

Frequently Asked Questions:

The Office of Intellectual Property & Sponsored Research

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See below for answers to the Frequently Asked Questions.

If a specific question is not addressed, please contact the OIPSR office at ext. 3035 or via email, ott@bnl.gov .

A1. A patent is essentially a grant by the federal government to an inventor of the right to exclude others from making, using, or selling his or her invention. Patents are necessary for successful commercial developments of inventions. While there are several types of patents, generally the one of interest to you will be a utility patent. Utility Patents are granted for machines, articles of manufacture, compositions of matter, and processes (or any useful improvement of these) that are novel, useful, and non-obvious. Patent protection is governed exclusively by the scope of the claims of the issued patent. Patent protection is only effective in the country in which the patent has issued.

A2. The three most important characteristics of a patentable invention are novelty, non-obviousness, and usefulness. Generally speaking, an invention is **useful** if it has a useful purpose, is operable, and is of some benefit to society. A **novel** invention is one that is not known to the public. In general, an invention will NOT meet the novelty requirement if:

- It was known to the public.
- It was described in a publication.
- It was used publicly, or offered for sale prior to the application filing date.

In addition, the invention must be **non-obvious**. This means that the invention must not be obvious to one of ordinary skill and creativity in the art and is a determination made by the U.S. Patent and Trademark Office by comparing the invention to the “Prior Art” (such as publications in the field of the invention, including your own). To help meet this requirement, make sure the patent attorney or agent working on the application has a good understanding of the invention and provide him or her with any prior art you know. This will allow them to draft the patent application so that the invention is clearly distinguishable from prior art.

A3. A copyright is a form of intellectual property that grants its holder the sole legal right to copy their works of original expression; such as a literary work, movie, musical work or sound recording, painting, computer program, or industrial design. It is possible to protect software that you have developed by getting a copyright or releasing it under an Open Source Software License. To obtain a copyright registration or to release software under an Open Source Software License, you must first contact the Office of Intellectual Property.

A4. OIPSR seeks and receives records of inventions from researchers, decides whether or not to elect title for inventions, files patent applications, markets patents to industry, and negotiates and administers license agreements. In addition to these tasks, OIPSR oversees patent prosecution of patent applications, records income and disbursements, and prepares yearly reports to the Department of Energy (DOE).

A major effort of OIPSR is to find companies possessing the capability, interest and resources to develop technologies from the stage of infancy into maturity as useful products. Other functions of OIPSR are to negotiate material transfer agreements (MTAs), non-disclosure agreements (NDAs), CRADAs, and Work for Others Agreements. OIPSR is a resource to BNL regarding intellectual property issues.

For more information on these agreements, see
http://www.bnl.gov/techxfer/SponsoredResearch/about_partnerships.asp

A5. Part of the Mission of the Department of Energy is the transfer and commercialization of technology. The key aspects to the function of OIP are inventors who are motivated to engage in the patenting process and the creation of licensing relationships by partnering with industry. This model is used at the University level and is now emulated by federal laboratories.

A6. This section of the office provides the means for Brookhaven National Laboratory (BNL) to obtain the necessary authorizations and funding to perform research and development services for non-DOE federal agencies (e.g., the Department of Defense, Department of Agriculture, the Department of Homeland Security, the Food and Drug Administration, the Department of Health and Human Services, National Institutes of Health, National Science Foundation, Nuclear Regulatory Commission or the Environmental Protection Agency) and non-federal entities (e.g., the New York State Office of Science, Technology and Academic Research (NYSTAR, which includes Centers for Advanced Technology (CAT)), or New York State Energy Research and Development Authority (NYSERDA). Sponsored Research authorizes interagency agreements (proprietary or non-proprietary) or grants, which can be beneficial and appropriate in important research areas of other Federal agencies that simultaneously advance the goals of BNL.

Provided below are links to a range of Federal and Non-Federal agencies, including direct links to important sections for persons seeking research grant support:

- Grants, see <http://www.bnl.gov/techxfer/wfo/era.asp>
- Federal agencies http://www.bnl.gov/techxfer/wfo/wfo_federal.asp
- Non-Federal Proposal Information Questionnaire, <https://sbms.bnl.gov/SBMSearch/ld/ld05/ld05e291.doc>
- Small Businesses, <http://www.bnl.gov/techxfer/SponsoredResearch/sba.asp>

A7. Technology Transfer is the process of developing practical applications for the results of scientific research. For instance, a research result may be of scientific and commercial interest, but patents are normally only issued for practical processes, and so someone -- not necessarily the researchers -- must come up with a specific practical process. Another consideration is commercial value.

The process to commercially exploit research varies widely. It can involve licensing agreements or setting up joint ventures and partnerships to share both the risks and rewards of bringing new technologies to market. Other corporate vehicles, e.g. spin-outs, are used where the host organization does not have the necessary will, resources or skills to develop a new technology. Often these approaches are associated with the raising of venture capital (VC) as a means of funding the development process.

A8. A Record of Invention is an important legal document that starts the patent process by identifying various aspects of the invention proposed to be patented.

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(Note: a record of invention is NOT a patent application.) This document briefly describes the invention and its achieved advantages, date of conception, and novel features. A record of invention also includes (but is not limited to) design sketches, funding source, related or referenced publications or patents, laboratory notebook entries, information on the contributing collaborators, and public disclosure information. The Record of Invention is very important because it officially starts the process of expert review of the invention to determine whether patent protection will be sought.

A9. Prior to filling out a Record of Invention, contact the Office of Intellectual Property. We will review the invention with you and determine if it is the proper time to submit a formal Record of Invention. Typically, since the Record of Invention helps to start the patent process, the sooner it is submitted, the better. Proper care in its early and complete preparation will save important time and inconvenience in the future.

For Record of Invention Form and Guidelines, go to:

<http://www.bnl.gov/techxfer/forms.asp>

A10. Upon receipt of a Record of Invention, OIP evaluates this document for: patentability (novel, useful, non-obvious) and commercial value (i.e., will companies want to use your invention?). If OIP makes the determination that the invention is Patentable and of Commercial Value, then OIP will prepare and file a patent application. OIP will then find a company (s) to license the invention and make products using or embodying the invention. This commercial license is then negotiated by OIP to include terms to fund sponsored research and to accommodate the license fees and royalties.

A11. OIPSR handles patent applications that are submitted to the United States Patent & Trademark Office (USPTO) for consideration of patent status. These **patent applications** are diverse in subject matter, and their technical briefs/press releases are viewable on the OIPSR webpage.

See the Licensing Opportunities at <http://www.bnl.gov/techxfer/>

Also, the USPTO has a database of patents and patent applications which is easily accessible for searching. To access the USPTO database, see

<http://www.uspto.gov/patft/index.html>.

A12. Disclosure of an invention is any public announcement or discussion, which includes written abstracts; talks, presentations, seminars, posters; publications (including electronic publications and postings); news releases; emails; and use of the invention in public. Disclosure will limit the right to obtain a patent. Until a patent application has been filed, you have to be very careful what you say, send in an e-mail, present in public, post on the Internet, or publish regarding the invention. There should be no public disclosure of an invention until a patent application is filed. Even if you have filed a Record of Invention, contact the Office of Intellectual Property prior to giving seminars, providing copies of papers, abstracts, overheads, or making any public disclosure.

A13. This is a common and complicated question to answer, so one should read this answer carefully. The simple answer to this question is yes, you can publish your work before an invention is patented. An inventor is permitted to obtain a patent if the patent application is filed within one year of the date of publication which first disclosed the invention.

A major distinction must be made between a patent and a patent application. These two distinct terms should not be used interchangeably because they convey separate meanings. A patent application does not carry the same protection provided by a patent because a patent excludes others from making, using, or selling an invention. In order to “patent” an invention, an inventor must file a patent application. This is a document filed by the Office of Intellectual Property to the United States Patent & Trademark office which fully and publicly discloses the information of the invention (if there are questions about the meaning or examples of **public disclosure** please refer to Question 13). When a patent application is filed, it does NOT mean that you have a patent. Be aware that the patent process can take months or even years to finalize, but also know that once a patent application is filed then an inventor can publicly disclose the information of an invention in a publication.

A14. . The Office of Intellectual Property & Sponsored Research is located in Building 185 within Brookhaven National Laboratory, and questions can be answered directly by email (lnziger@bnl.gov), telephone (631)-344-3035, or by contacting the appropriate staff member listed below.

A15. From the moment you think you have a new invention until the filing of the patent application; it is important to follow the proper procedures. The first step is maintaining accurate research records, which is a critical step in the patent process. Below is just a short list of guidelines for maintaining research notes that must be followed:

- Notebooks must have sewn bindings and sequentially numbered pages.
- Make sure all entries are original, handwritten in ink, and do not skip any pages.
- Make corrections by drawing a line through the incorrect material so that it is still legible.
- Sign and date each page upon completion. Have a witness read, sign, and date each experiment upon completion.
- Record everything you do, as you do it, including small calculations, changes to procedure, and results.
- Record your hypotheses as they form the basis of the conception of an invention.
- Avoid disparaging commentary or other characterizations of the data in your notebooks.

Patent Licensing Responsibilities, Benefits and Guidelines for Laboratory Notebooks can be found at:

<https://sbms.bnl.gov/SBMSearch/ld/ld12/ld12d331.htm>

<https://sbms.bnl.gov/SBMSearch/ld/ld12/ld12d421.htm>

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