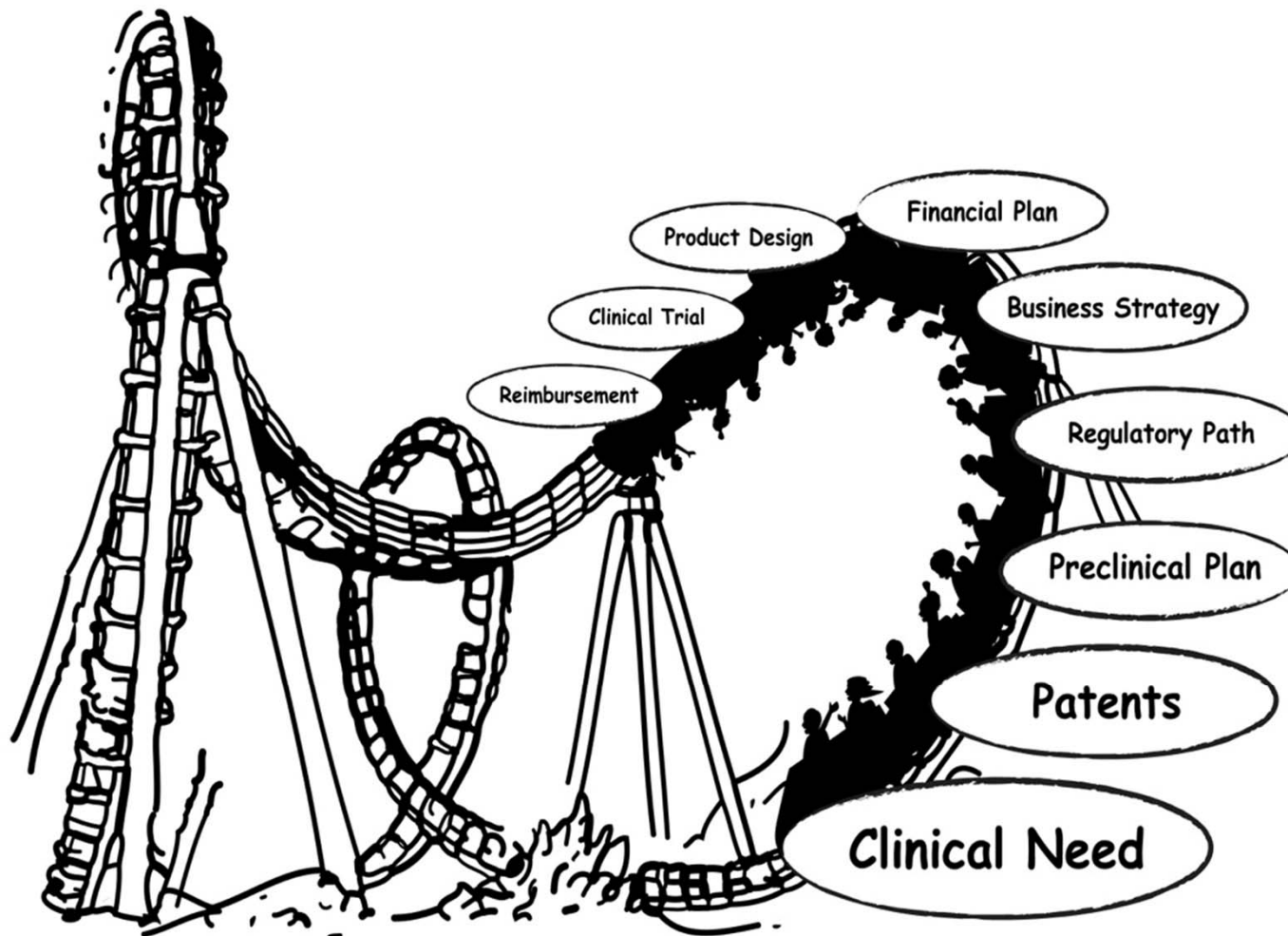


Translational Medicine Symposium 2013: *The Roller Coaster Ride to the Clinic*



Meet the
Entrepreneurial Faculty Scholars

Translational Medicine Workshop:
Intellectual Property

U TECHNOLOGY
VENTURE DEVELOPMENT
THE UNIVERSITY OF UTAH

Translational Medicine Symposium 2013

Intellectual Property

Bench to Business to Bedside:
The Roller Coaster Ride to the Clinic

Introductions

- Moderator:
 - Amelia Smith Rinehart (University of Utah)

- Panelists:
 - Rachel Slade (Stoel Rives)
 - Jonathan Baker (Innoventius)

Discussion Topics

- The Value of Intellectual Property
- Obtaining Key Patents
 - Your Invention and the Prior Art
 - Building a Strong Disclosure
 - US Patent Examination
 - Ownership Interests
- The Changes to US Patent Law under the America Invents Act
- Trademark, Copyright and Trade Secrets

The Value of Intellectual Property

- Patents
 - Useful inventions protected for 20 years from filing.
- Copyrights
 - Creative expressions protected for 70 (or 95 or 120) years plus the life of the author.
- Trademarks
 - Marks used in commerce protected as long as in use.
- Trade Secrets
 - Valuable secrets protected from misappropriation by state law as long as secrecy remains.

Obtaining Key Patents: Your Invention

- Identify all inventors.
- Make an invention disclosure in accordance with the U [Patent and Inventions Policy 7-002](#).
- Consider planning for reduction to practice (complete invention, recognizing it works).
- Refrain from any public disclosure until, at least, invention evaluated by TCO and next steps formalized.

Your Invention and the Prior Art

- The benefits of searching for prior art:
 - Build confidence in novelty/nonobviousness of your invention.
 - Justify the time and expense of your efforts.
 - Be more aware of the “state of the art”.
 - Map technology development.
 - Identify target companies in subject area (acquisition or licensing).
 - Identify leading inventors as potential colleagues for joint research .

Your Invention and the Prior Art

- More benefits of searching for prior art:
 - Learn new directions in which to take your own inventions.
 - Support a more robust disclosure.
 - Educate yourself on technical and legal practices to enhance your relationship with your patent professionals.

Your Invention and the Prior Art

- Some roadblocks to finding prior art:
 - Not all references are publicly available on the Internet.
 - A majority of information on the Internet is not available through public search engines like Google!
 - The most powerful, comprehensive databases are often extremely expensive and not always available.
 - Patents may use unfamiliar legal and technical jargon.

Your Invention and the Prior Art

- Conducting an effective search
 - [USPTO](#), [Google Patents](#) and [Espacenet](#) databases are good, **free** search tools.
 - Do **extensive** and **intensive** searching.
 - Including forwards and backwards searches from relevant patents, keyword *and* US/Int'l classification searches
 - Be familiar with the terminology used to describe your areas of technology.
 - Use appropriate databases, especially at an academic library such as the U of U, and consult with the subject specialists.

Building a Strong Disclosure

- **Timing** and **content** are (often) everything!
 - Under new law, **when** you file your application becomes even more critical
 - “First-inventor-to-file” instead of “first-to-invent”
 - The application must support your claims to obtain a patent.
 - Must enable PHOSITA to make and use invention.
 - Must demonstrate you were in possession of the invention.

Building a Strong Disclosure

- Timing versus Content...
 - File as early as you can (especially under new system)...
 - But the scope of your disclosure dictates the scope of your exclusivity...
 - Discussion of embodiments that retain, alter or enhance function supports broader exclusivity.
 - Conducting additional studies to obtain this data may delay your priority date!

Building a Strong Disclosure

- Seek counsel from the **Technology Commercialization Office** and its IP Professionals. They will:
 - Search the prior art to evaluate potential success.
 - Recommend an optimal disclosure and filing plan to adequately protect your invention in US and elsewhere.
 - Recommend a commercialization plan for your technology, taking into account key programs and assets.
 - Coordinate (and pay for) patent procurement.

The Decision to Patent Your Invention

- Reality check.
- Important decisions made by team:
 - Is a patent the best way to protect your IP?
 - Is your technology patentable now?
 - What is out there already?
 - What can you afford, and what are your timelines?

US Patent Prosecution

- The name of the game is the claim.
- Expect to wait 1-3 years.
- Expect to be rejected.
 - The examiner interprets claims broadly and has limited time to review files.
- Expect (and plan for) costs.
 - Often the most expensive stage.
 - But your involvement helps reduce costs.

US Patent Ownership

- Default rule: ownership vests in the inventor.
 - Ownership rights may be assigned before or after issuance. (Easier rules under AIA.)
- Employees must assign employment-related inventions to UURF.
 - TCO resources available.
 - Obligation to keep TCO informed.
- Requires careful collaboration.

IP Agreements

- No agreement is perfect...
 - You cannot plan for **all** contingencies but you can protect yourself from **most**...
 - Hindsight is always 20:20.
 - More is not always better.
 - Know when to take risks (and when to be risk-averse).
- Operating Agreements
 - Start off on the right foot.

US Patent Law: Major Changes

- The Leahy-Smith American Invents Act (“AIA”)
 - Signed into law on September 11, 2011.
 - US moves from **first to invent** system to **first inventor to file** system for patents filed on or after March 16, 2013.
- How will this affect technology creators?

US Patent Law: the AIA

1. If two researchers independently invent the same thing, the one who wins the race to the patent office gets the patent.
- Talk to IP professionals **early** and **often!**

U.S. Patent Law: the AIA

2. Your provisional patent applications must be “complete” to obtain the earliest filing date. Complete means repeatable.
- Provide your IP professionals with **all** the data, **early**.

U.S. Patent Law: the AIA

3. Third party disclosures of **your** invention can prevent you from obtaining a patent.
- File a patent application **before** you publish or present at a conference or meeting.

U.S. Patent Law: the AIA

4. Because third parties can prevent you from obtaining a patent, keep detailed records of with whom, when, and what you discuss regarding your IP, and sign/witness lab notebooks regularly.
- If the subject matter of the disclosure is derived from you, it doesn't qualify as prior art.

US Patent Law: the AIA

5. CDAs and JDAs may not fully protect you.
- Clarify the IP situation even with collaborators and potential licensees and, if possible, file patent applications **before** such discussions occur.

Trademarks

- A trademark signals information to consumers about the source of a good or service.
 - Federal, state and common law rights of varying scope.
 - Protects brands, logos, trade dress, and much more.
 - Cannot be generic or functional.

Copyright

- A copyright protects original works from reproduction, adaptation, distribution or public display or performance.
 - Works include literary, dramatic, musical and artistic works such as poetry , novels, movies, songs, architecture, and computer software.
 - Independent creation not liable for infringement.

Trade Secrets

- Information kept confidential that can include a formula, compilation, program, device, method, technique, customer lists or processes.
 - The information must derive independent actual value from not being generally known or readily ascertainably by proper means.
 - The secret holder must use reasonable efforts to maintain its secrecy.

Questions