

# Intellectual Property FAQ

## **When should I disclose an invention to the ORTT?**

Complete and [submit an Invention Disclosure Form](#) for any discovery you believe is new, useful, and non-obvious to one "skilled in the art"; that is, knowledgeable of the publically available information that would enable the practice of your invention.

## **Who is considered an inventor?**

Inventorship has a strict legal meaning under US law. Only persons who have independent, conceptual contributions to an invention (and/or its reduction to practice) are legal inventors. So, for instance, one who is carrying out the instructions of another is not considered an inventor. Note also that the authors of a published paper may not be the same as the inventors. An invention must be patented in the name of exactly all its legal inventors, that is, without including any unqualified person nor excluding any qualified person. Incorrect determination of inventors is a basis for invalidating a patent.

Invention disclosures often report work in which more than one person has participated. In such cases, legal principles are used to determine which of such co-workers qualify as legal co-inventors. The most important consideration in determining inventorship is initial conception of the invention. The courts have ruled that unless a person contributes to the conception of the invention, that person did not make an inventive contribution, and is not an inventor. Conception has been defined as "the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice". An invention is complete and operative "if the inventor is able to make a disclosure which would enable a person of ordinary skill in the art to construct the apparatus without extensive research or experimentation". This is called "enablement". In practice, the conceptual contributions which make up an invention typically consist of several inventive steps, possibly contributed by different persons.

In the patent application, each claim represents one of the essential conceptual elements which make up the invention. The legal test of inventorship is whether a co-worker has made an original, conceptual contribution to at least one of the claims of the patent.

For practical purposes in making an invention disclosure, include those who seem to qualify as inventors based on the foregoing information, understanding that the final determination will be made in consultation with patent counsel if a patent application is filed.

## **How should I protect my invention?**

### **Prior to filing a patent application**

- Keep thorough and accurate notebooks. Having accurate records of daily experiments which lead to your discovery will be invaluable should you ever need to prove your inventorship. Having witnesses regularly date and sign your notebooks makes them even more credible. (In contrast to most other countries, the United States recognizes "first to invent" rather than "first to file" for patenting purposes.)
- Never discuss the details of your discoveries with anyone outside of the university. A good rule of thumb is to share what your discovery will do, but not how it does it.
- Execute a Non-Disclosure Agreement if you need to discuss enabling details of your work with individuals outside the university. **Having a discussion without this agreement in place can destroy your ability to seek foreign patent protection, and limits the time you have to file for a U.S. patent to 12 months.** Contact us if you need help putting this agreement in place.
- Execute a Material Transfer Agreement if you need to send or receive materials outside the university. **This will clearly define your intellectual property rights** regarding discoveries made with these materials. Again, contact us if you need help putting this agreement in place.

### **After a patent application is filed (but prior to its publication by the patent office)**

- If you need to disclose information about your invention to potential licensees, consider providing a copy of the patent application without the enabling claims included.

**Please note: The following general information concerning patents is extracted from US PTO website at <https://www.uspto.gov/patents>**

## **What Are Patents, Trademarks, Servicemarks, and Copyrights?**

Some people confuse patents, copyrights, and trademarks. Although there may be some similarities among these kinds of intellectual property protection, they are different and serve different purposes.

### **What Is a Patent?**

A patent for an invention is the grant of a property right to the inventor, issued by the United States Patent and Trademark Office. Generally, the term of a new patent is 20 years from the date on which the application for the patent was filed in the United States or, in special cases, from the date an earlier related application was filed, subject to the payment of maintenance fees. U.S. patent grants are effective only within the United States, U.S. territories, and U.S. possessions. Under certain circumstances, patent term extensions or adjustments may be available.

The right conferred by the patent grant is, in the language of the statute and of the grant itself, “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. What is granted is not the right to make, use, offer for sale, sell or import, but the right to exclude others from making, using, offering for sale, selling or importing the invention. Once a patent is issued, the patentee must enforce the patent without aid of the USPTO. There are three types of patents:

- 1) Utility patents may be granted to anyone who invents or discovers any new and useful process, machine, article of manufacture, or composition of matter, or any new and useful improvement thereof;
- 2) Design patents may be granted to anyone who invents a new, original, and ornamental design for an article of manufacture; and
- 3) Plant patents may be granted to anyone who invents or discovers and asexually reproduces any distinct and new variety of plant.

### **What Is a Trademark or Servicemark?**

A trademark is a word, name, symbol, or device that is used in trade with goods to indicate the source of the goods and to distinguish them from the goods of others. A servicemark is the same as a trademark except that it identifies and distinguishes the source of a service rather than a product. The terms “trademark” and “mark” are commonly used to refer to both trademarks and servicemarks.

Trademark rights may be used to prevent others from using a confusingly similar mark, but not to prevent others from making the same goods or from selling the same goods or services under a clearly different mark. Trademarks which are used in interstate or foreign commerce may be registered with the USPTO. The registration procedure for trademarks and general information concerning trademarks is described on a separate page entitled “Basic Facts about Trademarks” (<https://www.uspto.gov/trademarks>).

## **What Is a Copyright?**

Copyright is a form of protection provided to the authors of “original works of authorship” including literary, dramatic, musical, artistic, and certain other intellectual works, both published and unpublished. The 1976 Copyright Act generally gives the owner of copyright the exclusive right to reproduce the copyrighted work, to prepare derivative works, to distribute copies or phonorecords of the copyrighted work, to perform the copyrighted work publicly, or to display the copyrighted work publicly. The copyright protects the form of expression rather than the subject matter of the writing. For example, a description of a machine could be copyrighted, but this would only prevent others from copying the description; it would not prevent others from writing a description of their own or from making and using the machine. Copyrights are registered by the Copyright Office of the Library of Congress.

## **What Can Be Patented**

The patent law specifies the general field of subject matter that can be patented and the conditions under which a patent may be obtained.

In the language of the statute, any person who “invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent,” subject to the conditions and requirements of the law. The word “process” is defined by law as a process, act or method, and primarily includes industrial or technical processes. The term “machine” used in the statute needs no explanation. The term “manufacture” refers to articles that are made, and includes all manufactured articles. The term “composition of matter” relates to chemical compositions and may include mixtures of ingredients as well as new chemical compounds. These classes of subject matter taken together include practically everything that is made by man and the processes for making the products.

The Atomic Energy Act of 1954 excludes the patenting of inventions useful solely in the utilization of special nuclear material or atomic energy in an atomic weapon 42 U.S.C. 2181 (a).

The patent law specifies that the subject matter must be “useful.” The term “useful” in this connection refers to the condition that the subject matter has a useful purpose and also includes operativeness, that is, a machine which will not operate to perform the intended purpose would not be called useful, and therefore would not be granted a patent. Interpretations of the statute by the courts have defined the limits of the field of subject matter that can be patented, thus it has been held that the laws of nature, physical phenomena, and abstract ideas are not patentable subject matter.

A patent cannot be obtained upon a mere idea or suggestion. The patent is granted upon the new machine, manufacture, etc., as has been said, and not upon the idea or suggestion of the new machine. A complete description of the actual machine or other subject matter for which a patent is sought is required.

### **Novelty And Non-Obviousness, Conditions For Obtaining A Patent**

In order for an invention to be patentable it must be new as defined in the patent law, which provides that an invention cannot be patented if: “(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent,” or “(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country more than one year prior to the application for patent in the United States . . .”

If the invention has been described in a printed publication anywhere in the world, or if it was known or used by others in this country before the date that the applicant made his/her invention, a patent cannot be obtained. If the invention has been described in a printed publication anywhere, or has been in public use or on sale in this country more than one year before the date on which an application for patent is filed in this country, a patent cannot be obtained. In this connection it is immaterial when the invention was made, or whether the printed publication or public use was by the inventor himself/herself or by someone else. If the inventor describes the invention in a printed publication or uses the invention publicly, or places it on sale, he/she must apply for a patent before one year has gone by, otherwise any right to a patent will be lost. The inventor must file on the date of public use or disclosure, however, in order to preserve patent rights in many foreign countries.

Even if the subject matter sought to be patented is not exactly shown by the prior art, and involves one or more differences over the most nearly similar thing already known, a patent may still be refused if the differences would be obvious. The subject matter sought to be patented must be sufficiently different from what has been used or described before that it may be said to be nonobvious to a person having ordinary skill in the area of technology related to the invention. For example, the substitution of one color for another, or changes in size, are ordinarily not patentable