Patents 101: First, Do No Harm

How to Write and Speak About Your Invention Without Losing US or Foreign Patent Rights

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TOPICS FOR DISCUSSION

• What is a patent and what does a patent protect?
• Requirements for patentability.
• Prior art and public disclosures.
• Types of public disclosures.
• How to publish without hurting your patent rights.
• Key milestones of the patent process and types of patents.
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.
REQUIREMENTS FOR PATENTABILITY

1. Must be **eligible subject matter**-machine, process, composition of matter, article of manufacture (non-eligible: inventions that are purely natural products or laws, abstract ideas, equations, correlations, mental steps…). When in doubt, Ask!

2. Must be **useful** (have utility)

3. Must be supported by an enabling **description** (how to make and use what is claimed)

4. Must be **Novel** (“New”)

5. Must be **Non-obviousness** (more than an obvious variation of what’s already known)
The Role of “Prior Art”

The novelty and non-obviousness of an invention is examined by the Patent Office in light of all of the publicly disclosed knowledge available before the filing date of the patent application.

Relevant prior art is a public disclosure made either by others, or by you, anywhere.
Assume that any disclosure, publication, or presentation by you that describes all or significant aspects of your invention, and is not subject to a confidentiality agreement (see OTD) or is not made only to other OU employees, is a public disclosure.

A public disclosure’s relevance to the patent process depends on how much of the invention is “enabled” or described in the public disclosure, and when it was publicly disclosed.

Types: Written, Oral, Public Use or Sale
WRITTEN DISCLOSURES (I)

• Publications (hard copy or online).
• Awarded grant proposals (Confidential matter should be explicitly marked).
• Preprints/draft manuscripts if distributed.
• Abstracts (hard copy or online).
• Theses/Dissertations uploaded to SHAREOK (unless embargoed).
• Thesis/Dissertation Abstracts uploaded to SHAREOK (even if embargoed).
WRITTEN DISCLOSURES (II)

- Meeting Abstracts or Proceedings.
- Posters (even if just in departmental hallways).
- Handouts.
- Book chapters.
- Web sites.
- Press releases, Published interviews.
- Non-confidential private emails or other correspondence (i.e., no CDA in place).
ORAL DISCLOSURES

- Meeting, Symposium, and Conference presentations.
- Departmental Seminars (if open and publicized), e.g., GREAT.
- Thesis/Dissertation defenses, if not closed.
- Non-confidential conversations, phone calls, or meetings, even if private.
Public Use or Sale

- Sale.
- Offer for sale (even if invention is not “ready” to sell).
- Use or demonstration in public, or in an area accessible to the public.
- Non-confidential material transfer (e.g., drugs, clones).
- Non-experimental or unrestricted use by others.
HOW TO PUBLISH WITHOUT HURTING YOUR PATENT RIGHTS

**BEST CASE** – File Patent application **before** any enabling public disclosure of your invention: **Both** US and foreign rights are **retained**.

**U. S. RIGHTS ONLY** - File Patent application **within one year** of an enabling public disclosure by you:
- **US** rights **retained** (the one year “grace period”), but
- **Foreign** rights **lost**.

**WORST CASE** – Public disclosure was **more than one year ago**. No patent application can be filed: **Both** US and foreign rights are **lost. No patent**.

Take home message: Submit your invention disclosure to OTD at least 3 months before any public disclosure by you.
KEY MILESTONES OF THE PATENT PROCESS, AND TYPES OF PATENTS

• Submit your Invention Disclosure to the OTD for commercial and patentability evaluation. If a “go”:

• OTD files a “Provisional” patent application. 12 months to collect additional data/investigate licensing. If a “go”:

• OTD files a “Non-Provisional” application within 1 year of the Provisional filing date. Can mature into a patent.

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

• 1+ years to complete the prosecution process, if lucky.

• A “PCT” application might be filed to retain non-US rights.
Inventor Resources

- To fill out an invention disclosure go to:
  - otd.ou.edu
- Click on “Disclose an Invention”, or
- To fill out a CA or MTA:
  - Click on “Intellectual Property Forms” then
  - Click on “Confidentiality Agreement” or “Material Transfer Agreement”.

Next Up in the Series:
“Customer Discovery/Growth Fund”

Presented by Meredith Wilkerson and Annie Smith, OTD

Sept. 25, 2018, Norman campus, Memorial Union, Weitzenhoffer Rm., 12-1 PM

Sept. 26, 2018, OKC, HSC, BRC 103, 12-1 PM