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Basic Patenting 101 & Working with Patent Counsel

Welcoming remarks will begin at
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The formal presentation will begin at Noon Eastern

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Basic Patenting 101 & Working with Patent Counsel

Speaker:
Lee C. Heiman, Esq., *Azos AI, LLC*

November 18, 2014

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Lee C. Heiman, Esq.

Azos AI, LLC

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Patenting 101 2014

Presented by: Lee C. Heiman, Esq.

November 18,2014

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Lee C. Heiman, Esq.
Chief IP and Licensing Counsel

Azos AI, LLC

Today's Learning Objectives

- Understand the four major types of intellectual property and how they are distinguished from each other
- Understand the origins and properties of patents
  - The basis for patent (and other IP) protection
  - The effects created by patent rights
- How patents are a part of the university technology transfer model
  - Leveraging intellectual property to create value and benefit society
  - Technology licensing
  - Start-up businesses
  - Recognizing particular dangers to avoid in the academic setting

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More Learning Objectives

- Recognize various types of patent applications and patent strategy
  - US application types
  - The "patent family"
  - International applications and foreign patent protection
- Learn the process of obtaining and using a patent
  - Statutory requirements
  - Filing requirements
  - The dual-track system in the US after passage of the AIA
  - Patent Prosecution at the USPTO
  - Defending and Enforcing Patents

One caveat

- What will be discussed today are general rules and applications of those rules
- There are exceptions to most rules
- This is not legal advice

➢ Always seek fact-specific advice on a particular topic or issue

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What Is Intellectual Property?

Intellectual Property (IP) encompasses:

- Non-"Abstract" Ideas (i.e. those having a real and useful embodiment)
- Manufacturing processes, products, and machines
- Non-"Abstract" ways of doing things related to business
- Computer programs *per se* and conceptually
- Expression of ideas
- Corporate image
- Consumer goodwill

➢ "Discoveries", no matter how important, are often too abstract to be protectable as IP

Basis for the US IP System

US Constitution, Article I, Sec. 8

*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**.*

Public Policy Considerations:

- To Protect and to Encourage Innovation and Invention
- *Quid pro quo:* rights are protected only in exchange for the eventual transfer of rights to the public

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What Is Protected?

- Patents protect inventions (content)
- Copyrights protect expression (style)
- Trademarks and Service Marks protect brand, i.e. a sign or symbol indicating quality/source for products or services
- Trade Secrets protect secret business information

Comparison of IP Rights

PATENT – Any mechanical, electrical, chemical, or process invention, or improvement thereof
- Term: 20/21 years (extendable for certain administrative delays)
- Examined, relatively thoroughly

TRADEMARK – Any sign or symbol indicating source/quality for products or services
- Term: unlimited so long as the mark is used "in commerce"
- Examined

COPYRIGHT – Any artistic or creative work of expression
- Term: "author's life + 70 years" (now)
- Registered; not examined

TRADE SECRETS – Anything that is a secret and gives a business advantage
- Inventions, formulas, and business processes, including especially customer lists
- Term: unlimited, so long as not "publicly known"
- Not examined or registered

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Turning to patents...

First, a matter of terminology:
- A "patent" is the fancy government-issued document that ends the patent procurement process
- Distinguish a "patent application", which *initiates* the patent procurement process
  - Many in business, tech transfer, and academia, including your colleagues and investigators, use these terms interchangeably
  - Understand when they are NOT interchangeable!

Basis for the US Patent System

- Congress: US Statutes, primarily US Code Title 35:
  - 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
- Judiciary: US Supreme Court/Federal Court Opinions– Interpret the Constitution and Statutes
- Executive: US Department of Commerce – Administers these Statutes and Opinions, through the US Patent and Trademark Office (USPTO)

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What is a Patent?

- A government grant of the right to ***exclude*** others from making, using, selling, or importing a protected invention
- The scope of a patent is defined by the property description found in the ***Claims***, which tell the public the metes and bounds of a patented invention
- A patent is a negative right, and is NOT a right to make or use an invention
  - does not create a monopoly!!!
- Duration: 20/21* years from first filing date
- Legal: Patents are intangible property

Types of Patents

- Utility Patents
  - Relate to structural or functional features
- Design Patents (* 14 year term)
  - Relate to ornamental features or appearance which are not structural or functional
- Plant Patents
  - Relate to new varieties of asexually reproduced (e.g. budding and propagating) plants

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Review of Learning Objectives

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  - The effects created by patent rights
- How patents are a part of the university technology transfer model
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  - Technology licensing
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Patents and University Technology Transfer

- Patents may attract investors and investment capital
  - Out-licensing to industry
  - Out-licensing to start up companies
  - University-based start up companies
- Patents help define and direct business
  - Existing market growth
  - New product/new market R&D
  - Patents can have negative limitations as well
- Patents often dictate the success of a business
  - Market exclusivity/competitive advantage, enforced through threat of infringement litigation
  - Patent expiration may signal the end of a business

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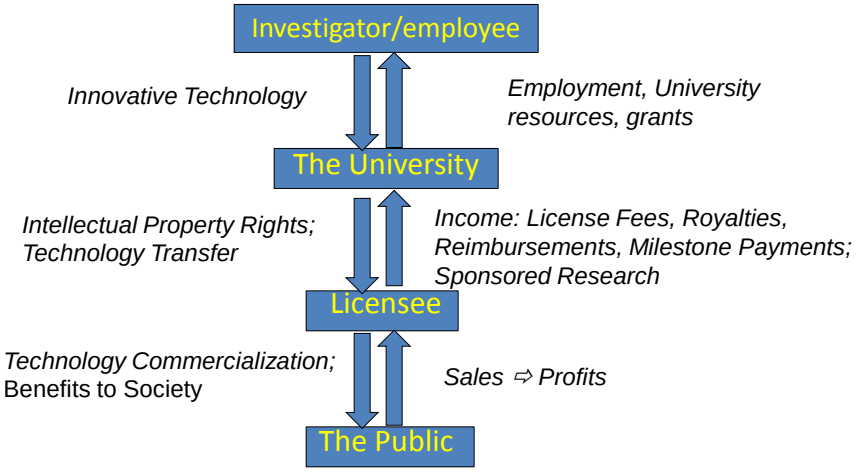
Patents and University Technology Transfer

- The University's Pursuit of Patents
  - Invention Disclosure
  - Triage
  - Patent protection decisions
  - Filing question: where/when vs. costs
  - Licensing and other avenues to the public

The Classic University Technology Transfer Model



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✓ How patents are a part of the university technology transfer model
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Types of US patent applications

- Provisional
- Non-provisional/Utility
- Continuing (i.e. derived from “parent”)
  - Divisional
  - Continuation
  - Continuation-in-Part
  - Continued Prosecution Application
  - File Wrapper Continuation

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What is a provisional patent application?

- Serves as a lower-cost/”light” first patent filing in the U.S.
- 12-month pendency, which ***cannot* be extended***
- Serves as the basis for a non-provisional (utility) application if:
  - The description and drawing(s) adequately support the subject matter claimed in the later-filed non-provisional application
- A non-provisional application is only entitled to the benefit of the common subject matter disclosed in the provisional application
  - Patentability evaluated as of the provisional filing date
- Twenty-year patent term measured from the ***non***-provisional date
- Allows the use of "Patent Pending"
- NOT examined, and thus does not have formal requirements like claims, oath or declaration, or an information disclosure statement
- Practice pointer: Distinguish "Conversion“ vs. “Claim to Benefit”

*new law in effect 1/1/2014 now allows two additional months to “restore” lost rights

What is a utility patent application?

- Fully examined; 20 year term measured from filing date
- Must meet utility, novelty, and non-obviousness requirements as discussed below, and additionally:
  - must disclose how to make and use the invention; must disclose so as to enable any person skilled in the art to make and use the invention; must set forth the best mode contemplated for carrying out the invention
  - must include at least one claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as the invention
- Consists of Specification, Claims, Abstract of the Disclosure, Drawings, ancillary data ***in the proper form***

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What is a continuing patent application?

- A patent application which follows, and claims at least partial priority to, an earlier-filed (parent) patent application
- Most retain parent's filing and expiration dates
- Must be filed ***while*** parent application is pending
- Relates to different claims than parent

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

What is a divisional patent application?

- An application having ***only*** originally filed claims which were not previously examined (often resulting from a "restriction requirement")
- Based on Specification identical to the parent
- A divisional application claims an invention distinct from the claims of its parent application
- A divisional application is NOT, and cannot be, tied to the parent application by a "Terminal Disclaimer"

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What is a continuation patent application?

- An application having claims which were not previously on file, but are fully supported by the parent application's disclosure
- A continuation application usually claims an invention similar to the claims of its parent application
  - Continuations sometimes claim "same invention, different scope"
- Often tied to the parent application by a "Terminal Disclaimer"

What is a continuation-in-part (CIP) patent application?

- An application having claims not previously filed or disclosed
- Based in part on different disclosure (substantive "new matter") not in the parent
- A CIP application claims an invention distinct from the claims of its parent application
  - NOT tied to the parent application by a "Terminal Disclaimer"
- Often, the CIP claims are an improvement on the claims in the parent
- Has multiple "effective" filing dates

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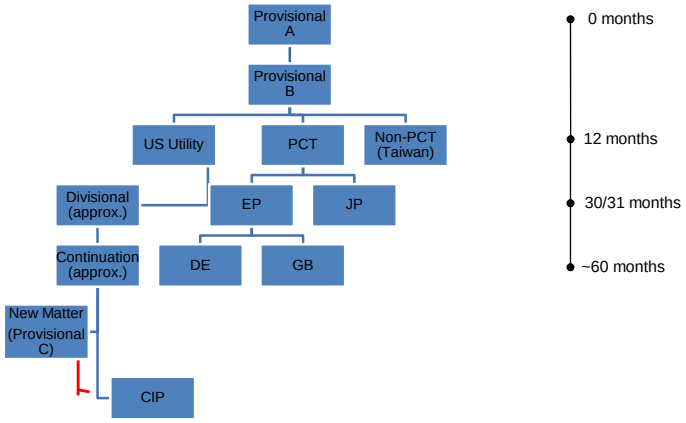
Continued Prosecution Patent Applications

- Means for buying new rounds of examination
- Request for Continued Examination (RCE)
  - May be used with any application filed on or after 6/8/95
  - Same serial number and filing date → minimized delay
- Continued Prosecution Application (CPA)
  - Legacy: only applications filed between 6/8/95 and 5/28/00
  - Same serial number, but new filing date → some delay
- File Wrapper Continuation (FWC)
  - Legacy: only applications filed before 6/8/95
  - New serial number and filing date → much delay

An example of a patent family tree and how priority dates work



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IP Protection Outside the U.S.

- Berne Convention and WIPO Copyright Treaty are two major treaties for the protection of literary and artistic (i.e. copyrighted) works
  - ~60 countries are members
- Madrid Protocol is the treaty that provides for the International Registration of Marks
  - ~80 countries are members
- Patent Cooperation Treaty covers patents
- There is no such thing as an “international patent”, “international copyright” or “international trademark”; each country has its own system for recognizing, granting, and protecting IP

The Patent Cooperation Treaty (PCT)

Clearinghouse function: simplifies and renders more effective and economical the granting of patents by establishing an international system which enables:

- Filing of a single "international patent application" in a single patent "receiving office"
- Filing in one language which is effective at this stage for each member state
- Examination by a single patent office
- International search and examination resulting in reports citing relevant prior art and providing an opinion as to whether the claimed invention meets ***international*** criteria for patentability
- Publication of international applications to facilitate and accelerate access by industry and developing countries to technical information related to inventions and technology

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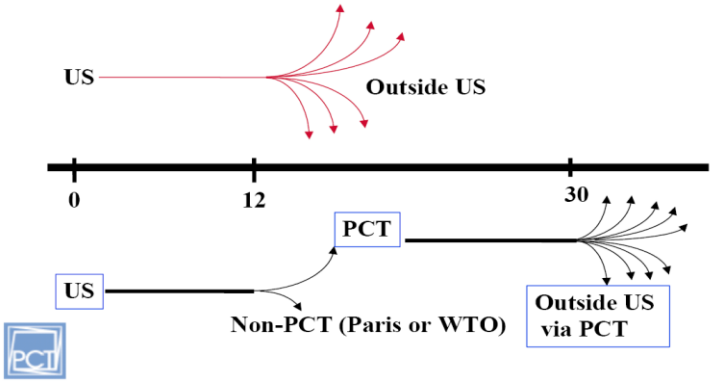
The PCT Timing Effect



Principal objectives of the PCT

- reduce duplication of effort both for applicants and national patent offices
- international cooperation for the filing, searching, and examination of patent applications
- broad adoption (>130 contracting states)
- ***but…*** does not grant "international patents"; granting patents remains exclusively in the national patent offices

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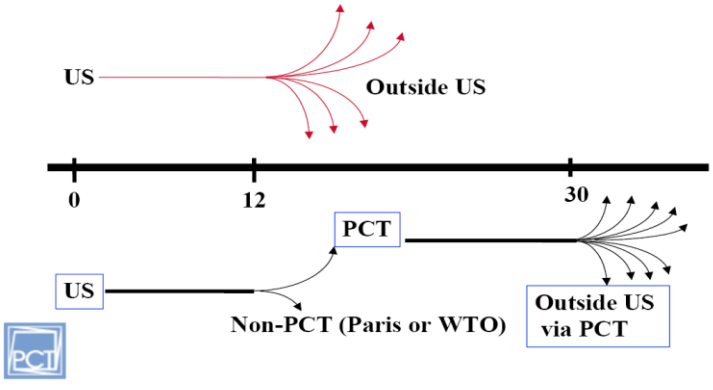
The PCT Timing Effect



European Patent Office (EPO)

- Serves a clearinghouse function in European Union similar to WIPO in relation to the PCT
  - Filing of a single "European patent application"
  - Filing in a single patent office
  - Filing in one of three official languages
  - Examination by a single patent office, ***based on EPO standards***
- Governing body: European Patent Organization (EPO)
- EPO issues a "European Patent" which can then be "validated" in individual countries
- Europe is moving toward a "Unitary patent", but not yet

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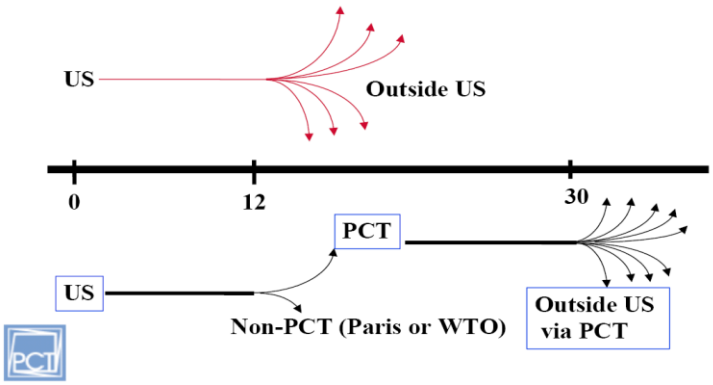
Non-PCT foreign jurisdictions

- Taiwan is the major industrialized nation that is not a PCT member
- Argentina, Chile, and Peru are non-PCT
- Much of the Middle East, parts of Southeast Asia, and most island nations are non-PCT
- For most non-PCT countries, the only entry for patent filing is via the Paris Convention for the Protection of Industrial Property, requiring filing *within one year* of the earliest filing date

The PCT Timing Effect



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Review of Learning Objectives

- ✓ Recognize various types of patent applications and patent strategy
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  - Filing requirements
  - The dual-track system in the US after passage of the AIA
  - Patent Prosecution at the USPTO
  - Defending and Enforcing Patents

Obtaining and Using Patents

- United States Patent and Trademark Office Examination
  - Statutory Requirements for Patentability
  - Filing Requirements
  - Patent Prosecution
  - The dual-track system in the US after passage of the America Invents Act (AIA)
- Defending a patent
- Enforcing a patent

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Conditions of Patentability

The Invention must meet:

- Patentable subject matter requirement
- "New, useful, and non-obvious"
  - Utility requirement
  - Novelty requirement
  - Non-Obviousness requirement
- Sufficient Disclosure requirement

Patentable Subject Matter

US Congress (in Title 35): new, useful, and non-obvious
- Compositions of matter (biotech/chemical/pharma inventions)
- Machines (mechanical inventions)
- Articles of manufacture (electrical/mechanical inventions)
- Processes for making (method inventions)
- Processes for doing ... something (method inventions)
  - e.g. Methods for doing business
- And improvements thereof

US Supreme Court: "Anything under the sun that is made by man" (*Diamond v. Chakrabarty*) and is not too "Abstract" (*Bilski v. Kappos*)

USPTO: Applying the law, and subject to review, ***whatever we determine***

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What Is *NOT* Patentable Subject Matter?

- Laws of Nature (why? lack utility)
  - e.g. Law of Gravity
- Physical phenomena (why? not made by man)
- Abstract ideas (why? lack utility)
  - e.g. $E = mc^2$, Einstein's special relativity equation
  - But... A useful application of an abstract idea can be patentable
- A newly discovered mineral (why? not made by man)
- A new plant found in the wild (why? not made by man)
- Products of Nature (why? not made by man)
  - e.g. naturally occurring DNA

"New, Useful & Non-obvious"

USEFUL

- 35 U.S.C. § 101 Utility requirement
  - The disclosed invention must have at least one specific, substantial, and credible use
  - So, *not* cold fusion, perpetual motion, raw data, laws of nature, computer programs *per se*
  - What is "credible" changes over time; e.g., cancer treatments
  - Exception: specific, substantial, and credible uses of raw data and laws of nature *are* patent eligible

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New, Useful & Non-obvious"

NOVEL/NEW

- § 101/102 Novelty requirement
  - This means that each and every claim limitation, in the proper order if order is relevant, is not found in the "prior art"
  - Prior art is knowledge which is published or generally known before the date of invention/filing and raised during the examination of the patent application
  - Statutory Bars to Patentability: 35 U.S.C. § 102 specifies the combinations of conditions– who, what, where, when– that define what is, and what is not, prior art

35 U.S.C. § 102 (through 3/15/13)

"A person shall be ***entitled*** to a patent unless ..." some combination of conditions exists to defeat patentability

- Found in the prior art?
  - contained in an application for patent, patented, or described in a printed publication
  - (widely) known or used by others (and NOT secret!)
  - in public use or on sale
- Action by whom?
  - Applicant
  - Others
- In relation to what date/event?
  - Patent application filing date
  - Date of Invention (conception; reduction to practice)
- Where invention made/inventors' citizenship?
  - U.S.
  - Foreign country (must distinguish Treaty partners from others)

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35 U.S.C. § 102 (on or after 3/16/13)

"A person shall be ***entitled*** to a patent unless ..." some combination of conditions exists to defeat patentability

- Found in the prior art?
  - (widely) known or used by others (i.e. NOT a trade secret!)
  - contained in an application for patent, patented, or described in a printed publication
  - in public use or on sale
  - otherwise ***available to the public***
- Action by whom?
  - No longer relevant (exception: the inventor's own disclosures)
- In relation to what date/event?
  - Patent application filing date
  - Disclosure by inventor(s) or associated persons
- Where invention made/inventors' citizenship?
  - No longer relevant

Avoid patent-killing events

- General Rule: **Non-privileged Disclosure Kills Patents**
  - U.S. has a one year grace period (post-AIA, limited)
  - Europe and Japan have ***extremely*** limited exceptions
- Advice: use Non-disclosure and Confidentiality Agreements to maintain secrecy
- Advice: file patent applications as early as possible after development
- Option: Trade Secret Protection
  - This is generally not an option in academia

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"New, Useful & Non-obvious

NON-OBVIOUSNESS

- § 103 Non-obviousness requirement
  - Is the subject matter sought to be patented different enough from the prior art? (i.e. non-obvious) Or would the subject matter have been obvious to a person of ordinary skill in the art?
  - ***Combinations*** of published prior art and general knowledge are used to show obviousness
  - Key issue is often this: what are the ***reasons*** to combine prior art references/knowledge to reach the invention?

Sufficiency of the Disclosure

- Enablement – The Specification must enable one 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. The Specification must demonstrate that applicant was "in possession" of the invention

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Organization of a patent application

(1) Title of the invention
(2) Cross-reference to "related" applications*
(3) Statement regarding federally sponsored research or development*
(4) The names of the parties to an applicable joint research agreement*
(5) Reference to an appendix submitted on a compact disc having a "Sequence Listing," a large table, or a computer program listing--and an incorporation-by-reference of the material on the compact disc*
(6) Background of the invention (including the state of the art)
(7) Brief summary of the invention (proper form: based mostly or exclusively on only the independent claims)
(8) Brief description of the drawing(s)*
(9) Detailed description of the invention
(10) A claim or claims
(11) Abstract of the Disclosure
(12) Appendix of sequence listings, large tables, or computer program listings*
(13) Drawings*

*if applicable

Inventorship

- The term “inventor” is an individual that contributes in whole or in part to the conception of the invention on a claim by claim basis.
- Persons that contribute solely to the reduction of the invention to practice are not considered inventors under patent law, unless the reduction to practice itself is novel.
- Inventorship is not determined by percent contribution of effort.
- Inventorship is not the same as authorship in a journal article.
- Incorrect listing of inventors can be the basis of invalidating an issued patent.

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Bayh-Dole, Stevenson-Wydler Acts

- Grant support, if federally funded, ***must*** be included in a patent application in a Statement of Federally Sponsored Research

Example: “This invention was made with government support under (identify the contract) awarded by (identify the Federal agency). The government has certain rights in the invention.”

The Dual Patent System Post-AIA

See AUTM's "AIA in Practice for Technology Transfer Professionals" for more detailed information

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Through March 15, 2013

- First to invent system
- Could "swear behind" a prior art reference
- "Full" 1 year grace period covered "equivalents"
- Filing initially in inventors' name(s) was required
- Small entity fees (50%)

Post-March 16, 2013

- First inventor to file
- Cannot "swear behind" a prior art reference
- Limited grace period does not cover "insubstantial changes or only trivial or obvious variations"
- Can now file in institution's name
- Microentity fees (75%)

Post-AIA Practice Tips

- "Don't cross the streams"-March 16, 2013 is critical date

➢ Segregate "old" and "new" subject matter

- Applications under first to file system:
  a. Subject to more prior art
  b. Cannot swear behind third party references
  c. Subject to post grant review procedures

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Resources

- USPTO policies, procedures, guides, tools and manuals:
  http://www.uspto.gov/patents/resources/index.jsp#heading-1
  - Patents Guidance (problem avoidance)
  - Tools & Manuals (how to...)
  - Links to electronic resources
  - Office of Patent Training (OPT) - Training Materials
- Nonprovisional (Utility) Patent Application Filing Guide:
  http://www.uspto.gov/patents/resources/types/utility.jsp
- Process for Obtaining a Utility Patent:
  http://www.uspto.gov/patents/process/index.jsp

The USPTO – Patent Prosecution Overview

- Patent application filed
- Application formalities check
- Invention Classification
- Assignment to a Group Art Unit ("GAU")
- Assignment to a Primary Examiner
- Office Actions and Responses
- Examination "Counts"
- The role of the Supervisory Patent Examiner ("SPE")
- The use of Examiner Interviews
- Quality Control
- Patent Allowance

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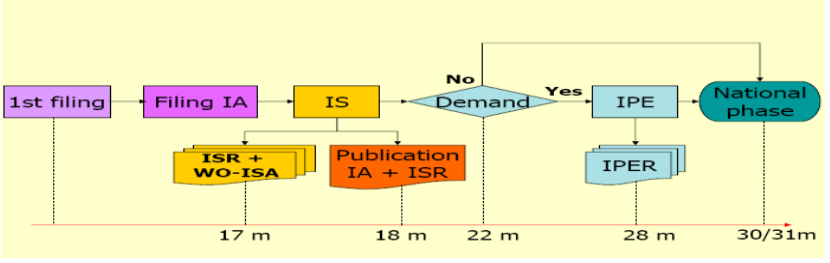
The USPTO – Patent Prosecution Overview

Time Periods, Events, Cost ranges:

- Invent, Search, File Application ($6000-$50,000)
- 1-2 mos.= Serial Number; file any missing parts ($0-500)
- 16-30 mos.=USPTO Search/Restriction ($0-1000)
- 18-36 mos.= First Office Action on the Merits ($0-1000)
- 21-42 mos.= Interview, Response, Final Rejection, QC ($2000-$15,000)
- 24-46 mos.= Notice of Allowance, Pay Issue and Publication Fees ($1500-3000)
- 28-50 mos.= Grant ($300)

PCT Timelines



IA= International Application
IS(R)= International Search (Report)
IPE(R)= International Preliminary Examination (Report)
WO= Written Opinion (now called Preliminary Report on Patentability: IPRP)

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Defending and Enforcing Patents

Post-grant administrative actions

- Review of Examination within the USPTO
  - Reissue
  - *Ex parte* [from or by one party] reexamination
  - *Inter partes* [between parties] reexamination
  - Supplemental Examination (New)
- Appeals to the Patent Trial and Appeal Board (PTAB)
  - Post-grant review (New)
  - *Inter partes* review (New)

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Basic patent litigation issues

- Who can bring the action? (“standing”)
- What is the proper court? (“venue” and “jurisdiction”)
- Substantive issues: Is the patent
  - Valid?
  - Enforceable?
  - Infringed?
- What type of infringement is alleged?
- What are appropriate damage type(s)?
- Appeals

Helpful websites

- USPTO.GOV
  - http://www.uspto.gov/main/patents.htm
  - http://www.uspto.gov/web/patents/guides.htm
- World Intellectual Property Office (WIPO)
  - http://www.wipo.int/portal/en/resources_innovators.html
  - PCT Applicant's Guide
    - http://www.wipo.int/pct/guide/en/index.html
- AUTM.NET
- LES.ORG (US and Canada; International)

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Patenting 101 2014

Lee Heiman

Thank You!

Questions? Comments?

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Aug. 31 – Sept. 1, 2015

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