



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.

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: 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.

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** (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:

NEXT UP IN THE “INNOVATION TO IMPACT” 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