U.S. Patent Practice

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What is a Patent?

• A patent is a property right given by the government to an inventor. The property right gives the inventor the right to exclude others from making, using, offering for sale, or selling the invention. In return for the exclusive right for a certain period of time, the inventor must disclose the invention to the public.

• The patent does not give the inventor the right to practice the invention.
Types of Patent Applications

• Utility Patents
  – Protect new and useful inventions
  – Protect the way an invention works
  – Term of Protection: 20 Years (measured from earliest effective U.S. filing date)
  – Provisional and Non-provisional

• Design Patents
  – Protect the ornamental appearance of a product
  – Term of Protection: 14 years from the issue date
    • For design patents issued on applications filed after May 13, 2015, the term will be 15 years

• Plant Patents
  – Protect new varieties of asexually produced plants
What Can Be Patented?

封锁 Anything new and useful

封锁 Methods (example: a method of using a medical device), Machines (example: a smartphone), Compositions of Matter (examples: chemicals, pharmaceuticals, assays), Manufacture

封锁 Mathematical algorithms, laws of nature, and ideas? – No
Requirements for Patentability

• **Novelty**
  – Must be new (not previously known or used by others)

• **Non-Obvious**
  – Must not be obvious to a person of ordinary skill in the field of the invention at the time the invention was made

• **Utility**
  – Invention must be useful

• Invention must be described and enabled in the patent application (how to make and use the invention)
Why Patent Your Inventions

• Showcase your technology
  ♦ Use as an asset when looking for funding
  ♦ Key factor to bring your innovation to the market

• Obtain exclusivity for your products
  – Utility Patent
    • 20 year patent term
  – Design
    • 15 year patent term

• Block your competition
• Protect an area of research while you identify a product
• Licensing revenue
• Source of recognition for the inventor
Inventorship

• Determining who is an inventor is a legal determination

• The inventor must contribute to the conception of the invention

• Inventors are **not** the same as co-authors of a paper, students in a lab, or supervisors

• Wrong inventorship can invalidate a patent
Common Pitfalls

♦ U.S. is a first to file country

♦ If the inventor allows other people to know about the invention before a patent application is filed, the inventor may lose his/her patent rights.

♦ Do not disclose the invention without an executed confidentiality or non-disclosure agreement.

♦ United States
  – One year grace period (U.S. filings must take place within one year from any public disclosure or offer for sale)

♦ Most foreign countries/regions (for example: Europe)
  – Absolute novelty (Foreign filing must take place prior to any public disclosure or offer for sale)
Common Pitfalls

♦ Any public disclosure
  – poster presentations
  – handouts at meetings
  – abstracts
  – material posted on the internet
  – oral presentations
  – a lecture or speech
Common Pitfalls

♦ The public disclosure must be enabling
  – Must describe the invention in sufficient detail to enable a person of ordinary skill in the art to carry out the invention
  – Huge risk of disclosing too much information
Disclosure Form

♦ Report your inventions via the NJIT Inventor Portal

https://njit-ip.ttoportal.com/Login.aspx