

Office of Innovation & Technology Transfer Oregon Institute of Technology

OITT IP Process for Patentable Subject Matter

1. Training

Faculty and staff involved in projects that may have the potential of generating intellectual property should attend the “Fundamentals of Intellectual Property Workshop” offered by the OITT. This workshop covers the fundamentals of intellectual property law, an introduction to patent law including patentability requirements, how to conduct preliminary prior-art searches, how to write proper invention disclosures, legal aspects regarding the ownership of intellectual property, licensing, and OUS rules regarding IP. This training is especially important for faculty members working on projects with industry including undergraduate senior projects and MS thesis.

2. Preliminary Prior-Art Search

This step involves conducting a preliminary prior-art search by inventor(s) in order to determine the novelty of the invention.

3. Invention Capture and Invention Disclosure

The inventor(s) are responsible for capturing their invention in written form using the Invention Disclosure form. The OITT’s Invention Disclosure form includes the necessary sections and information to help the inventor through the process. This helps ensure the invention is described with sufficient detail in order to meet the 35 USC 112 requirements of 1) written description, 2) enablement, and 3) best mode. Preparing a detailed written description is critical since it expedites the patent application preparation process, results in stronger patents, and significantly reduces cost.

4. Submission to the OITT

The OITT is responsible for accepting invention disclosures, filing them, reporting them, and assessing patentability and commercial potential. The patentability assessment will be based on statutory class, utility, novelty, non-obviousness, and written description (i.e. 35 USC 101, 102, 103, & 112).

5. Provisional Patent Application Preparation

A US Provisional Patent Application (PPA) will be prepared by the OITT in collaboration with the inventors for inventions with patentability potential. The PPA

will be prepared to be compliant with MPEP 600 requirements and will include claims (i.e. the PPA will include all the sections and detail required for US Nonprovisional Patent Applications).

6. Filing the PPA with the USPTO

The PPA will then be filed with the United States Patent & Trademark Office (USPTO) in order to receive a Filing Date (Priority Date) and a Patent Application Number. Once the Filing Date is established through the PPA process, the invention can be publicly disclosed without jeopardizing any international IP rights (i.e. Patent Pending Status has been obtained). The filing date of the PPA can be relied upon in a later US nonprovisional patent application (NPA), a foreign patent application under the Paris Convention, or an international patent application under the Patent Cooperation Treaty (PCT). In order to receive the priority benefit the later application must be filed within 12 months of the filing date of the PPA.

7. Assignment

Once the PPA capturing the invention is filed and a US Patent Application Number is obtained, the inventors will execute the Assignment (transfer of ownership) to OIT.

8. Recordation

The executed Assignment will then be recorded in the USPTO by the OITT.

9. Early Stage Licensing

The OITT, with help from the original inventors, will make efforts to license the IP associated with PPA applications. Licensing Agreements or Option Agreements will typically require the Licensors to contribute to the costs of patent preparation, filing, and prosecution of the corresponding nonprovisional patent applications.

10. Preparation & Filing of US Nonprovisional Application

A US Nonprovisional Application (NPA) needs to be filed within 12 months of the original PPA in order to claim the priority benefit of the PPA and avoid abandonment. USPTO NPAs are published as US Patent Application Publications 18 months from the earliest filing date (i.e. typically the Priority Date established by the US Provisional Patent Application). Once the NPA is published by the USPTO as a Patent Application Publication, the legal invention claimed cannot be patented by a third-party. Examiners use Patent Application Publications to issue rejections or limit the claims of later filed patent applications.

11. Prosecution before the USPTO

After the application is published by the USPTO, the next step involves a substantive examination for patentability by a USPTO Patent Examiner. This often results in a Restriction Requirement, a Non-Final Rejection, a Final Rejection, and Advisory Actions. Each of these Office Actions requires filing a timely Response that typically includes Amendments, Remarks and Arguments prepared by the Licensed Practitioner prosecuting the patent application before the USPTO in order to avoid Abandonment. Additionally, it is often necessary to conduct an Examiner Interview and present oral arguments in order to place the application on the allow track.

12. Patent Issuance & Licensing

Assuming the subject matter is patentable the application will issue as a US Patent. During the entire prosecution process efforts will be made in order to License the IP in order to benefit the public and OIT.

13. Licensing Royalties

Royalties collected will be used first to recover the costs associated with preparing, filing, and prosecuting the patent application. Once these costs are recovered, licensing royalties are shared between the inventor, the department, and the OITT. As detailed in OAR 580-043-0011 employees shall be eligible to share in net royalty income from each invention or separate improvement thereof, an amount not to exceed 40 percent of the first \$50,000, 35 percent of the next \$50,000, and 30 percent of all additional net royalty income received by the Board for inventions and technological improvements.