



# *Patent Issues & Potential Problems*

**Invention to Venture**  
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# Public Disclosure

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- **Disclosure rules differ from country to country**
- **Types of disclosures to consider**
  - Talks - in house
  - Grant applications
  - Meeting abstracts
  - Meeting presentations - talks and posters
  - Websites and press releases
  - Journal publications – print and online
- **Managing risk – assume public disclosure**

# Confidentiality & IP Rights

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- **Material Transfer Agreements**
  - Prior to accepting/providing materials
- **Non-disclosure Agreements**
  - Prior to discussion
  - Update if scope of disclosure changes
- **Managing risk – understand rights**

# Evidence of Invention: Record Keeping

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- **Long-term issue**
- **First to invent vs. First to file**
- **Legal standard**
  - **Corroboration rule**
  - **Chain of custody**
- **Record format**
- **Managing Risk – implement a records procedure**

# Inventors & IP

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- **Inventorship**
- **Assignments/Declarations**
  - **Timing**
  - **Chain of title on record at USPTO**
- **Maintaining contact information**
- **Managing risk – timely communication**

# Should you File a Patent Application?

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- **Assess costs and benefits of filing**
- **Know product and market**
  - **Cost and demand for product**
    - Long-term value?
    - Obsolescence?
  - **How to enforce patent?**
    - Who will use or infringe product?
  - **Do you need to file to pursue licensing opportunities?**

# Should you File a Patent Application? *(cont)*

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- **Alternatives to filing**
  - License to someone else to develop
  - Control access to your product without patent
    - Trade secret
- **Risk management**
  - Assess holdings regularly along with company/lab goals
  - Document reason you filed or maintained particular application to help make future decisions