Patent and Publish Without Perishing

What You Need to Know to Write/Speak About Your Work Without Losing US/Foreign Patent Rights

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Director of Intellectual Property Management
We believe innovation from academic research can make a positive difference in the world. The Purpose of OTD is to help OU researchers transform ideas into tangible impact for the betterment of society.

The Mission of OTD is to provide the highest level of fiduciary expertise for the perfection, conveyance and commercialization of OU IP.

To be recognized as a driving force for OU’s economic impact through education, expertise and efficiency.
TOPICS FOR DISCUSSION

• What is a patent and what does a patent protect?
• Key milestones of the patent process and types of patents.
• How to publish without hurting your patent rights.
• What constitutes a "public disclosure"?
What is a patent?

A patent is a document which gives the patent owner (the University) a monopoly over the “claimed” invention for up to 20 years.

A patent gives the owner the sole right to exclude others from making, using, selling, or importing the claimed invention.

The invention claimed in an issued patent is established only after an extended “prosecution” process with the Patent Office.

A patent is only good in the country it is issued.
Key Milestones of the Patent Process, and Types of Patents

- Submit your Invention Disclosure to the OTD for commercial and patentability evaluation.

- File a “Provisional” patent application, collect additional data during the next 12 months.

- If “go forward,” a “Non-Provisional” application must be filed within 1 year of the Provisional.

- 1.5 – 2 years before the Non-Provisional application is examined by the Patent Office.

- 1 more year to complete the prosecution process, if lucky.

- A “PCT” application might be filed to retain non-US rights.
How to Publish Without Hurting Your Patent Rights

1. **BEST CASE** - Patent application is filed **before** any public disclosure of invention: both US and foreign rights **retained**.

2. Public disclosure of invention, then file patent application **within one year**: US rights **retained** (the one year “grace period”), foreign rights probably **lost** (no “grace period”).

3. **WORST CASE** – Patent application is **not filed within one year** of public disclosure: both US and foreign rights are probably **lost**.

4. Take home message: Submit your invention disclosure to OTD at least 3 months before any public disclosure.
What constitutes a "public disclosure"?

Assume that any disclosure, publication, or presentation that describes all or part of your invention, and is not subject to a confidentiality agreement, is a public disclosure.

Types:

1. Written
2. Oral
3. Public Use or Sale
WRITTEN DISCLOSURES

- Publications (hard copy or online)
- Grant Proposals (if confidential matter is not explicitly marked)
- Preprints/draft manuscripts if distributed
- Abstracts (hard copy or online)
- Theses/Dissertations (once indexed and shelved)
- Meeting Abstracts or Proceedings
- Posters (even if just in departmental hallways)
- Handouts
- Book chapters
- Web sites
- Press releases, Published interviews
- Non-confidential private correspondence/emails
ORAL DISCLOSURES

• Meeting and Conference presentations
• Departmental Seminars (if open and publicized)
• Thesis/Dissertation defenses, if not closed
• Non-confidential conversations or meetings, even if private
PUBLIC USE OR SALE

• Sale

• Offer for sale (even if not “ready” to sell)

• Use or demonstration in public, or in an area accessible to the public

• Non-confidential material transfer

• Non-experimental or unrestricted use by others
Thurs., Oct. 29, 2015, 4 PM, Devon Energy Hall, Rm. 220, Norman

Wed., Nov. 4, 2015, 12 PM, BRC N. Conf. Room 103, OKC

Tues., Nov. 10, 2015, 12 PM, University Club, Norman

Tues., Nov. 17, 2015, 4 PM, HSC Bird Library, Rm 299, OKC
NEXT UP IN THE “SOONER-TO-MARKET”™ DISCUSSION SERIES

DATA THAT MATTERS

Presented by DR. GINA McMILLEN,
Director Office of Technology Development
Health Sciences Center

Wed., Dec. 2, 2015, 12 PM, BRC N. Conf. Room 103, OKC
Wed., Dec. 9, 2015, 4 PM, Devon Energy Hall, Rm. 220, Norman
Tues., Jan. 12, 2016, 4 PM, BRC N. Conf. Room 103, OKC
Tues., Jan. 19, 2016, 12 PM, University Club, Norman
QUESTIONS?