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Building Fences:

CREATING THE RIGHT IP TO PROTECT YOUR MOST IMPORTANT IDEAS

For: XLerateHealth
Nucleus Innovation Park
October 9, 2013
Louisville, KY

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THE PATENT OFFICE'S OBJECTIVES …

- Issue stronger patents
- Increase efficiency
- Increase certainty

… ARE ALSO OUR OBJECTIVES AS ATTORNEYS AND INVENTORS.

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Different forms of Intellectual Property

- Patent - **excludes others** from making, using, selling, etc. the invention for a limited time in exchange for public disclosure of the invention.
- Trade secret - information used in business that provides economic **advantage over competitors who do not know or use it**, and owner of trade secret takes reasonable steps to protect the secrecy (the opposite of a patent in many ways)
- Trademark –protects words, phrases, symbols, designs, etc.; **identifies the source** of the goods or services of one party
- Copyright – protects **original works** of authorship fixed in a tangible medium of expression

A Patent Contains …

- A front page with biographical information

(10) **Patent No.: US 8,448,532 B2**
(45) **Date of Patent: May 28, 2013**

(12) **United States Patent**
Martin et al.

(54) **ACTIVELY COOLED VAPOR PRECONCENTRATOR**

(75) Inventors: **Michael Martin**, Louisville, KY (US); **Kevin Walsh**, Louisville, KY (US); **Julia Aebersold**, Floyd Knobs, IN (US); **R. Andrew McGill**, Lorton, VA (US); **Stanley V. Stepnowski**, Alexandria, VA (US)

(73) Assignees: **The United States of America as represented by the Secretary of the Navy**, Washington, DC (US); **University of Louisville Research Foundation, Inc.**, Louisville, KY (US)

Primary Examiner — David Rogers
Assistant Examiner — Alex Devito
(74) *Attorney, Agent, or Firm* — Wyatt, Tarrant & Combs, LLP; Stephen C. Hall

(57) **ABSTRACT**

An analyte collection system device includes an active area that includes a plurality of perforations extending therethrough. The plurality of perforations are arranged to permit passage of an analyte fluid flow through the microscale plate. A heating element is provided for heating the active area, and a thermal distribution layer is disposed over at least a portion of the active area. For cooling the active area at or below an ambient temperature, an active cooler is provided.

23 Claims, 6 Drawing Sheets

The Parts of a Patent – Cont'd

- The Legal Part (**claims**)

Various features of the invention are set forth in the appended claims.

What is claimed is:

1. An analyte collection device, the device comprising:

a microscale plate having an upper surface and an active area, the active area including a plurality of perforations extending therethrough, the plurality of perforations being arranged to permit passage of an analyte fluid flow through said microscale plate;

etc.

- Patent documents and other publications the application was examined against (pp. 2 and 3 of the '532 patent)
- The Text Description
- The Illustrations

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3 simple, yet key questions for inventors and counsel

- What did you **invent**?
- What **prior art** do you know about?
- How is the invention **different**?

REQUIREMENTS FOR A PATENT

- Written description, enablement, and best mode
- Novel compared to **prior art**
- Non-obvious compared to **prior art**
- Eligible subject matter

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VARIOUS KINDS OF "DISCLOSURE"?

- Issued patent or published application
- Published article
- Presentation
- "On sale"
- Used in public
- "otherwise available to the public" – new language from the America Invents Act (a.k.a. patent reform)

ISSUES and STRATEGIES

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- Maintain confidentiality as much as possible
- Be ready to prepare a complete patent application within a reasonable period of time after publication is made (*i.e.*, If you publish an article, be ready to move forward with the patent application quickly)
- Keep making improvements and file follow-on applications (the lesson of *Tronzo*)
- Act quickly and stay vigilant – expect third parties to do the unexpected and be prepared at each stage
- Remember that once a pertinent prior art disclosure is known, it must be disclosed to the patent examiner

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NDA Take-aways; Protecting Your Ideas

- Use them, but also understand the limitations of an NDA
- Treat the info like it is secret
- What the invention does (the result it achieves) ≠ how the invention works

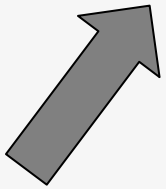
"First to File" – Changes to Patent Law in the U.S.

- ***Effective*** filing date controls who gets the patent, rather than the date of invention
- Flexible aspects to an otherwise rigid system include grace periods and derivation proceedings
- For most applications, the key question is still going to be whether the invention is obvious compared to prior art

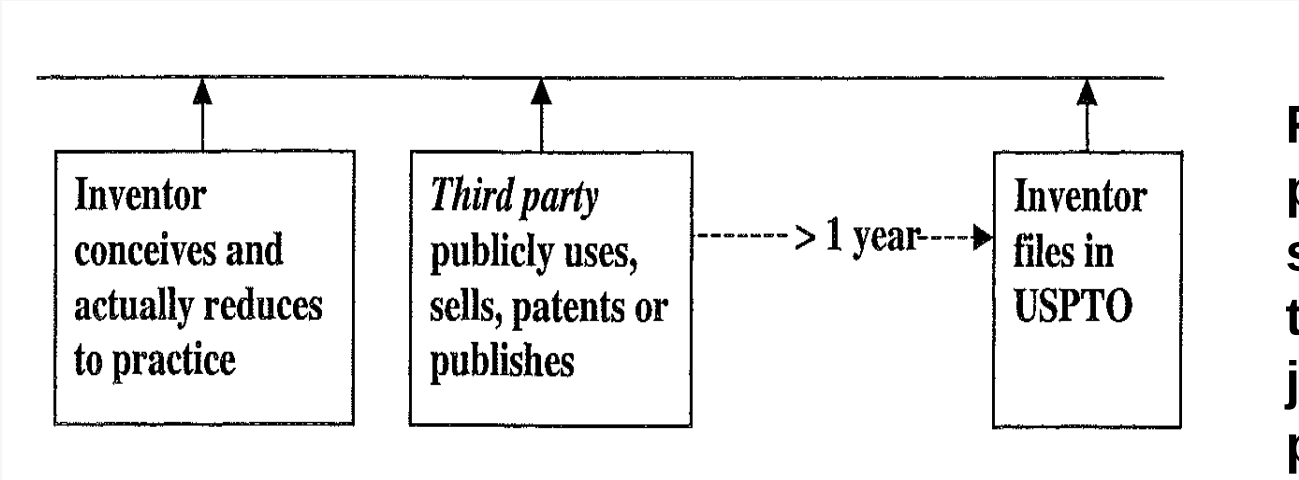
Plain English

In the U.S., a person shall be entitled to a patent *UNLESS–*

the claimed invention was [**DISCLOSED**] before the effective filing date on the application.

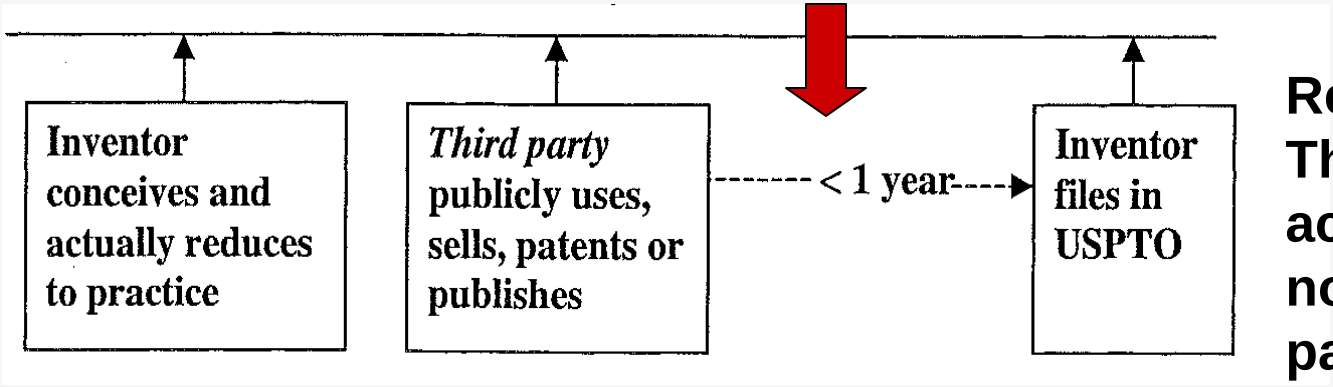


For applications filed **under the old system**



Result: Third party has created some prior art that could jeopardize the patent.

But change one fact …



Result: Third party activity would not prevent a patent.

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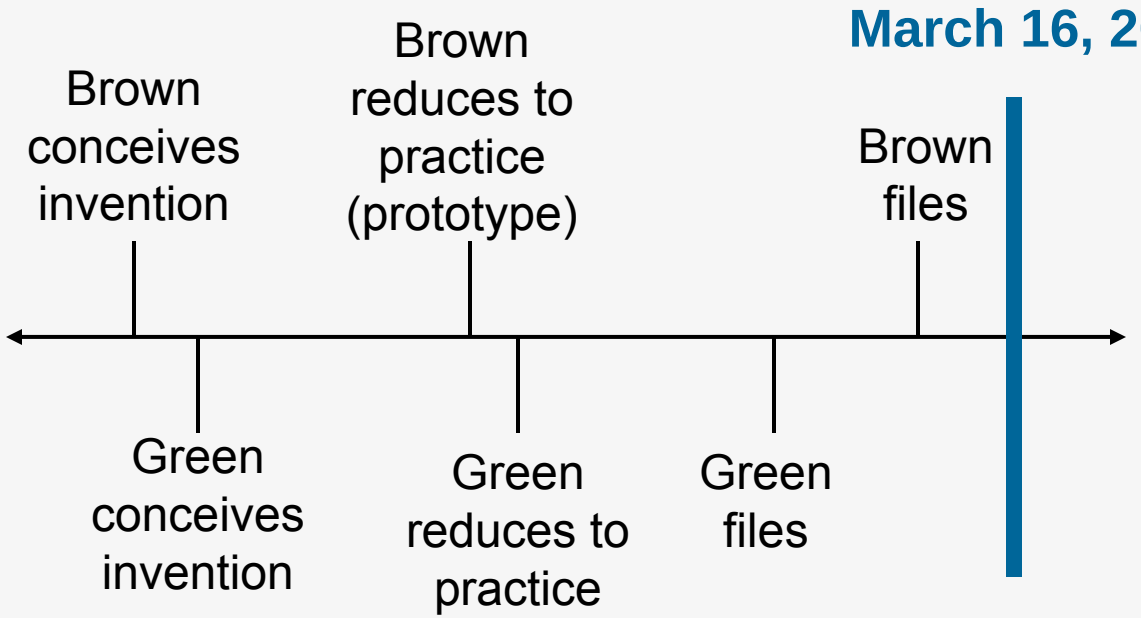
Comparing old system to new:

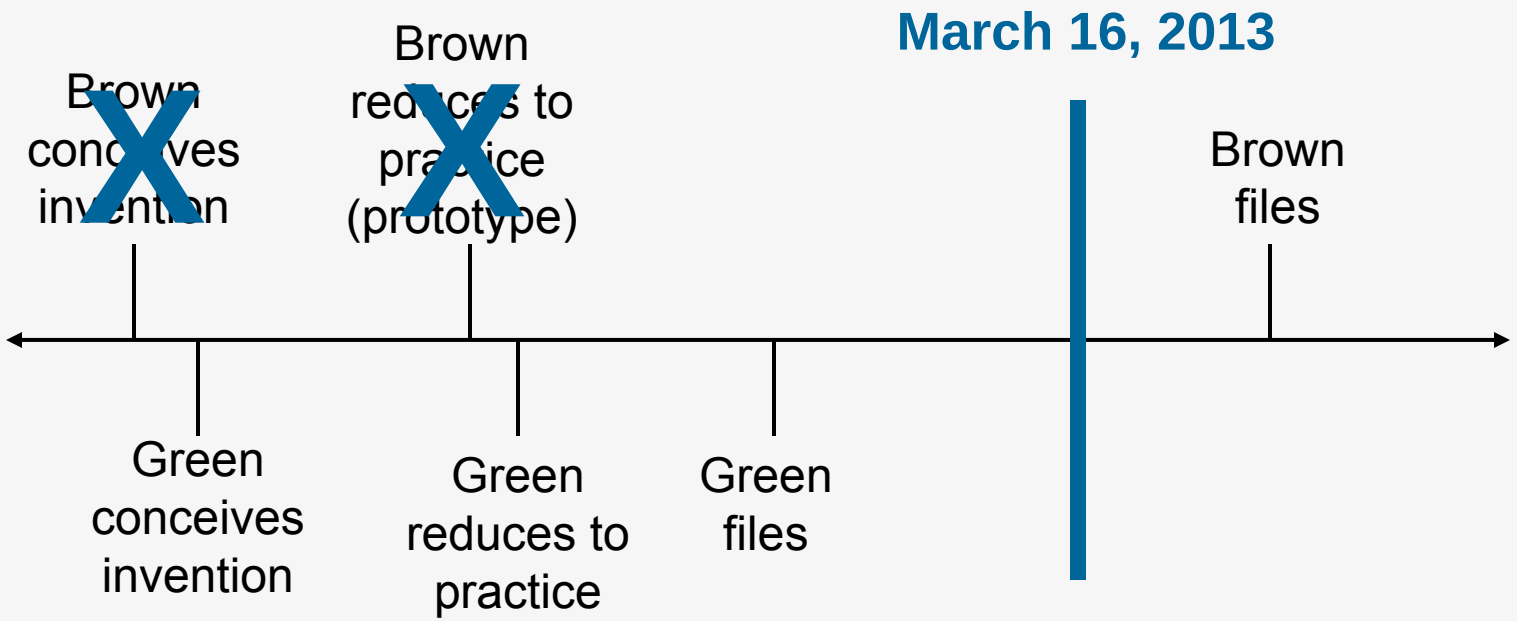
- To illustrate the effects of the new system (AIA, American Invents Act), suppose the application was filed on or after March 16, 2013.
- In general, the third party's "disclosure" would be prior art against an application with an effective filing date after the disclosure occurred.
- Caveats: if the inventor disclosed the exact invention himself (**grace period**), before the third party did, or if it can be proven that the third party **derived** the content of its disclosure from the inventor.
- However, these caveats are a "no man's land" to be avoided if possible.

ALSO, THERE ARE CHANGES IN WHICH INVENTOR IS ENTITLED TO A PATENT

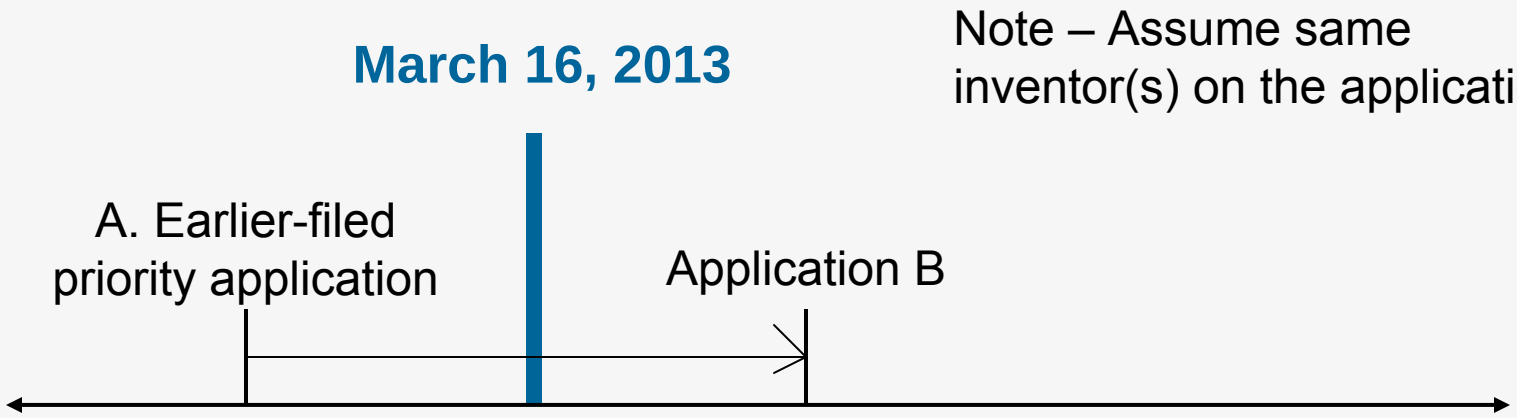


Fact pattern continues on next slide

CHANGES IN WHO GETS THE PATENT – cont'd



STRADDLING THE AIA LINE



Note – Assume same inventor(s) on the applications

If: Application A describes everything applied for in Application B, then B is treated like it was filed on the earlier date; former rules govern.

But if: Application B claims even one feature that was not included in Application A, the **entire** Application B is handled under the new law.

See Previous slide, "Changes in What Qualifies as Prior Art"

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CONCLUSION

THANK YOU FOR YOUR TIME,
ATTENTION, AND QUESTIONS.

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