

Patent and Perish?



How to Patent, Publish and Survive!

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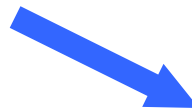


Products of Scientific Research

Research Results

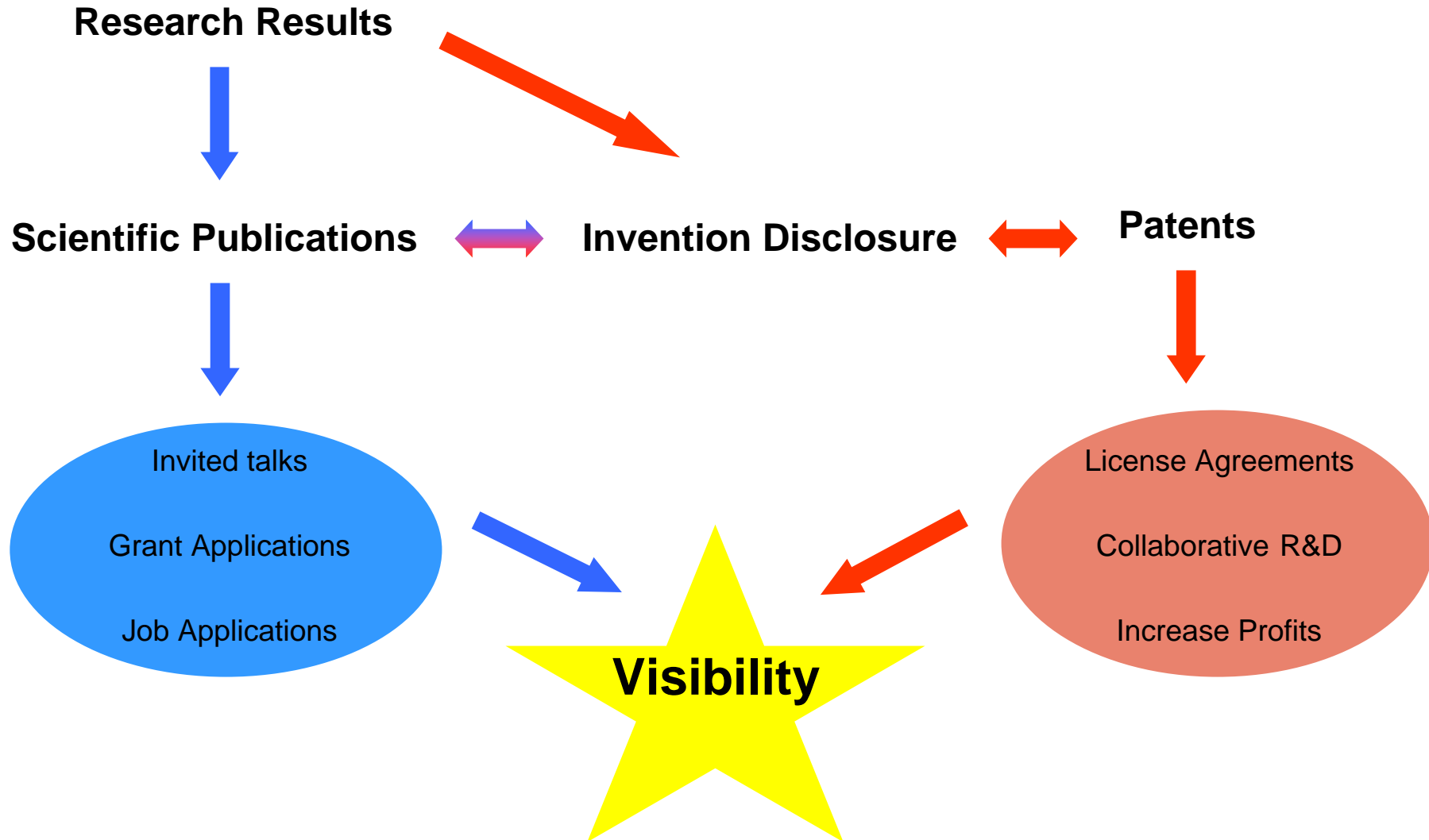


Scientific Publications



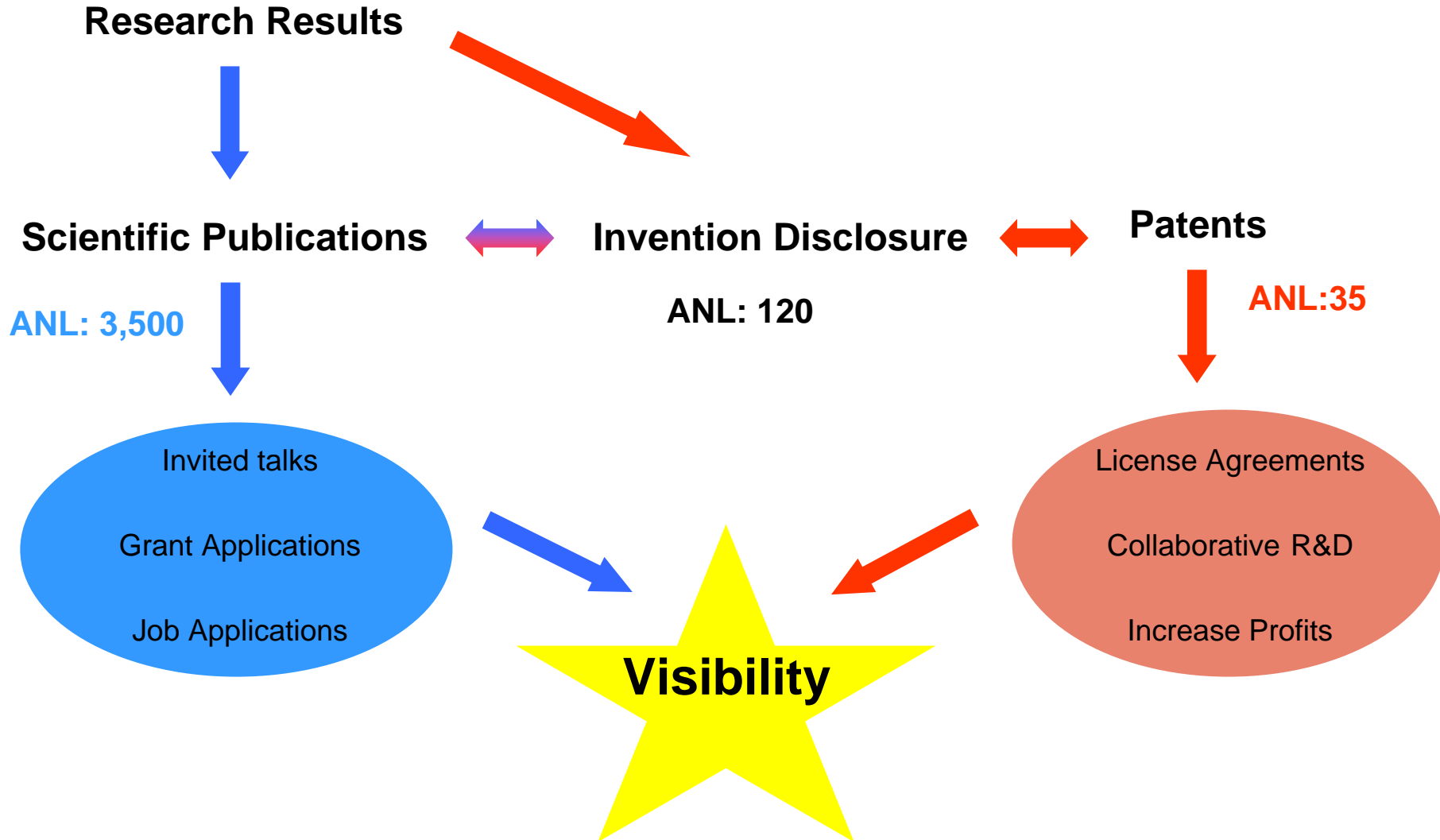


Products of Scientific Research





Products of Scientific Research





To Publish or Patent, that is the question



Publication of research results in peer reviewed journals and oral presentations at conferences are the major ways in which academic researchers inform the scientific community of their new discoveries. Wide use of Scientific Citation Index for scientific impact of a scientists work.



Identification of an invention within research results and the subsequent decision to file a patent application can delay the publication of research results in peer reviewed journals and oral presentations. Cannot immediately announce new results without some loss of patent rights.



What is a Patent?



- A patent is a right granted to an inventor by the Government after examination of the patent application.
 - The inventor is granted for a limited term the right to exclude others from making, using or selling his invention in consideration for disclosing the invention to the public
 - Patent law promotes scientific progress by offering inventors exclusive right for a limited period as an incentive for their inventiveness and research efforts
 - United States Code Title 35 - Patents



What is patentable?

- Five 'statutory classes' of things which are patentable
 - *Processes*
 - *Machines*
 - *Manufactures*
 - *Compositions of matter*
 - *Improvements of any of the above*
- Invention must be useful i.e. must have utility
- Invention must be novel
- Invention must be non-obvious

What is meant by **novelty**?

(35 USC § 101)



What is the USPTO meaning of Novelty?

A person shall be entitled to a patent unless -

102 (a) Actions: **By Others**

The invention was known or used by others in this country, or patented in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent

102 (b) Actions: **By Inventor or another**

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 date of application for patent in the United States.

(35 USC § 102a & b)

USPTO concept of 'Printed Publication'



Traditionally, used to mean patents, scientific journal articles, reference texts etc. that were really 'printed'

However.....

..disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it and recognize and comprehend therefrom the essentials of the claimed invention without need of further research or experimentation..

In re Wyer, 210 USPQ 790 (CCPA 1981).

Concept of **Non-Traditional Publication**

Useful to think of a **Public disclosure**



Public Disclosures

Conference presentations

- Abstracts
- Poster Presentations
- Oral Presentations

Scientific journals

- Scientific journals (web abstracts)
- e -Journals

Grant applications

- Unpublished results
- Collaborators

Theses and dissertations

- Unpublished results

Other

- Web pages
- Discussions with industry

In U.S

Inventor

12 month grace period

Rest of world

No grace period

Absolute novelty





Conference presentations

Abstracts

- Often required before the meeting
- Often published on web in proceedings
- Try and keep info in abstracts very general!

Posters

- Only put up at the meeting
- May include 'printed' info for distribution to delegates
- Usually quite specific in nature (one to one Q&A)
- Fine to say that you cannot discuss full details at this time

Oral Presentations

- Only presented at the meeting
- May be printed for distribution to delegates
- Usually quite specific in nature (Q & A session)
- Fine to say that you cannot discuss full details at this time



Scientific Journals

Reviewers

- Usually required to sign confidentiality agreements. This is not considered a public disclosure.

However

- Be aware that the paper (or even pre-prints) may be published on the web before the print edition is circulated.
- If the paper contains a potentially valuable invention please indicate that in the applicable section of the publication clearance form ([before](#) submission to a journal)
- If foreign IP rights are a concern contact LEG or OTT to discuss possible implications [before](#) submission for clearance or to a journal.
- The same applies to e-Journals

Theses and Dissertations



Unpublished Data

Theses and Dissertations often contain data that we (as scientists) assume is 'unpublished' as it has not been submitted to a peer-reviewed journal...

However

To the USPTO they are 'printed publications', accessible to the public, and are therefore a public disclosure as of the date the material was indexed as available on a Library shelf.





Grant Applications

Grant applications submitted to a Federally funded granting agency are **held in confidence** by the agency and those individuals reviewing the grant until the grant is funded.

However

- Once funded, the Federal agency may make info contained in the application publicly available.
 - NIH – CRISP database info re funded grants
 - NTIS – US DOC – Project description abstract
- Remember that the Federal granting agencies are subject to FOIA
 - If you need to include the hottest invention since the internal combustion engine in your grant proposal please ask LEG/OTT for a ‘patent hold’ legend that is included on those pages that contain patentable information. When faced with a FOIA request, the funding agency will then at least contact you before giving out these pages.
- Collaborators
 - May need to think whether a confidentiality agreement is appropriate



- **Web Pages: Group or personal web sites/blogs**
 - Great for visibility. Keep specific information to a minimum.
 - USPTO will consider them as a publication
 - If in enough detail will start the 12 month clock
- **Industry/Commercial entities**
 - If you need to discuss the hottest invention since the internal combustion engine with others please contact OTT/LEG for a confidentiality agreement! (aka Non-disclosure Agreement, NDA, CDA)
 - These documents are signed by ANL's LEG department and a representative of the company. They allow full disclosure of what is in the invention, but do not start the 12 month clock.
 - A record of who owns what at the time of the meeting



In Summary.....

- Publication and dissemination of research results is of key importance to building the visibility of Post-docs.
- ANL researchers are required to report inventions to LEG
- If you think that your research is something that may have commercial potential and that could be patentable please file an invention or software report electronically at:

<http://www.techtransfer.anl.gov/internal/tools-training/software/inv-softreport.html>

Every effort will be made to allow you to publish, while fulfilling DOE reporting requirements

- After you have publicly disclosed your work there is a **12 month grace** period during which you **may still file a U.S. patent**.
- However, unless you had a NDA in place you have **lost all foreign rights**





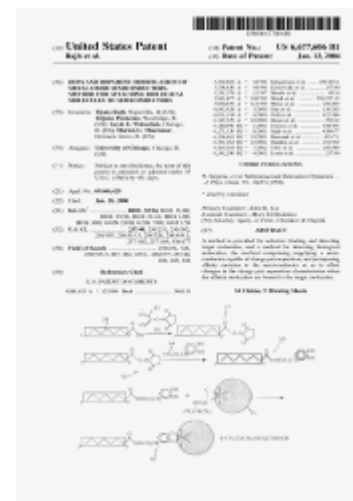
Just to prove it.....



Publish

Tijana Rajh (CHM)

Patent



And Survived!

