

PUBLISH AND YOUR PATENT RIGHTS MAY PERISH

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SYMPOSIUM ON WHAT CHEMISTS NEED TO
KNOW ABOUT INTELLECTUAL PROPERTY

DIVISION OF CHEMICAL INFORMATION
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COMPLEX SUBJECT

- CONSTITUTIONAL CHARTER
 - “To **promote** the Progress of Science and **useful Arts**, by **securing for limited Times** to Authors and **Inventors the exclusive Right** to their **respective Writings and Discoveries**”
- LEGISLATION SINCE 1790
- FREQUENT RECENT CHANGES IN LAW – 1995, 1999, CURRENT BILL
- MANY COURT CASES
- FULL EMPLOYMENT FOR PATENT LAWYERS

OUTLINE

- BRIEF PATENT TUTORIAL
- PROBLEM AREAS
 - Publication
 - Presentation
 - Use in public or known
 - Sold or offered for sale

PUBLIC POLICY BEHIND PATENTS

- **RIGHT TO EXCLUDE OTHERS FROM MAKING, USING , SELLING, IMPORTING FOR LIMITED PERIOD OF TIME**
- **IN RETURN – PUBLICIZE THE INVENTION**
- **PROMOTES INNOVATION**
- **NOT CLASSIC MONOPOLY**

A PATENT IS ANY USEFUL PRODUCT OF HUMAN INGENUITY

- **PROCESS OR METHOD**
- **MACHINE**
- **MANUFACTURE OR APPARATUS**
- **COMPOSITION OF MATTER**

A PATENT IS NOT

- SOMETHING OCCURRING IN NATURE OR LIVING THING
 - But human ingenuity applied to article of nature or living thing may be
- PRINCIPLE OF SCIENCE
- TRANSLATION OR ALTERNATE LANGUAGE

SPECIAL CASE OF COMPUTER PROGRAMS

- AT FIRST NO – MERE TRANSLATION OR ALTERNATE LANGUAGE
- LATER – OK IF IT ASSISTS IN DOING SOMETHING PATENTABLE
- MORE RECENTLY – BROADENED TO INCLUDE “BUSINESS METHODS” – AN ALGORITHM TO MAKE INVESTMENT DECISIONS.
- QUESTION – ARE ALL DECISION TOOLS BUSINESS METHODS?

REQUIREMENTS FOR A PATENT

- PATENTABLE SUBJECT MATTER
- USEFUL
- NOVEL – NO ONE REFERENCE CAN ANTICIPATE THE INVENTION
- NOT OBVIOUS TO ONE ORDINARILY SKILLED IN THE ART – A COMBINATION OF REFERENCES

REQUIRED PARTS OF A PATENT APPLICATION

- **WRITTEN DESCRIPTION**
- **ENABLEMENT**
- **BEST MODE**
- **CLAIMS**

NOVELTY IS LOST IF

- Prior publication, someone else, before you invented
- Your invention was:
 - published
 - presented
 - used in public or made known
 - sold or offered for sale
- You abandoned the work
- You are not the inventor
- One year grace period in US – future uncertain

PRIOR PUBLICATION BY SOMEONE ELSE

You Can Prove You Invented Before The Publication
(Simple Declaration)

You Can Prove Prior Invention To A Patent Or
Application (Interference Proceeding)

Both Of These May Disappear In Current Legislation

PUBLICATION BY YOU – THE BIG PROBLEM

- **PUBLICATIONS INCLUDE**
 - Articles
 - Abstracts
 - Electronic distribution
 - Thesis when cataloged

PUBLICATION BY YOU – THE BIG PROBLEM

■ TESTS

- Is invention enabled
- Publication available to public
- Good news – peer review is not a problem
- Bad news – if not disabled by anticipation, may be by obviousness analysis
- Bad news – if published part of invention, the rest may lose economic value

PRESENTATION BY YOU – ANOTHER PROBLEM

- SHOULD BE SAME CRITERIA IF FOUND OUT
- NOT HELPFUL
 - Abstracts
 - Handouts
- POSTERS?
 - Recent case
 - Brevity hurts

OTHER PROBLEM AREAS

- **USED IN PUBLIC OR KNOWN**
 - If in completed, enabled form
 - Not if public experimentation
- **SOLD OR OFFERED FOR SALE**
 - Concrete discussions between marketers, not experimental collaborations

WHAT YOU CAN DO

- IN US – ONE YEAR GRACE PERIOD
 - But out of luck internationally
 - May not survive legislation, treaty
- BEST STRATEGY – CONSULT WITH BOSSES OR YOUR ATTORNEY FIRST AND FILE APPLICATION BEFORE PUBLIC DISCLOSURE
- PROVISIONAL APPLICATIONS
- NON-DISCLOSURE AGREEMENTS IF COLLABORATING

SELECTED INFORMATION RESOURCES

- YOUR ORGANIZATION'S PROCEDURES MANUALS
- US PATENT AND TRADEMARK OFFICE – WWW.USPTO.GOV
- WHAT EVERY CHEMIST SHOULD KNOW ABOUT PATENTS, 2nd ED – ACS COMMITTEE ON PATENTS & RELATED MATTERS
- UNDERSTANDING CHEMICAL PATENTS: A GUIDE FOR THE INVENTOR, 2nd ED., MAYNARD & PETERS, 1991 – WWW.AMAZON.COM & 3rd ED IN PREPARATION
- WHAT IS A PATENT?, 2nd ED., AMERICAN BAR ASSOCIATION

HOW TO GET IN TOUCH WITH ME

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