

A Few Basic Facts About Patenting¹

Fundamentals: what is a patent?

Patents provide inventors with the right to stop others from: *making, using, selling, or importing*² their invention. A patent is issued by the US government (or internationally by another government). It is up to the inventor to enforce the patent which can take the form of demand letters, lawsuits, or for imported goods with administrative proceedings with the international trade commission.

Types of patents:

- **Utility patent.** The key words are: New, Useful, and Not Obvious. The Utility Patent will be for a: “useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” At Florida Poly, almost all patent activity will be with utility patents. Examples: the lightbulb (1880), the telephone (1876). Utility patents provide 20 years of protection after the original filing date.
 - New – not established knowledge. This means formally that it is not a part of “prior art.” Prior art is defined below.
 - Useful – whatever is patented must be used to accomplish something.
 - Not Obvious – for a practitioner in the field, it cannot be an obvious extension to existing knowledge or practice.
- **Design Patent.** For “visual ornamental characteristics embodied in an article” (e.g. the look and feel of the device). Example: the original Coca Cola bottle from 1915. Design patents provide 15 years of protection after the filing date.
- **Plant Patent.** “asexual reproduction of distinct and new variety of plant”. Examples: the Honeycrisp apple tree, the Eureka Lemon. Plant patents provide 20 years of protection after the filing date.
- **Provisional utility patent.** This is a mechanism to start to protect a potentially patentable idea that provides one year of protection before the patent application is filed. It is typically used to either: protect the idea while the idea is “matured” or provide a low initial cost mechanism for protection. With a provisional patent, you have one year to file a formal patent application; if you do not, the provisional patent is abandoned. Formally a provisional patent allows you to use the term “patent pending.”

Key elements in patenting, what can be patented:

- Prior art is not patentable; prior art is defined as anything that has been publicly disclosed one year or more before the filing date of the patent.
- Key factors:
 - Novelty (cannot be part of prior art)
 - Usefulness (Capable of use and provides an identifiable benefit)
 - Non obviousness (cannot be an obvious extension of prior art, requires “inventive step”)

¹ Document assembled from various sources by Terry Parker, Professor Mechanical Engineering and Director of Technology Transfer

² Commonly used terms in the description of patents and their protection.

- Public disclosure and a patent application:
 - Publication or public disclosure of the invention starts a one-year period, with no ability to have patent protection of the invention after the one-year period. ***This is very important to academics since it means they must be strategic about what and when they publish if they also intend to file a patent application.*** Formally, after the one-year period, the “invention” that was publicly disclosed (published or presented) becomes “prior art” and therefore is not patentable. (reference <https://www.uspto.gov/web/offices/pac/mpep/s2153.html> , formally this specifies a one year grace period for an inventor before it becomes a part of the prior art). ***Please note that some countries do not include the one year grace period after the initial disclosure and instead require that a patent be filed before a any public disclosure of the invention is made.*** This means that international patent protection may have a stricter requirement for public disclosure that that required for US patents.

How to seek patent protection at Florida poly:

- Fill out patent disclosure form (email tparker@floridapoly.edu or TechTransfer@floridapoly.edu for a copy).
- Schedule a time with the Director of Technology Transfer to discuss your idea (you can do this before filing out a disclosure if you are not sure if a patent will be helpful to you).

Resources:

Overview of filing a patent from the US Patent and Trademark Office:

<https://www.uspto.gov/patents/basics/apply>

Nonprovisional (Utility) Patent Application Filing Guide:

<https://www.uspto.gov/patents/basics/apply/utility-patent>

Provisional Application for Patent: <https://www.uspto.gov/patents/basics/apply/provisional-application>

Please note that while this information is useful and informative, the Office of Technology Transfer provides a service to faculty and staff, where the university has a policy driven ownership stake, to help navigate the patent process.