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The Patenting Process in the United States

Welcoming remarks will begin at
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The Patenting Process in the U.S. An Overview for Administrative & Support Staff

Presented by:

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designated question and answer period at
the conclusion of the presentation.**

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The Patenting Process in the United States: An Overview for Administrative & Support Staff

15 May 2012

The following presentation reflects the personal views and thoughts of Ryan Schneider and Kim Dunn, and is not to be construed as representing in any way the corporate views or advice of Troutman Sanders LLP or GTRC and their Affiliates, Subsidiaries or Divisions, nor the views or advice of the Association of University Technology Managers (AUTM). The content is solely for purposes of discussion and illustration, and is not to be considered legal advice.

Today's Learning Objectives

- Types of Intellectual Property
- The Origins, Properties, And Types Of US Patents
- Learn The Process Of Obtaining A Patent
- The University Technology Transfer Model And How Patents Are A Part
- Recognize Various Types Of Patent Applications And Patent Strategy
 - The "Patent Family"
 - US Application Types
 - Foreign Patent Protection – *Upcoming Webinar*

Types of Intellectual Property

- Patent
- Trademarks
- Copyright
- Trade Secrets

What Is Protected?

Patents protect **inventions**

Trademarks and Service Marks protect **brand**, a sign or symbol indicating quality/source for products or services

Copyrights protect **expression**

Trade Secrets protect **secret information**

- Research Universities Generally Not Incentivized To Use Trade Secrets
- TTO Mission May Not Be To Protect Secret Information, But Rather Disseminate Information For The Public Good.

Basis for the US Patent System

Congress shall have the power to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

US Constitution, Article I, Sec. 8

Basis for the US Patent System

US Congress Statutes:

- 35 USC § 101 - Utility/Patentable Subject Matter
- 35 USC § 102 - Novelty
- 35 USC § 103 - Non-obvious
- 35 USC § 112 - Form and Content of Patent Application

US Supreme Court/Federal Courts - Interpretation of the Constitution and Statutes

What is a US Patent?

A grant by the Government of the right to **exclude** others from making, using, offering to sell, or selling the patented invention within the United States or importing it into the United States.

Purpose/Policy:

- Induce Innovation
- Induce Disclosure
- Induce Commercialization
- Create Incentives to Bargain

What is a US Patent?

Contract Between The US Government And An Inventor – **NOT A MONOPOLY**

A Patent Is A *Negative Right* (To Exclude Others) - Thus **DOES NOT** Give The Inventor The Right To Make And Sell Her Invention
Term: 20 Years From Filing Date (Provisional Year Does Not Count)
Public Policy To Protect And To Encourage Inventions
Requires **FULL** Disclosure Of Invention

What Can Be Patented?

Any New And Useful:

- Process
- Machine
- Manufacture
- Composition Of Matter

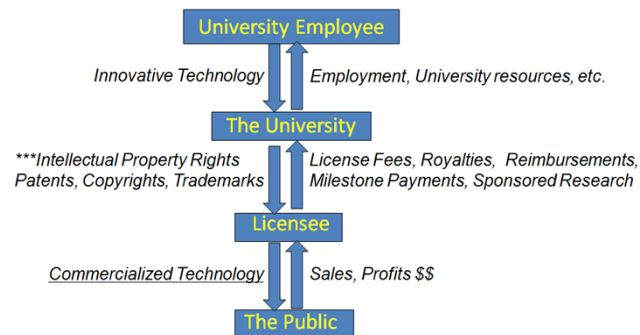
Three Types of US Patents

Utility Patents – (20 Years) - “Patents For Invention” - Relates To Structural Or Functional Features – Use Of US Provisional Patent Applications Will Be Discussed

Design Patents – (14 Years) - Relates To Ornamental Features Or Appearance -Design Cannot Have Any Utility

Plant Patents – (20 Years) - Relates To New Varieties Of Asexually Reproduced Plants

The University Technology Transfer Model



Patents and University Technology Transfer

- Patents May Attract Investors And Investment Capital
 - Licensing Opportunities
 - Start Up Companies
 - Sponsored Research
- Patents Help Define And Direct Business
 - Growth/Development And Limitations
- Patents Often Dictate The Success Of A Business
 - Market/Competition → Puts Competitors On Notice
 - Patent Expiration

The University's Pursuit of Patents

- **Invention Disclosures**
 - Clearly Define The Technology
 - Define A Market
 - Inventorship
 - Funding
- **Prior Art Searches**
 - Can You File? → Patentability
 - Should You File? → Marketability
- **Patentability Opinion**
 - Attorney's Analysis Of Prior Art

The University's Pursuit of Patents

US Provisional Patent Applications

- Preserves a Priority Date
- Expires One Year from Filing Date
- Not Examined by USPTO - They Will Never Become Patents

US Provisional Patent Application

Purpose/Benefits:

- To Establish An Earlier Filing Date (Priority Date)
- To Buy Time To Develop Technology For Non-provisional Application
- A Quick Application In Case Of Pending Disclosure
- Reduced Cost (USPTO And Attorney)
- Find Potential Licensees

NOT Examined, And Thus Does Not Have Formal Requirements Like Claims, Oath Or Declaration, Or Information Disclosure Statement

12-month Pendency, Which **Cannot Be Extended**

- May Serve As The Basis For A Non-provisional Application As Long As The Provisional Adequately Support The Subject Matter Claimed In The Later-filed Non-provisional Application

Twenty-year Patent Term Measured From The **Non**-provisional Date

US Provisional Patent Application

University's Advantage

- Cost Savings (\$125.00 Small Entity)
 - Microentity
- Bar Date Soon Approaching
- Extends Time To Evaluate IP

US Provisional Patent Application

Who Files?

- TTO Versus Patent Attorney?

Potential Con If Not Reviewed By Attorney:

- Material May Not Be Sufficient Enough to Cover Scope of Non-Provisional; Therefore Priority May Be Compromised.

- Must Be Careful To Evaluate Content Of Provisional When Filed In-house. EPO Has Come Back Denying Priority Due To Claim Set In Non-provisional Not Covered In Provisional.

US Provisional Patent Application

Make The Best Use Of A Provisional

- Filing A US Provisional *Prior* To A Public Disclosure Protects Potential Foreign Patent/Filing Rights.
- Filing A Provisional *Subsequent* A Public Disclosure (But Within 12 Months Of Such Disclosure), Protects Potential Us Patent/Filing Rights.
- Strategy - If Public Disclosure Has Occurred, File US Provisional As Close To One Year Bar Date, Which Provides Almost Another Full Year To Make Decision On Whether To File US Conventional

US Provisional to US Non-Provisional (Conventional)

Inform Patent Attorney of Administrative Considerations

- Entity Status (Small/Large) – How To Determine?
- Ownership/Licensing
- Inventorship – Will Dictate If First Filing Can Be In The USPTO, Or Another Country's/Region's PTO
- Federal Funding/Government Rights

US Provisional to US Non-Provisional (Conventional)

Entity Status

- Large – Any IP Rights Granted To Large Entity Company?
- Small – University/Research Institution
- Micro – Newly Defined Under AIA Rules

US Provisional to US Non-Provisional (Conventional)

Federal Funding

The Federal Government requires the following “exact” language to be incorporated as the “Government support clause” in all applications based on inventions supported by all or partial Federal funds.

“This invention was made with Government support under Agreement No. xxxxx, awarded by the xxxxxxxx. The Government has certain rights in the invention”

The USPTO – Conventional Patent Application Prosecution Overview

Filing An Application:

- (A) 1-2 Months: *Notice To File Missing Parts, Filing Receipt*
- (B) 16-24 Months: *USPTO Examiner Prior Art Search/Restriction*
- (C) 18-36 Months: *Office Action (§ § 101,102,103,112), Publication*
- (D) 21-42 Months: *Interview, Response To Office Action*
- (E) 24-46 Months: *Notice Of Allowance, Pay Issue Fee And Publication Fee*
- (F) 28-50 Months: **Grant**
- (G) Post-Grant: Maintenance Fees At 3 ½, 7 ½, And 11 ½ Years

Overall Costs Include:

- Your Time
- USPTO Fees
- Attorney Fees

Filing Requirements – All Documents

1. **Full Patent Application**
2. USPTO Transmittal Form
3. Name And Address Of Applicant (Place Of Incorporation If A Company)
4. **Name, Address, Citizenship Of Inventor(s)**
5. *Declaration/Oath Of Inventors*
6. Certified Priority Document
7. Filing, Search, And Examination Fees
8. *Power Of Attorney*
9. *Assignment*

USPTO Minimum Filing Requirements Satisfied If 1 and 4 are filed

Filing Requirements

(A) 1-2 Months: *Notice to Filing Missing Parts, Filing Receipt*

- USPTO Will Issue *Notice To File Missing Parts* For 5 And 7, And Upon Filing, Patent Application Filing Is Perfected – You Will Have Time To Provide 5 And 7.
- USPTO Will Issue *Filing Receipt* Once It Receives 1, 2, 4, 5 And 7
- Can Avoid The *Notice To File Missing Parts* If Original Filing Includes 1, 2, 4, 5 And 7

Filing Requirements

(B) 16-24 Months: *USPTO Examiner Prior Art Search/Restriction*

Prior Art Search

- “State Of The Art” – Information Available To The Public Before A Given Date (Priority Date)
- *Information Disclosure Statement* (Applicant) – Applicant’s Duty

Restriction Requirement – If Two Or More Independent Or Distinct Inventions Are *Claimed* In A Single Application - Election (Applicant)

Filing Requirements

(C) 18-36 Months: *Office Action* (§ § 101,102,103,112),
Publication

Office Action

- Non-Final, Final
- Allowance Or Rejection Of Claims
- Objections To Form Of Claims

Conditions of Patentability

Office Action (§ § 101,102,103,112)

Utility
Novelty
Non-Obviousness
Disclosure

Utility

35 USC § 101 "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof."

US Supreme Court: "Anything under the sun that is made by man" (*Diamond v. Chakrabarty*).

Examples of Subject Matter *NOT* Patentable

- Laws of Nature
 - Newton's Law of Gravity
- Physical phenomena
- Abstract ideas/Formulas
 - $E = mc^2$
- A newly discovered mineral
- A new plant found in the wild

Novelty

Invention Cannot Be:

- Publicly Known Or Used By Others In US Before The Invention Date
- Patented Or Described In Printed Publication Anywhere Before The Invention Date
- Patented Or Described In Printed Publication Anywhere More Than One Year Prior To US Application Date
- In Public Use In US More Than One Year Prior To US Application Date
- File As Soon As Possible After Development!*

Novelty

Invention Cannot Be:

- On Sale In US More Than One Year Prior To US Application Date
- Abandoned
- Described In A Later Issued Patent Whose Application Date Was Filed Before The Invention Date
- Invented By Another But Claimed By The Applicant
- Made By Another In The US Before The Invention Date
- *File As Soon As Possible After Development!*

Non-Obviousness

The subject matter of the invention as a whole must not be obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter of the invention pertains.

Disclosure

Enablement – The Specification Must Enable Anyone Skilled In The Art To Make And Use The Claimed Invention.

Best Mode – The Application Must Set Forth The Best Mode Of Achieving The Invention Known To The Inventor.

Written Description – Distinct From Enablement. Pinpoints Exactly When Applicant Was “In Possession Of The Invention.” Includes: (1) The Claims, (2) Specification (I.E. The Dictionary), (3) The Drawing, Etc.

Filing Requirements

(D) 21-42 Months: Interview, *Response To Office Action*

Applicant's Actions

Response to Office Action

Arguments (Attorney, Inventor)

Declarations (Expert opinions)

Case law

Amendments (Claims)

Examiner Interviews

Request Continued Examination (RCE)

Appeal

Filing Requirements

- (E) 24-46 Months: *Notice Of Allowance, Pay Issue Fee And Publication Fee*
- (F) 28-50 Months: *Grant*
- (G) Post-Grant: *Maintenance Fees At 3 ½, 7 ½, And 11 ½ Years*

Notice Of Allowance

Patent Term Extension/Adjustment

Issue/Publication Fee

Post-Grant Maintenance Fees

3 ½ , 7 ½ , And 11 ½ Year Deadlines (With Grace Periods)

Conditions of Patentability Design Patent

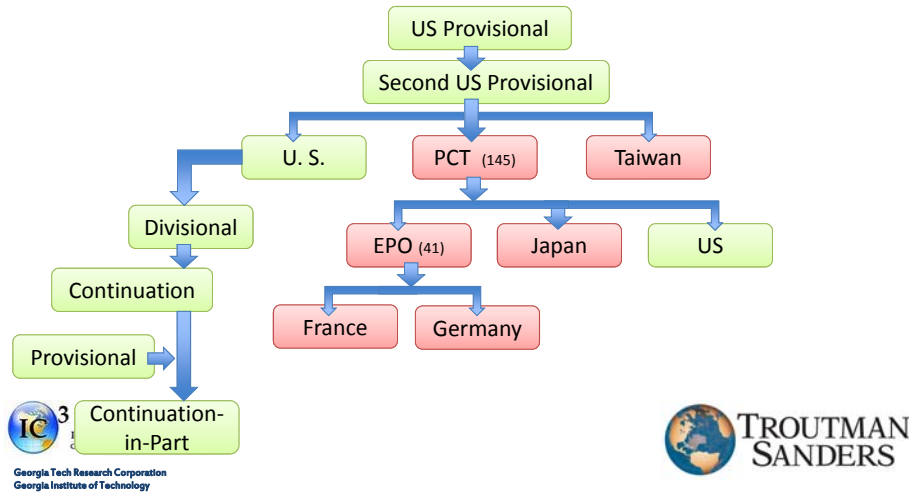
Novelty

Originality

Non-Obviousness

Ornamental

The Patent Family



Types of US Patent Applications

Provisional Applications

Utility/Non-provisional

Continuing Application - Main Types

- Divisional
- Continuation
- Continuation-in-part

Continuing Application - Main Types

A Patent Application Which Follows, And Claims At Least Partial Priority To, An Earlier-Filed (Parent) Patent Application

Retains Parent's Filing And Expiration Dates

Filed While Parent Application Is Pending

| Summary of continuing patent applications in the US | | |
|---|----------------------|--------------------|
| Type | Disclosed in parent? | Claimed in parent? |
| Divisional | Yes | Yes |
| Continuation | Yes | No |
| Continuation-in-part | No | No |

Patent Protection Outside The US

No Such Thing As An "International Patent"

The Patent Cooperation Treaty (PCT) And The World Intellectual Property Organization (WIPO)

Advantages:

File A Single "International Patent Application"

Filing And Examination In A Single Patent "Receiving Office"

Filing In One Language Effective In Each Member State

International Search And International Search Report

Opinion On Patentability

Extends The Deadline For Filing: (30 Month National Phase Deadlines)

→ But, You Still Have To Go Through Each National Patent Office To Get A Patent

Helpful Websites

- [USPTO \(www.uspto.gov\)](http://www.uspto.gov)
 - Patents
 - PAIR
 - Assignments
 - “Resources and Guidance”
 - International Search Offices
- [WIPO \(www.wipo.int\)](http://www.wipo.int)
 - Patent Search (PCT and National Applications/Patents)
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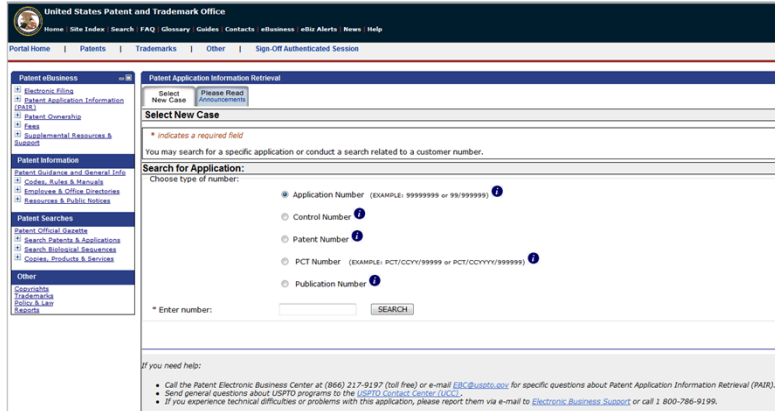
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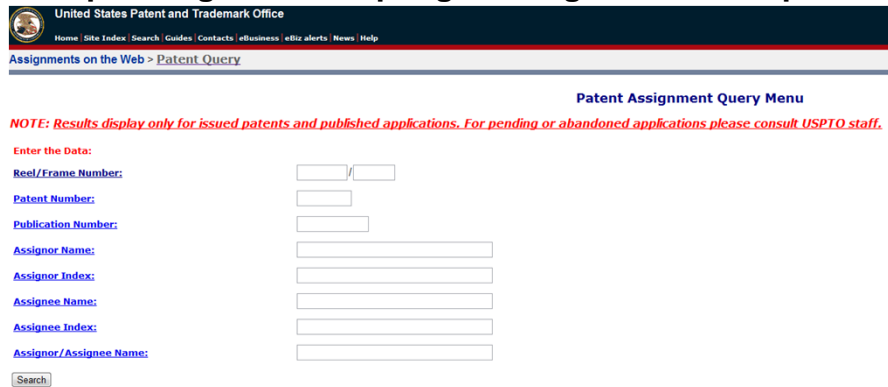
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