

A Discussion on Intellectual Property and Patenting Issues



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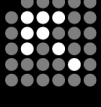


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Most Common Intellectual Property Rights

- Patents
- Trade-marks
- Copyrights
- Industrial designs
- Integrated Circuit Topographies
- Trade secrets



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Patents



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- Exclusive right to manufacture, sell and use an invention
- Must be original, not obvious and have industrial application
- Duration of patent protection: twenty years from the application filing date

Trade-marks

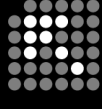


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- Used to distinguish the source of products and/or services from one business to another
- TM - “Common law” use of a mark limits its enforceability to the particular locality where the mark is used

Trade-marks (cont'd)

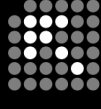


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- © - A registered trade-mark is presumptive evidence of the validity of the mark and the owner's right to use that mark nation-wide
- Duration of trade-mark protection is fifteen years from the registration date with indefinite renewal

Copyrights

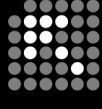


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- An exclusive right to reproduce an original work of authorship fixed in any tangible medium of expression
- Extends to any original literary, dramatic, musical or artistic work, including computer software
- Does *not* extend to any idea, method of operation, concept etc.

Copyrights (cont'd)



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- Automatically subsists from the instant of creation
- Registration confers the owner with presumed evidence of the validity and ownership of the protected work
- Protection extends to the life of the author, plus fifty years after the author's death

Integrated Circuit Topographies

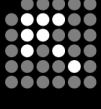


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- Protects semiconductor integrated circuits or microchips and their topographies
- Duration of protection is ten years from application filing date
- Chip design must be original
- Registration must be effected within two years of commercial sales

Industrial Designs

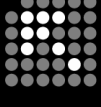


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- Protection relates to the aesthetic appearance of articles
- Design must be original
- Duration of protection is ten years from the registration date

Trade Secrets

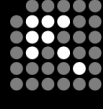


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- Proprietary information which is not publicly available and confers economic benefit to the owner of such information
- Includes: know-how; technical, commercial, financial information; business and sales techniques; customer and supplier lists

Trade Secrets (cont'd)

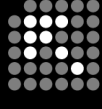


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- Confidential nature of the information must be communicated from the owner to the recipient
- ***Not*** afforded under any statutory law, i.e. common-law protection only
- Can be protected for as long as the secrecy nature is maintained

Patenting Requirements: 3 Criteria

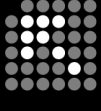


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- **Novelty**
- **Ingenuity**
- **Utility**

Novelty

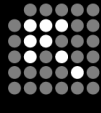


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- Whole invention being anticipated by a single source
- Prior publication – patents, papers
- Public disclosure – conferences, posters, sales, etc.

Ingenuity

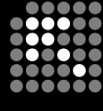


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- Not obvious to average person “skilled in the art”

Utility



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- Able to work and has industrial usefulness

Subject Matter



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Not patentable (yet) –

- Mere idea, scientific principles, abstract theorems, medical treatments, software programs, etc.
- Internet-related developments
- Business methods
- Genetic engineering and higher life-forms

UNUSUAL INVENTIONS

U.S. Patent No. 4,666,425
 Device for Perfusing an Animal Head
 May 19, 1987

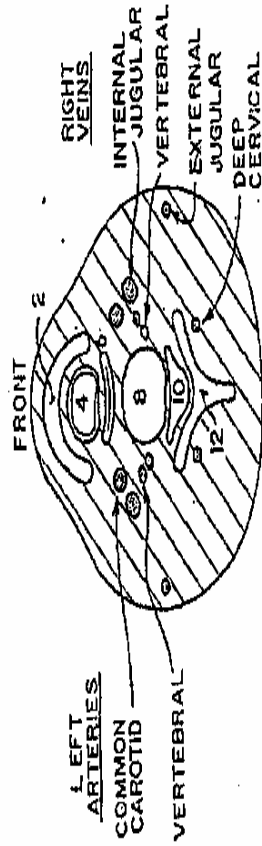


FIG. 1.

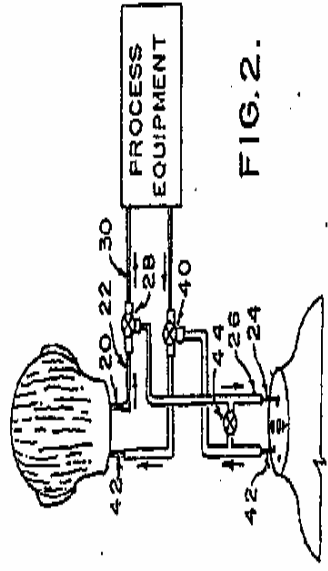


FIG. 2.

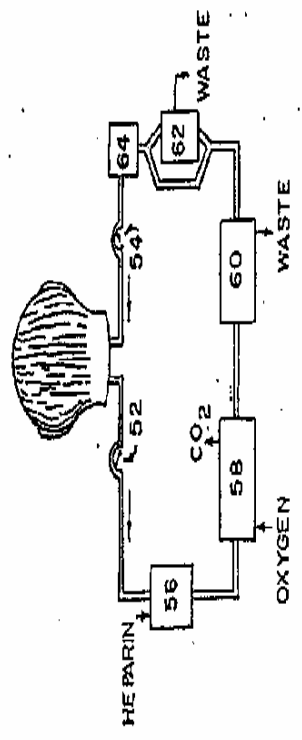


FIG. 3.

ABSTRACT

This invention involves a device, referred to herein as a "cabinet", which provides physical and biochemical support for an animal's head which has been "discorporated" (i.e. severed from its body). This device can be used to supply a discorped head with oxygenated blood and nutrients, by means of tubes connected to arteries which pass through the neck.

UNUSUAL INVENTIONS

U.S. Patent No. 4,605,000
Greenhouse Helmet
Aug. 12, 1986

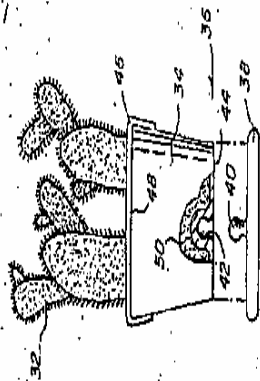
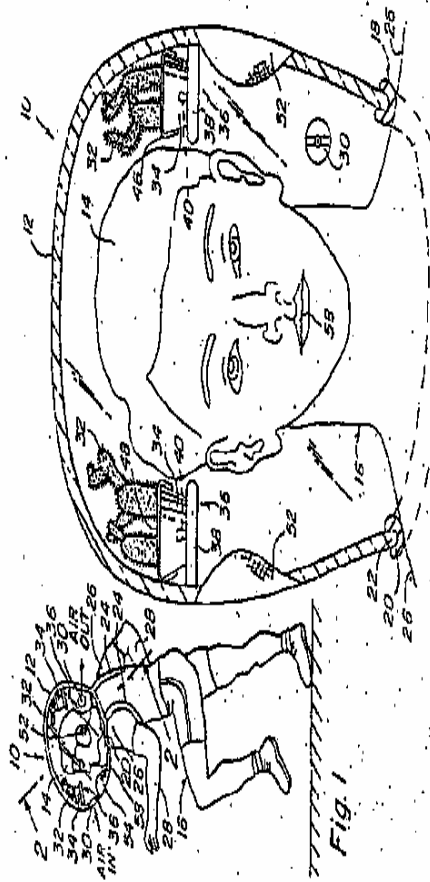


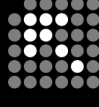
Fig. 2

ABSTRACT

A greenhouse helmet is provided and consists of a dome containing plants secured within the dome worn completely over the head of a person so that the person can breathe in the oxygen given off by the plants.

Fig. 3

Patenting Process:



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Patentability Searches

- Canada – www.cipo.gc.ca
- US – www.uspto.gov

Patenting Process: (cont'd)



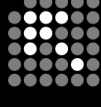
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Filing Patent Applications

- Entitlement given to first filing party
- Preparing an application – abstract, description, drawings and claims
- Filing an application – provisional vs. complete

Patenting Process (cont'd)



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Filing Patent Applications (cont'd)

- Examination and response
- Amendments
- Patent grant

Patenting Process (cont'd)



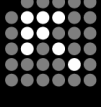
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Foreign Patents

- Determining where to file
- Paris Convention
- Patent Cooperation Treaty (PCT)

Patenting Issues Pertaining to Academic Institutions



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Disclosure

- Publication vs. filing a patent application
- One-Year “grace period”
- Advantage of a provisional application
- Drawbacks of a provisional application
- Non-disclosure agreements

Patenting Issues Pertaining to Academic Institutions (cont'd)



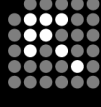
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Inventorship

- Definition of inventor
 - A person conceiving the inventive idea
 - *Not* a person presenting a problem to another for solution
 - *Not* a person who critiques an inventive development
 - *Not* a person collecting experimental data

Patenting Issues Pertaining to Academic Institutions (cont'd)



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Ownership

- University policy
- Outside contractual obligation
- Sole vs. joint
- Assignment – whole or partial

Patenting Issues Pertaining to Academic Institutions (cont'd)

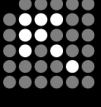


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Licensing

- Retention of ownership rights
- Exclusive vs. non-exclusive
- Improvements – who owns the IP?



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