

From Discovery (Invention) to Patent Application Filing...and Beyond

Peter I. Bernstein
Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza
Suite 300
Garden City, New York 11530
(516) 742-4343



From Discovery (Invention) to Patent Application Filing...and Beyond

First Steps:

- Prepare Detailed Invention Disclosure form as soon as possible with all relevant information, including:
 - drafts of future publications
 - figures
 - data
- Send the detailed Invention Disclosure to the Technology Transfer Office as soon as it is complete



From Discovery (Invention) to Patent Application Filing...and Beyond

First Steps:

- The Detailed Invention Disclosure should be submitted to the Technology Transfer Office before publication or presentation at meetings or conferences to avoid sacrificing possible patent rights
- If a public presentation or publication is planned, you should let the Technology Transfer Office know immediately



From Discovery (Invention) to Patent Application Filing...and Beyond

Prior to Filing:

- Before filing an application, there are several things to keep in mind:
 - Who is an Inventor? Better question, “what” is an inventor
 - Is your invention in the realm of statutory subject matter
 - Is it new
 - Is it non-obvious
 - Can you enable another person to practice the invention successfully, complying with the requirements of 35 U.S.C. § 112
 - Have you complied with the duty of candor, informing the Technology Transfer Office of all relevant prior art



From Discovery (Invention) to Patent Application Filing...and Beyond

Prior to Filing:

- 35 U.S.C. § 101 states that an invention must be of patentable subject matter
 - Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.



From Discovery (Invention) to Patent Application Filing...and Beyond

Prior to Filing:

- 35 U.S.C. § 102 states that a person shall be entitled to a patent unless -
 - (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
 - (b) 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 the application for patent in the United States.



From Discovery (Invention) to Patent Application Filing...and Beyond

Prior to Filing:

- 35 U.S.C. § 103 states that an invention must cover non-obvious subject matter
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.



From Discovery (Invention) to Patent Application Filing...and Beyond

After Filing:

- After filing the application, there are other matters to keep in mind:
 - The time period between filing and issuance of your patent may span years, there are many things you can and must do in the meantime
 - Duty of candor
 - Report improvements new data to TTO
 - Consult TTO regarding potential licensees
 - Publish? Poster? Make contacts in industry.



From Discovery (Invention) to Patent Application Filing...and Beyond

After Issuance:

- After Issuance of the patent, there are new points to focus on:
 - Licensing
 - Who will you license the patent to, are there specific parties in mind
 - What kind of license would be best
 - How will you enforce your patent rights
 - Do you know of anyone practicing your patent
 - Possible licensee?



Thank You

Questions?

Peter I. Bernstein
Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza
Suite 300
Garden City, New York 11530
(516) 742-4343

