Forms and Types of Intellectual Property

Intellectual Property = Asset

• Patent—new, useful inventions/designs
• Copyright—original expressions secured in a concrete means
• Trademark—distinguish source of goods
• Servicemark—distinguish source of services
• Trade Secret—company secrets
Patent Outline

• What is a patent
• Types of patents
• What can I patent
• Value of a patent
• Anatomy of a patent
• Can I get a patent
• Filing strategies
  ➢ Provisional
  ➢ Utility
What is a Patent?

• A patent is a form of contract

• Inventor agrees to disclose “fully” the invention to the public and meets certain “patentability tests”

• In exchange, the Government grants a “limited monopoly” on the invention to the inventor for a “limited time”
What is a Patent?

Patents grant their owner the right to “exclude others” from:

- Making the invention
- Using the invention
- Selling the invention
- Offering the invention for sale
- Importing the invention
Types of Patents?

- Provisional—“Place Holder”
- Utility—Novel technology, products, or methods
- Design—Protects the way an article looks
- Plant—Protects asexually reproduced plants
What Can Be Patented?

• Processes
  ➢ Do not need to know why the process works

• Products
  ➢ An assembly of parts that are put together
  ➢ Anything man-made

• Compositions of matter

• New uses of any of the above
What Cannot Be Patented?

- Laws of nature
- Physical phenomena
- Abstract ideas
When Can a Patent Be Valuable?

- Barrier to entry—market advantage
- Licensing Revenue
- Security for investors
- Security for loans
Anatomy of a Patent

• Specification

- Describes the invention
- Discloses how to make it and use it
- Reveals the best way known to the inventor of practicing the invention
Anatomy of a Patent

• Claims
  ➢ Points out and distinctly describe what the applicant regards as the invention

• Drawings
  ➢ Can be schematics, flow charts, sequence listings, etc.
Usefulness/Utility (35 USC § 101)

Does the invention really do anything and, if so, does it solve the problem it was designed to solve?
Patentability Tests and Statutory Bars

Novelty (35 USC § 102)

“A person shall be entitled to a patent unless:”

The claimed invention was disclosed in the prior art.

Prior Art:

• Prior patent/publications
• Prior public use
• Prior commercial offers to sell
• Prior sales
• Prior conversations
Patentability Tests and Statutory Bars

Non-obviousness (35 USC § 103)

Even if new and novel, would the claimed invention have been obvious to one skilled in the art at the time of the invention?
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most clearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out the invention.
How to Obtain a Patent

First step: file the patent application

Types of Patents

- Provisional patent
- Utility patent
- Design patent
- Plant patent
Provisional Patent Applications

• Place holder

• Is not examined
  ➢ Formal drawings
  ➢ Multiple inventions
  ➢ Does not require claims

• Expires one year from the filing date

• Minimal filing fee
Provisional Patent Applications

Advantages:

• Inexpensive to file

• Gives the inventor(s) one year to determine commercial viability of the invention

• Pushes patent expiration date by one year
Provisional Patent Applications

Disadvantages:

• Provisionals require the same amount and type of information as non-provisionals. An incomplete application may give a false sense of security.

• Add to the overall cost of patent procurement

• Delays issuance of patent
Utility Applications

• Can result in a U.S. patent

• Examined for compliance with U.S. patent law

• Examination takes ~2-4 years (can be expedited in some cases)

• Published 18 months after the earliest filing date

• Filing fees: $165 + (small entity), $330 + (large entity)
What one needs to know about intellectual property

- Who owns what?
- How difficult is it to get a patent/trademark/copyright?
- How likely is it that I will get a patent/trademark/copyright?
- How long will it take?
- How much will it cost?
- How do I know if my idea is worth pursuing?
- Who will commercialize my intellectual property?
- What is the financial benefit?
Who owns what?

- Intellectual property created as a result of employment (i.e., performing research) at the University belongs to the University. Intellectual property created via non-research activities carried out by faculty, staff, and students is also owned by UA if University resources were used.

- Intellectual property created without the use of University resources or personnel, or by persons not employed by the University, is owned by the inventor(s).

- Conferring ownership to UA is done via an assignment of invention—without an assignment the University makes no claims to the intellectual property and CANNOT help in protection/commercialization activities.
How difficult is it to get a patent/trademark/copyright?

- **Patents** require a tremendous amount of work, most of which you are not required to do. The bulk of the work is coordinated by OTT and handled by outside patent attorneys. What you have to do is describe your invention in sufficient detail so that one skilled in the art could read the description and make or use the invention.

- **Trademarks** require minimal work. All that is required is that you show that the trademark/servicemark is actually in use in commerce and that it is not confusingly similar to other marks.

- **Copyrights** require almost no work at all. By law the act of writing, speaking, or composing a creative work creates a ‘common law’ copyright in it.
How likely is it that I will get a patent/trademark/copyright?

- **Patent:** The patenting process is rigorous enough that most applications that get filed will likely issue in some form. Before filing, a thorough ‘prior art’ search is performed to help insure that the invention is novel and non-obvious. If prior art is discovered that is significantly similar, you will be unable to apply for patent protection.

- **Trademark:** A search of registered trademarks is done to preclude “confusing similar” marks. Provided your mark is not simply descriptive but is capable of secondary meaning, it will likely grant.

- **Copyright:** If you want to register your work, you simply pay a fee, and you are done. The uniqueness of the work is not examined—this is left to litigation. A registered copyright permits you to seek some limited extra damages in a suit against an infringer.
How long will it take?

• Patent: A few months to a few years. After an inventor prepares an “enabling disclosure,” an outside patent attorney prepares either a provisional patent application or a non-provisional application. The issued patent confers substantial rights for 20 years from the date of application filing.

• Trademark: Typically takes about one year. A search of registered trademarks is done to preclude “confusingly similar” marks. The life of the trademark is indefinite as long as it is used in commerce.

• Copyright: If you want to register your work, you simply pay a fee, and you’re done. The life of a copyright varies depending on when it was created—currently it is 90 years from the date of creation.
How much will it cost?

- Patent: A typical patent search costs $1,000-3,000, and the patent application and prosecution costs $15,000-30,000.
- Trademark: A typical trademark search costs $500-1,500 and the filing fee is approximately $350. Trademarks are also subject to annuity payments.
- Copyright: A common law copyright has no cost. A registered copyright costs approximately $50 plus any applicable legal fees and is paid for by UA.
How do I know if my idea is worth pursuing?

- All creators/inventors believe that their “babies are beautiful,” and sometimes they are! However, the marketplace is responsible for determining the actual value of a creation/technology, and the value is very difficult accurately predict.

- By definition, all patents are novel and useful. However, the vast majority of issued patents never generate any income!

- A vital function of OTT and AIME is to work with the creators/inventors to assess the market value of ideas before moving forward. If we believe in the potential value of a creation/invention, we put significant energy and resources behind it.
Questions
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