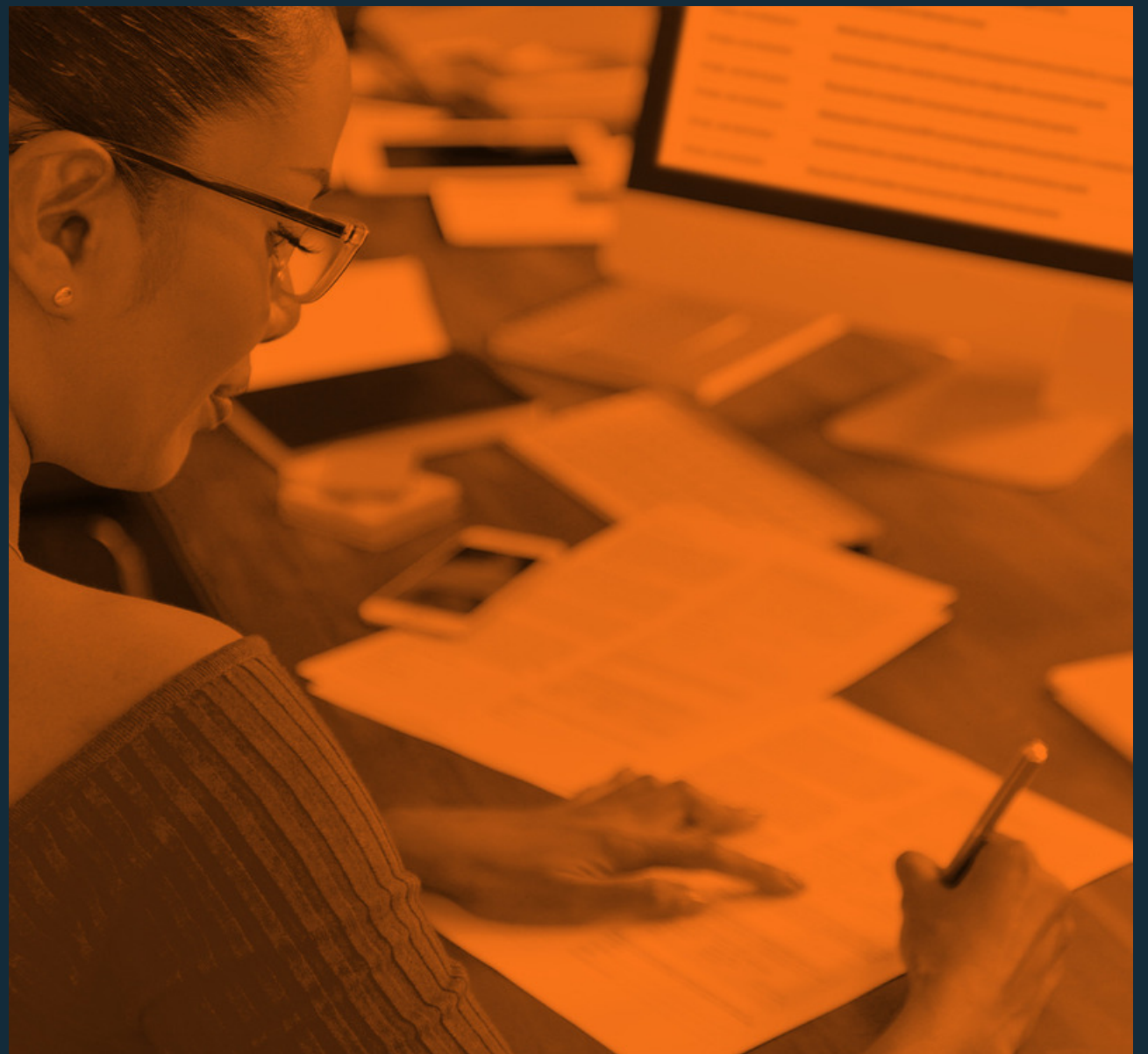
**The four factors you need to know**



Excerpted from *The 30-minute Patent MBA*

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Companies are constantly innovating. This is the way of business. A company identifies demand that has yet to be met in the marketplace and then develops a product or service to fill that need. This new product or service constitutes a competitive advantage



for the inventing company and, often, this invention is patentable intellectual property.

However, many CEOs, CTOs and Engineering Managers don't think of their technology in this way. Instead of considering it as intellectual property, they simply think of it as part of their business, or as a solution to a problem. And for the rare person who does think about protecting their company's technology, how do they even know if it's patentable?

This is a predicament faced by innovation-focused executives. They know their company has innovated as it has built a market for its products/services but they lack the expertise (and time) to explore whether their innovations can be protected. If they do pursue an answer to this question, they do so by consulting with a patent professional, such as a patent attorney. But there are technology solutions that can help them figure this out more quickly and cost-effectively than paying a lawyer hundreds of dollars per hour.



This eBook presents business advice that may help you understand the base requirements that make an idea patentable.\* Armed with this knowledge, you will have a better idea of whether your company's technology can be protected by patents and if you should contact a legal professional.

## What is the criteria to get a patent?

At the most basic level, an invention must fulfill the following requirements to be considered for a patent:

**1. The subject matter must be patent-eligible.** Section 101 of the U.S. Patent Act, found in Title 35 of the United States Code, states that “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.



Things that are not patentable, include:

**a. Laws of nature:** you cannot, for example, patent nuclear fusion, gravity, electron spin or cloning.

**b. Physical phenomena or products of nature:** naturally occurring chemical compounds, wildlife or plants cannot be patented.

**c. Abstract ideas, such as concepts, formulas or algorithms:** This one is tricky, as the boundaries between algorithms and software programs aren't clear. According to Ken LaMance, an attorney at LegalMatch: “Although software functions by using algorithms and mathematics, it may be patentable if it produces some concrete and useful result. However, what cannot be patented is software whose only purpose is to perform mathematical operations. Thus, software



that converts one set of numbers to another will not be patentable, but software that converts one set of numbers to another to make rubber will be patentable.”

d. Artistic works: Music, literature and art may not be patented; they may, however, be eligible for copyright protection. Simply stated, discoveries within the natural world cannot be patented, having existed prior to being

discovered. However, inventions utilizing discoveries, or applications of such discoveries, can be patented.



**2. The invention must be new or novel.** If an invention was known to the public prior to an inventor filing a patent application, the invention cannot be considered new or novel, and is therefore not patentable. In other words, a patent cannot be granted if it prevents people from doing what they had previously been free to do. This requirement for novelty exists to ensure that existing inventions, also known as prior art, are not patented again. All information relevant to a patent’s claims of novelty that has been disclosed to the public, no matter the form in which it was presented, is considered prior art.

So, for example, you can't claim "an electric lamp for giving light by incandescence, consisting of a filament of carbon of high resistance, made as described, and secured to metallic wires, as set forth" because everybody has used or heard of Edison's electric lamp even though his patent on the technology has long since expired. So, in this case, it doesn’t matter if a patent is valid or expired, only that the idea you are trying to patent is new or novel.

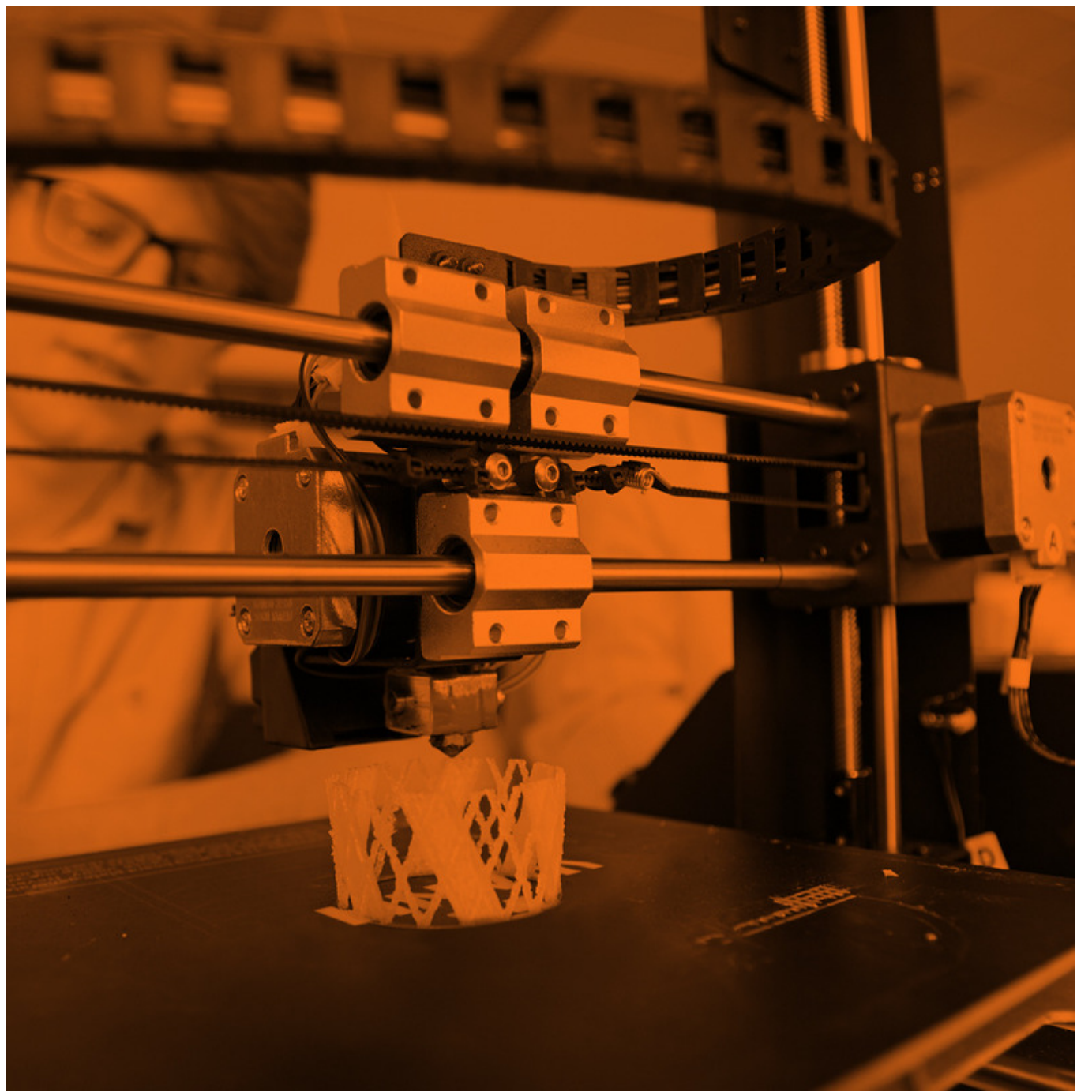
The way to figure this out is to work with a patent professional who either knows what’s in the prior art for a specific kind of invention (a domain expert) or, perhaps more importantly, one who can quickly find relevant prior art. A professional who can find relevant prior art



fast is often more useful than a strong domain expert because available information about patentable concepts or ideas is growing at a fast rate.

**3. An invention must be non-obvious.** This means that an invention must be a non-obvious improvement over existing products or practices. If it is deemed that an invention could easily be discovered by someone of “ordinary knowledge” or

follow from “normal development” in a given field, the invention is not patentable. Additionally, if the invention is simply a routine or predictable combination or application of existing technology, it is not patentable.



For example, if your invention is to take your application's local database and store it in the cloud or on the blockchain (both the cloud and blockchain technologies are meant for storage and particularly storage of databases), then your invention is likely only using a known technology in its intended manner and is, thus, obvious. This can make it more difficult to patent processes that don't provide a technical improvement beyond what is already inherent to the known technology or fail to combine the known technology in a non-obvious way.

**4. An invention must be useful.** This means that the USPTO's patent examiners must determine that an invention has a specific utility.

Now knowing what it takes for an idea to be patentable, we will assume that your solution is useful. Why else would you be creating it? We will focus the patentable invention investigation on patent-eligible, novel, and non-obvious to determine if your technology or processes contain inventive material.



Generally, when reviewing your product and roadmap for patentable inventions, you should focus on your most significant differentiators and competitive advantages. What do you want your sales and marketing people to tell potential clients? Is your company's solution faster, cheaper, smaller, easier to use, etc.? How did you make it so or how do you plan to make it so?



When trying to determine where in your technology there may be good IP, often an engineering team is unaware that what they have created is novel and non-obvious. It's been our ongoing experience that talented engineering staffs frequently dismiss the possibility of their creation being patentable. This is an area where automation can really help.

## Conclusion

Automated invention discovery tools can compare product information to a vast database of prior art and help give you an idea of whether or not patentable material exists within your solution. It can also be helpful to have a patent expert examine your technical material and/or hold a brief invention investigation session with your key engineers. It is best to do this prior to publicly disclosing your innovations or offering for sale products that contain your innovations.

Going forward, have your engineering team document new projects, upgrades, and designs in enough detail to have someone of a similar skill level be able to reconstruct it without too much experimentation. This enhances future invention disclosures and will provide a ready-made basis for your next set of provisional patent applications.



TurboPatent pairs U.S.-based TurboPatent engineers who possess deep domain expertise with industry-leading patent preparation technology to help companies patent their ideas more quickly, easily for about half the cost of a law firm.

TurboPatent's clients receive predictive analytics that help them make smarter patenting decisions, enabling them to focus their

efforts (and money) on protecting the right technology.



\*TurboPatent is not a law firm. The information included in this eBook is intended as business advice. You should contact a registered patent professional for legal advice.

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