Patent and Publish Without Perishing

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

Dr. Chris Corbett
Director of Intellectual Property
• 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.
**WHAT IS A PATENT?**

**WHAT DOES A PATENT PROTECT?**

- 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: natural products or laws, abstract ideas, correlations, mental steps…)

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 depend upon all of the public disclosure knowledge available before the “priority date” of the invention, e.g., the filing date of the patent application.

Relevant prior art is a public disclosure made either by others, or by you.
WHAT CONSTITUTES A "PUBLIC DISCLOSURE"?

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 or is not made only to other OU employees, is a public disclosure.

The relevance of a public disclosure 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

• Publications (hard copy or online)
• Awarded 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, Symposium, and Conference presentations
- Departmental Seminars (if open and publicized)
- Thesis/Dissertation defenses, if not closed
- Non-confidential conversations, meetings, or phone calls, 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

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

2. Patent application filed *within one year* of a public disclosure by you:
   - US rights *retained* (the one year “grace period”), but
   - Foreign rights *lost*.

3. **WORST CASE** – No patent application is filed *within one year* of public disclosure: *Both* US and foreign rights are *lost*. *No patent*.

4. Take home message: Submit your invention disclosure to OTD at least 3 months before any public disclosure by you.
• 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.
“New Ventures and Conflicts of Interest”

- How to launch a Venture
- Do I have a Conflict of Interest?
- How do I manage it?

Presented by Jim Bratton, Exec. Director, OTD

Nov. 29, 2016, Norman campus, Memorial Union, 12-1 PM
Nov. 30, 2016, OKC, HSC, BRC 103, 12-1 PM