INTELLECTUAL PROPERTY (IP) BASICS

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What is IP?

- A product of the intellect that has commercial value, including copyrighted property such as literary or artistic works, and ideational property, such as patents, appellations of origin, business methods, and industrial processes.

- Dictionary.com

- Patents
- Copyrights
- Trademarks
What is Patentable?

- Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvements thereof, may obtain a patent, subject to the conditions and requirements of this title.  
  
  *Section 101 of the US Patent Act*

- So in the United States…
An Invention must be:

- Statutory
  - consistent with the patent law statutes (NOT source code, laws of nature, or non-functional compilations of information)

- Novel
  - Not already known to the public; cannot be publicly disclosed, used, or offered for sale 12 months prior to filing

- Non-obvious
  - not considered an obvious improvement over the prior art “to one of ordinary skill in the art”

- Useful
  - Performs an intended function
Types of Patents

- Provisional Patent
- Utility Patent (Non-Provisional)
- Non-U.S. Patents
- Other types such as Design and Plant Patents
Provisional Patents

- Inexpensive
- Provides a priority date that lasts for 1 year
- Other countries recognize the provisional as a patent application
- Must contain an enabling description of the invention
  - “If I gave a colleague the description, who wasn’t part of this research, could he/she duplicate and/or practice it?”
“Full” U.S. Utility Patents i.e., Non-provisional

- Effective for 20 years from the filing date and costs ~ $12-15K in U.S to file ($30K + total to obtain an issued patent).
- In the US, the first to invent receives the patent and the application must be filed within 1 year of any public disclosures.
- It takes at least 3 to 5 years from initial filing for a patent to issue.
Full” U.S. Utility Patents i.e., Non–provisional

- Parts of a patent application:
  - Specification
  - Drawings
  - Claims (the most important part because they define what subject matter is protected by the patent)

- It takes about 5 years from initial filing for a patent to issue
  - The patent office will send “office actions” that disallow claims requiring either claim amendments or arguments
Most foreign countries are first to file and an application must be filed before a public disclosure.

A patent only protects a product sold in that country (i.e., a US patent only protects products in the US).

Can be expensive to file in each individual country- costs can run up to $100K + for one country.
Patent Cooperation Treaty (PCT) Application:
- Recognized as the “place-holder” for participating countries
- Must be filed within 1 year of the first filed patent application
- Lasts for 30 months from the filing date of the first patent application
- At 30 months, the application must be filed in individual countries patent protection is desired (called the national phase)
What does a patent give the owner?

- The right conferred by a patent grant is the right to exclude others from making, using, offering for sale, or selling the invention in the country the patent is awarded or importing the invention into that country.

- It is an **EXCLUSIONARY** right; it does **NOT** give the owner of the patent a right to practice the material covered by the patent.
Inventorship

- All persons who contributed to the conception of an invention must be listed on a patent.
- Conception is the description in the mind of the inventor of the complete and operable invention.
- Someone who merely constructs an embodiment of an invention is not necessarily an inventor.
QUESTIONS?

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