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