Who Makes the Patent Calls?

Technical preparation isn't always a requirement for making decisions about inventions. And that may not be all bad. By Kirk Teska

Besides you, the inventor, a lot of people of varying backgrounds can become involved in your patent. You might be surprised to find that non-techies make some of the most important decisions regarding your intellectual property.

The process starts with the patent application, which is usually drafted and filed by a patent attorney. Such an individual typically has at least a bachelor's degree in engineering or science, went to law school, and in addition to passing a state bar exam to become a "regular" attorney, also passed a specialized test given by the Patent Office called the (dreaded) "patent bar." Patent agents have similar backgrounds except they did not go to law school.

Your patent application is reviewed by an examiner at the Patent Office, and it is this individual who decides if your invention is worthy of a patent. Examiners have at least a bachelor's degree in engineering or science, but you won't typically know if your examiner graduated last month or ten years ago. Many examiners have no engineering experience outside of college. For example, only 26 percent of the examiners reviewing so-called business method patents have any industry experience.

If you sue someone for infringing your patent, the key decisions will be made by both a federal judge and a jury. The judge and the members of the jury typically do not have technical degrees.

What does your patent protect? That is a decision that the judge makes. Was the patent violated? That question is answered by the jury. Is the patent valid (e.g., is the invention novel and unobvious)? The judge decides. If infringement is found, how much money can you recover? Jury question. The judge decides, however, whether you are entitled to a preliminary injunction pending a trial.

Since these people may never completely understand the patented technology, patent cases are often deemed a "battle of the experts" because both parties to the case will employ experts to attempt to convince the judge and jury that their side should prevail.

If you are unhappy with the Patent Office examiner's decisions, or the judge's or the jury's decisions at trial, you can appeal to the Court of Appeals for the Federal Circuit located in Washington, D.C. This so-called specialized patent court consists of sixteen judges who hear all patent appeals. Yet fewer than half were once patent attorneys or have any kind of technical background. If you appeal from the CAFC to the U.S. Supreme Court, none of the justices there has a technical degree.

Many people have commented on the fact that many important patent decisions are made by non-techies. There are both pros and cons to the idea of a specialized technical patent court in the U.S. like those that exist in some foreign countries.

I look at it this way. Suppose you invent and patent a never-before-seen device. Presumably, if it's a true invention, no one will have seen it before. So, is there really any benefit to having an engineer decide whether your patent is infringed or valid? Perhaps your answer is yes, because it will be easier to explain your device to this engineer judge. On the other hand, what if this judge (maybe he has a Ph.D. and you only have a B.S.) doesn't think much of your device?

As things stand now, the key people deciding your case likely will not have an engineering degree. That is one reason that, although patents need only be written to be understood by "one skilled in the art," the best patents are written so that they can be understood, at least at a high level, by those not skilled in the art—because those are the key people who will be reading and deciding things about your patent.

Consider an invention where one key component is an ion mobility spectrometer. As an engineer writing for other engineers, you may not need to explain what such a device is or how it works. In the world of patents, though, you might be better off with a discussion a little more accessible to non-specialists. The key is to delineate, which means to describe and to explain in vivid detail. A patent should read like an article in *Mechanical Engineering* or a technology column in *Time* and *Newsweek*.

So, in the above example, the patent would explain that an ion mobility spectrometer is a device which ionizes small amounts of chemicals and measures how quickly they move through an electric field to detect and identify very low concentrations of, for example, drugs and explosives.

People tend to ignore that which they cannot understand and appreciate that which can be understood. A patent, often a valuable asset, is better when it can be understood. ■

Kirk Teska, a frequent contributor to *Mechanical Engineering*, is an adjunct law professor at Suffolk University Law School, and is the managing partner of Iandiorio, Teska & Coleman, an intellectual property law firm in Waltham, Mass. His book *Patent Savvy for Managers* is now available online and at most major bookstores.