Patentability
PROCEDURE

- ODU IP policy requires inventions developed through substantial use of ODU property, or in the course of employment at ODU, prior to public disclosure
  - Disclose early, disclose often.

- What happens?
  - David Einfeldt/Khaled Abul-Hassan review disclosure
  - We will have a meeting to discuss the state of the art, make sure we have a good understanding
  - We develop a search request, send it to inventor for verification
  - Send out for an outside/non-biased search
  - We will make a determination regarding a likelihood of patentability
    - If likely to obtain a patent we will file application
    - If not likely to obtain a patent we will Release to inventor if ODU decides not to pursue.
Intellectual Property

- Patents
  - Invention
- Trademarks™
  - What you call it, your company or product name
- Copyright ©
  - Creative works, sculptures, songs, paintings
- Trade Secrets
  - Not patentable, but provide a competitive advantage
Patent - what is it?

- The right to EXCLUDE others from making, using, offering for sale, or selling the invention in the United States, or importing the invention into the United States.

- No such thing as an international patent, a patent only protects you in the jurisdiction which grants the patent.
  - There are treaties which allow for reduces application cost, but once reviewed under a treaty each country must be individually sought and application/grant fees paid for the particular jurisdiction.
Patent – Different Types of Applications

- Design Patent
  - 14 years or patented
  - Only products the exact look of a design
  - Very narrow

- Plant Patent
  - 20 years
  - No naturally occurring plants, only for asexually created hybrid plants
  - Very narrow

- Utility Patent
  - 20 years of enforceability
  - Broader protection on principles of utility, how something operates, can be as broad as the written claims will allow.
Utility Patents Two types

- Two types (Provisional, non-provisional)
  - Provisional (cheap, easy to prepare, and provide “Patent Pending” status)
    - Really only a place holder, only save a date for you for what is contained in the disclosure
    - Only last one year, as an application, never grant, only meant to be something to claim priority to in a full application
    - Never reviewed or examined
    - No formality requirements
  - Non-Provisional Utility (Expensive, require significant effort to prepare)
    - Full patent application
    - Will be examined
    - Formal claims can ultimately be issued into an enforceable patent
    - Application provides “Patent pending” status, granted patent provides “Patented” status which can be enforceable in court
Non-Provisional Utility Standards for allowance

- Must be directed toward a patentable Statutory category
  - processes, machines, manufactures and compositions of matter
  - Not be directed toward a judicial exception

- Have Utility
  - Solve a problem

- Be New/Novel
  - Exact same thing must not be out there already
  - What you invented is defined by the claims in the application

- Be Non-obvious
  - This is the difficult standard to define
Statutory Categories defined by USC 101

- Processes
- Machines
- Manufactures
- Compositions of matter
- Any Improvement Thereof
- No Judicial Exceptions
  - Laws of nature
  - Natural phenomena
    - Living things (actually can patent living things that are artificially made "anything under the sun made by man"), but not if they occur naturally
    - Claim the methods of manufacturing, using, etc. try to stay away from claiming the living thing itself
  - Products of nature
  - Scientific principles
  - Disembodied concepts
  - Disembodied mathematical algorithms and formulas
  - Business Models
Judicial Exceptions

- Just because something involves an exception does not render it unpatentable, but must rise above the unpatentable exception alone
  - A method with additional steps above just applying an algorithm
  - Claim as a whole must amount to significantly more than the exception itself

- Must not preempt the use of the principle.
Abstract Ideas

- Patents do not cover results, they cover the “how” or method of achieving the results or the features of a machine or thing which can be utilized to achieve particular results.
- Can often be explained by reciting a result without the “how”.
- *Alice Corp. Pty. Ltd. v. CLS Bank Int’l,*
  - A mere instruction to implement an abstract idea on a computer "cannot impart patent eligibility."
  - "[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention."
  - "Stating an abstract idea 'while adding the words "apply it"' is not enough for patent eligibility."
  - "Nor is limiting the use of an abstract idea to a particular technological environment."
Non-obvious

- Subjective
  - KSR v Teleflex allows examiners to state any reason as a motivation for combining references, no longer need to find explicit stated reasons

- High standards
  - More than a simple logical leap based on what is already known
  - More than a mere combination of known things to obtain an expected result
Enablement

- The constitution gives Congress 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.

- Patents represent a bargained-for right in exchange for teaching the public, so that in the future, science can utilize human ingenuity for advancement rather than reinventing the wheel.

- 35 USC 112 requires “enablement”. As the purpose of patents is to give a temporary monopoly in exchange for full disclosure, this provision essentially requires you to disclose sufficiently that a person having skill in the art could use your disclosure to re-create the invention.
  - Can’t hold anything back.
Claims

- Claims are painfully specific
- Set the boundaries of what the invention “is”
  - Requires some context
  - Must contain what differentiates your invention from what already exists
So what happens?

- ODU decides to file for protection
  - Office of research oversees preparation of a patent application (myself or outside counsel)
  - Wait until the patent office picks it up
  - Overcome any issues, formality/obviousness/ make any required arguments.
    - Depends on the research agreement and field of invention, may be outside company pursuing, outside counsel, or myself (David Einfeldt)

- ODU decides to release
  - Depends on whether there was federal funding
    - If so, Office of Research will issue a formal release of ODU interest
    - Fed Govt. must be petitioned for ownership rights
      - Happens fairly often
    - If NO Fed Funding, we issue a formal release of ODU interest
    - Still represents state property, Office of Research will make a recommendation to the State regarding reasons behind release;
Invention Disclosure Submission

Sponsorship Check

Federal

State

Industrial

Report to sponsor(s)
File Provisional Application

Sponsor receives 6 months option,
-Pays for patent filing,
-Negotiates a license

Validity/Freedom to Operate analysis
(Professional legal firms)

+ve

-ve

Release of Rights

Licensing

+ve

IP Firm drafts appl.

-ve

File Utility Appl.

USPTO/WIPO

No

Yes

In house-Patent Agent drafts appl.

Intellectual Property