Tip #7 – Is your invention “ready” for patenting? – Part II

Note: Our seventh tip in a series. To view previous articles please click [here](https://www.jmbdavis.com/category/us-patent-practice-tips/).

When I was just starting out in patent law, I had the great pleasure of taking my children to a [museum exhibit](http://grandeexhibitions.com/da-vinci-the-genius/) showing full-scale models of inventions from Leonardo DaVinci’s notebooks. Walking through the ingenious creations on display left me no less open-mouthed in wonder than my kids. But then the naïve patent attorney part of me reacted in horror: how could any mechanical device be patentable after DaVinci?! The next day I told one of my mentors about the experience, and he wisely remarked that “the invention is in the details!” For biotech, chemistry, and pharma patent applications, I would add: the invention is in the **experimental data**.

Every invention has a secret ingredient – those details of the technology that mark it as a true advance over the state of the art. In many countries outside of the US, this quality is called “inventive step,” but in the US, it is called “non-obviousness.” Like in all jurisdictions, US patent examiners determine non-obviousness by comparison with the prior art. A big difference between the US and everywhere else however is that a US examiner needs very little underlying basis in the prior art to reject a claim as obvious, and can rely on what an examiner might consider to be mere “common sense” of the “ordinary artisan.”

For an invention to be “ready” for patenting therefore, it is crucial not only that you, or your client, can identify the unique, inventive features of the invention, but also that those features are highlighted in the patent specification ***and included in the claims***. It is also important to remember that while the functional benefits of the inventive features may seem clear to you, they must be both described and also ***demonstrated*** in the patent application. In addition to helping to fulfil the description and enablement requirement, including these details can also help demonstrate non-obviousness during examination. Even if an examiner doesn’t “get” the invention at first glance, explaining the benefits of the inventive details in the application will allow your patent attorney to highlight the inventive features to the examiner, and argue that a claim is non-obvious over cited prior art.

Which brings me to data.

There is no substitute for good data to support the non-obviousness of a claimed invention. If the non-obviousness of an invention rests on a superior function resulting from a structural feature, the patent application must provide this data. Without it, the invention is not ready for patenting. Without it, there isn’t really an invention at all, just an idea.

So tell the world both ***why*** and ***how*** your invention is not obvious. If you can do that, then the invention is truly ready for patenting!

Do you have questions about the above information? Are there subjects that you would like to hear about? [Let us know!](mailto:mike.hammer@jmbdavis,com)