

CHAPTER 2: WHAT IS PATENTABLE
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The United States allows inventors to patent “anything under the sun made by man that is useful, novel, and non-obvious.”

Made by Man

Patent protection can be secured only for subject matter that involves the hand of man. Discovery of something that exists in nature – while perhaps an important and valuable discovery – cannot be patented. For example – a chemical compound found in nature is not patentable by the persons who discovered the compound as man was not involved in creating the compound. However, a concentrated extract of that compound may be patented as man was involved in extracting the compound. Similarly, discovery that the thermal expansion of concrete is highly dependent upon the concentration of magnesium ions present in the concrete slurry during initial curing cannot be patented as this relationship existed in nature long prior to its discovery by man. However, a method of making concrete using water that has been treated to remove magnesium ions in order to form concrete resistant to thermal buckling may be patented as man was involved in treating the water.

Useful

The “usefulness” requirement may be satisfied by substantially any level of utility beyond mere experimental use of the invention in the development of another invention. Usefulness tends to be an issue only in those situations where a patent application seeks to patent a new chemical compound they’ve synthesized in the lab, but they have yet to ascertain any use for the compound beyond fill for a sandbag.

Novel

The “novelty” requirement means that the exact invention must not be described in a single prior art reference. The usefulness and novelty requirements are straight forward, and may generally be readily evaluated with a fair degree of certainty.

Nonobvious

The “non-obvious” requirement requires the invention to be sufficiently different from what was known before (prior art in “patentese”) that conception of the invention would not have been obvious, at the time the invention was made, to a person having routine skill in the art to which the invention pertains. As can be readily appreciated, the “obviousness” standard introduces substantial uncertainty into an assessment of patentability due to the subjective nature of the analysis.

In assessing the chances of obtaining patent protection, it is necessary to compare the invention with the prior art, identify features which distinguish the invention from the prior art, and specify the advantages which the distinguishing features contribute to the invention.

Chapter 3 will provide additional details for assessing obviousness and set forth some practical examples.