

# TechRoadmap *Directions*

Intellectual Property Issues of Interest to High Tech Companies

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## Welcome

Most inventors know that an invention must be useful, novel and non-obvious to qualify for a patent. Where they often fall down, however, is differentiating a new *invention* from a new *application* for an existing invention.

**Patent examiners rarely care what the invention is used for**; in the patent world if your invention performs an analogous function in an analogous manner to an existing device you're not likely to get a patent. If you don't believe it, read "Applications Don't Count" to learn why **the Patent Office thinks you can brush your hair with a toothbrush.**

## Who else should read this?



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### • Brush off your "IP IQ"

Figuring out what to patent is a two part process - first you have to decide if the idea, product, or technology you're working on is novel enough to **qualify for patenting** and then you need to decide if it is **worth** patenting.



Acting as your Director of Intellectual Property TechRoadmap helps you with both decisions. Check out our *Invention Mining<sup>sm</sup>* Service, which identifies potentially patentable ideas in your on-going work.

### • Applications Don't Count

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## review



We would be happy to schedule a visit to your facility to help you review the good and not so good IP practices you use. Sign up on our web site with the link below.

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## IP Links of Interest

- [US Patent Office](#) A host of useful, official information.
- [EKMS, Inc.](#) A strategic IP management partner of TechRoadmap.
- [The Patent Cafe](#) An on-line portal for IP matters.
- [AlvaMed, LLC](#) A medical device consulting company we work with.
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In the movies it always seemed that the ultimate boot camp punishment was to **scrub the latrine with a toothbrush** (preferably one's own!). This was a hard punishment because of the obvious mismatch between the tool and the task. In the world of patents, however, **it might be judged differently**. Is there a difference between brushing teeth and cleaning a toilet with a brush? After all, the toothbrush is intended to clean hard surfaces by scrubbing with moderately stiff bristles, optionally with a soap-like cleaning product and isn't that just how you clean the latrine? **Isn't it just a different application for a brush?**

**If a recent Appeals Court ruling is to be believed, in your patent application applications hardly matter!** The decision relates to a patent application for a hair brush, which was rejected because of toothbrush prior art. While the details of the case are not particularly of interest, the two points repeated by the Court are worth noting.

First, the Court agreed with the Patent Office that **during examination claims should be given their broadest possible interpretation**. As applied to this case it means that the inventor's hair brush claims (i.e., scalp hair) become claims for brushes used for any hair - scalp, facial, animal, etc.

Second, the Court also agreed with the Patent Office that a toothbrush perform a similar function to small hair brushes; that is, they agreed that **tooth brushing is analogous to hair brushing**. Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, **regardless of the problem addressed** or (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is **reasonably pertinent to the particular problem** with which the inventor is involved. In this case, the invention was determined to relate to the "field of hand-held brushes having a handle segment and a bristle substrate segment."

Specifically, the **Court concluded that the prior art toothbrush was in the current inventor's field of endeavor** because "the structural similarities between toothbrushes and small brushes for hair would have led one of ordinary skill in the art working in the specific field of hairbrushes to consider all similar brushes including toothbrushes."

As an inventor you must always remember that patents generally **protect how you implement your invention,**

**not how you use your invention.** Keep that in mind and the Patent Office won't give you the brush-off!

- **Tip of the Month**

**Before spending money on a patent application decide if you really have an invention:**

- **Spend some time talking to clever friends** - Because a non-inventor is not so focused on your field of use he or she might suggest analogous fields of use. Then *check for prior art!*
- **Make lemonade** -If the PTO thinks there's prior art in some other field, see if you can address the issue and get a broader patent.
- **Analyze your invention for structure and function** - You know the saying; if it walks like a duck... If your invention performs an analogous function in an analogous manner you probably have reinvented that duck.

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- **Disclaimer**

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