A Faculty Guide to Protecting Inventions

Intellectual Property Overview

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Contents of this presentation are for educational discussion purposes only. NOT to be considered legal or patent advice.
National Academy of Inventors (NAI)

Mission and Goals

- Recognize and encourage inventors with patents issued from the U.S. Patent and Trademark Office;
- Enhance visibility of academic technology and innovation;
- Encourage disclosure of intellectual property;
- Educate and mentor innovative students; and
- Translate inventions of its members to benefit society

http://www.academyofinventors.org/about.asp#history
What is Intellectual Property (IP)?

A product of the mind or intellect, in a concrete or abstract form, in which one can assert ownership rights.
Technology Innovation Model Generates IP

Technology Innovation Model

- Business Plan
- Source Code
- Name / Graphics / Logos
- Trademark
- Copyright
- Patent
- Trade Secret

Engineering Model; Hardware; Software; iOS; Apps

- Algorithms
- Flow Charts
- Launch Time Table
- Marketing
- Methods, Processes, or Techniques

Copyright
Trademark
Trade Secret
Patent
Trade Secret
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What is a Patent?

- Grant issued by the U.S. Patent and Trademark Office (USPTO)
- Gives the right to exclude all others from making, using, selling or importing for sale
- Within the United States, its territories and possessions
- Up to 20 years from filing date
3 Types of Patents

**Utility Patent**
- Protects the function or “utility” of the invention. Term is 20 years from effective filing date.

**Design Patent**
- Protects the “ornamental design” or appearance. Term is 15 years from grant.

**Plant Patent**
- Protects distinct and new varieties of plants. Term is 20 years from effective filing date.
America Invents Act (AIA)

2013 - U.S. Patent system changed

• **Previously:** “First To Invent” gets the patent

• **Now:** “First Inventor to File” gets the patent

➤ An inventor must file the invention as quickly as possible before another inventor files for the same invention.
Patentability – What is patentable?

New, useful and non-obvious:

- Machine (Apparatus)
- Article of Manufacture
- Composition of Matter
- Process (Method)

A useful improvement on any of these
Patentability – What is NOT Patentable?

NOT Patentable:

- Laws of nature
  - $E=mc^2$; Gravity

- Natural phenomena
  - $H_2O$; Salt

- Abstract ideas
  - algorithm, method of computation or other general principle
  - when taken as a whole, the claimed invention must have additional limitations that amount to significantly more than the abstract idea

(Alice Corp. v. CLS Bank International)
Novelty and Prior Art

Prior Art – No patent if already:

- Patented;
- Described in a printed publication;
- In public use;
- On sale; or
- Otherwise available to the public before the effective filing date (date of first application for patent)

Except:

- 1-year “grace period” for inventors in US only
- Foreign – Any disclosure is “absolute bar” to patentability

Use Non-disclosure Agreements!
Non-obvious

Invention may be obvious, even if not identical to prior art, if:

The differences between the claimed invention and the prior art are such that...

✓ The invention as a whole
✓ would have been obvious before the effective filing date
✓ to a person having ordinary skill in the art.
Patent Application (Non-Provisional)

Patent Specification

- Written description of the invention
- Full, clear, concise, and exact
- Describes manner and process of making and using invention
- Enables a person skilled in the pertinent art to make and use it

Claims

- Particularly pointing out and distinctly claiming the subject matter

Drawing

- Where necessary for understanding the invention

Cost is high

- $10-15K / patent plus maintenance fees
Provisional Patent Application

• Provides a lower-cost first patent filing in the United States

• Establishes an effective filing date (but only for the technical details you include in the Provisional Patent Application)

Danger! You must include as much technical detail as possible in the Provisional Application, or the Provisional filing date might not be effective for additional technical detail in the Non-Provisional.

• Difficult balance between putting everything in Provisional vs. filing as quickly as possible.
IP Ownership and IP Rights

The creator of IP is the presumptive owner with all rights…

*Unless*, there is an *agreement to the contrary*, for example:

- Employment agreements (university employment) may assign ownership and rights
- Shop right interests may imply a license to use by employer
- CSULB has a policy on “IP: Inventions and Discoveries”

This is not legal advice. I refer you to the CSULB website:

What Is a Copyright?

- Exclusive legal right

- Protects original works of authorship
  - Given to an originator or an assignee
  - To print, publish, perform, film, or record literary, artistic, or musical material, and to authorize others to do the same

- Protects *creative expression* of ideas, but NOT the ideas, themselves

- Must be fixed in a tangible medium of expression
How To Obtain a Copyright?

A copyright automatically comes into existence the moment you create a work of authorship and fix it in a tangible medium

- Pen to paper; Type a line of code; Record sounds; Shoot video

Don’t need to register, but filing with the U.S. Copyright Office provides some important additional benefits

- Ability to sue for Infringement, Statutory damages, Attorney fees

Relatively inexpensive to register

- $65.00 / application
- $35.00 / application if file on-line
Rights in Copyright

Exclusive rights to (or authorize others to):

• Reproduce in copies or phonorecords (audio recordings)
• Dictate who can copy
• Modify or prepare a derivative work
• Distribute/sell copies
• Publicly perform or display a work

Exceptions: Fair Use

http://copyright.gov/fair-use/index.html
Resources

- U.S. Copyright Office…[www.copyright.gov](http://www.copyright.gov)
- CA Civil Code 3426-3426.11…[www.leginfo.ca.gov](http://www.leginfo.ca.gov)

- State and Local Bar Associations
  - CA State Bar Association…[www.calbar.ca.gov](http://www.calbar.ca.gov)
  - LA Bar Association…[www.lacba.org](http://www.lacba.org)
  - OC Bar Association…[www.ocbar.org](http://www.ocbar.org)

- Libraries
  - Long Beach Law Library *(West Ocean Blvd, Long Beach)*
  - LA Law Library *(1st Street, LA)*
  - OC County Law Library *(North Flower Street, Santa Ana)*