Intellectual Property and Patent Law
Objectives

- Understand what intellectual property is, its value, and potential uses

- Learn to be on the lookout for potentially patentable innovations

- Know how to protect your IP or your institution’s IP from premature disclosure to outsiders
Intellectual property in one minute

• Patents
  • For useful methods and objects – useful inventions
  • Granted by government – term is 20 years from filing

• Trademarks
  • For things (words, sounds, colors) that consumers mentally connect with a particular seller
  • Granted by use and by government – term is (potentially) forever

• Copyrights
  • Covers “expression,” not ideas (e.g., source code, manuals, etc.)
  • Granted upon creation – can register with government
  • Can last essentially forever, thanks to Disney’s lobbyists

• Trade Secrets
  • You get it by keeping business information secret
  • Can last forever (Coke formula)
Purposes of the patent system

To reward inventors and thereby encourage innovation

To make it economically feasible to invest money in research and development

To provide a technology “database” available to all; e.g., to discourage accumulation and hoarding of trade secrets
Quid pro quo

The bargain:

The patentee gets the right to exclude others for a limited length of time.

The public gets full disclosure of the inventor’s best ideas about how to make and use the invention.
Value / uses of a patent

• Licensing / revenue generation

• Tangible asset reflecting value of R&D

• Legitimacy value (credibility for sales and funding)

• Exclude competitors

• Defensive – cross-licensing
Identifying potential inventions

• In general, any innovation or development that *solves a problem* or *provides an advantage* (enhanced functionality, better, cheaper, faster, easier to use, increased efficiency, fewer components, etc.) is potentially patentable
  • New products, services, or methods
  • Delta between successive versions
  • Good patents are hard to get around
The "High-Five" patent

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**Abstract**

An apparatus for simulating a "high-five" including a lower arm portion having a simulated hand removably attached thereof, an upper arm portion, an elbow joint for pivotally securing the lower arm portion to the upper arm portion, and a spring biasing element for biasing the upper and lower arm portions towards a predetermined alignment.

12 Claims, 3 Drawing Sheets
A method of swinging on a swing is disclosed, in which a seat positioned on a standard swing suspended by two chains from a substantially horizontal arc bound induces side to side motion by pulling alternately on one chain and then the other.
Method of Exercising a Cat

United States Patent

Inventors: Kerin T. Amiss, 215 S. Pickett St., #301, Alexandria, Va. 22304; Martin H. Abbott, 1049 Assembly Dr., Fairfax, Va. 22030

Filed Nov. 2, 1993

Abstract

Method of exercising a cat consists of directing a beam of invisible light produced by a hand-held laser apparatus onto the floor or wall or other opaque surface in the vicinity of the cat, thus moving the laser so as to cause the bright pattern of light to move in an irregular way fascinating to cats, and any other animal with a chase instinct.

4 Claims, 1 Drawing Sheet
What sorts of things are patentable?

Products
- devices, chemical compositions, chemical formulations, isolated cells, polypeptides, nucleic acids, antibodies, transgenic animals, assay kits, nanoparticle compositions, conjugates

Methods
- diagnostic/prognostic methods, medical treatments, purification methods, screening assays
Patent eligibility in United States

35 U.S.C. § 101

Four categories of patent-eligible subject matter: processes, machines, manufactures, and compositions of matter.

The Courts

Exceptions are “laws of nature,” “natural or physical phenomena,” and “abstract ideas.”
Other requirements for patentability

- Useful
- Novel
- Non-obvious
- Enabled
- Described
Protecting your institution’s IP

• Try to file before any disclosure outside your institution (e.g., scientific publication, abstract presentation, product or press release, trade show)

• Use non-disclosure agreements (NDAs) where feasible
Seek help when in doubt

- Reach out to appropriate personnel at your institution (e.g., intellectual property managers, technology transfer personnel, etc.)

- Get advice from a patent attorney

- Earlier is better!
Myth #1

“My patent gives me the right to make, use, and sell my invention.”

In fact, a patent is just a right to block others from exploiting the invention.

It is not an affirmative right to practice the invention.

- The invention may be illegal to use (a bomb?) or to sell (an unapproved drug?).
- Others may own patents that also cover some aspect of your invention.
Myth #2

“Merely having a patent will stop others from copying my patented product.”

A patent does not automatically stop anyone from doing anything. It is just a “ticket to court.” You must enforce the patent in court to hold others accountable for infringing behavior.

Fear of liability for infringement may stop some competitors.
Myth #3

We didn’t copy anyone’s product, so we don’t infringe anyone’s patents.”

Lots of inventions are patented, but not on the market

Whether you know about a patent or not, you can be liable for infringing it

Before investing in a new product, consider doing a “freedom to operate” analysis to identify potential third party patents
Myth #4

“I’ve never seen this product on the market, so it must be patentable.”

To qualify for patent protection, the invention must be new, useful, and non-obvious.

Whether or not a similar product is “on the market” is not the test.
Myth #5

“To get a patent, all I need to do is fill out a form and send it to the government.”

Claims must be carefully drafted to encompass the invention both broadly and narrowly, yet to exclude the prior art.

Specification must disclose how to make and use the invention and provide support for the claims as originally written and as they may be amended in the future.

After filing, there can be years of back-and-forth with the patent office examiner.
Final thoughts

• Your ingenuity will make you and your institution successful

• Don’t undervalue your contributions
Questions?
Thank you!

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