Office of Counsel

Patents and Technology Transfer

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• Patent Process

• Technology Transfer

• Federal Trade Secrets Act
Patent Process

- Invention Disclosure
- Preparation and Filing of US and Foreign Patent Applications
- Issue of Patent
- Payment of Maintenance Fees
Technology Transfer

- Cooperative Research and Development Agreement (CRADA)
- Short Form CRADA - Material Transfer Agreement
- Patent Licensing Agreement (PLA)
Invention Disclosure

- Recorded in Laboratory Notebook
- Review by Chain of Command
- Forwarded to OTT/OOL
- Review by Invention Evaluation Committee
OOT/OOL Action

• Request Further Proof of Concept from Inventor (more data)
• Recommend Patenting (Military Need, Commercial Success)
• Leave Rights with Inventor
Types of US Patent Applications

• **Utility** - Grant from Date of Issue until 20 Years from Date of Earliest Filing
• **Provisional** - No Patent Grant
• **Design** - Grant from date of Issue until 14 Years Thereafter
• **Plant** - Same Grant as Utility Patent
• US Patent Applications
  • Provisional - Lapses After One Year
  • Regular U.S. Filing -- Pending for 2-5 Years at USPTO
  • One year Grace Period from First Public Disclosure

• Foreign Patent Applications
  • PCT - Patent Cooperative Treaty
  • Absolute Novelty - Any Public Disclosure Prior to Filing
    Destroys Ability to Obtain Patent
Provisional Pitfall for the Unwary

• Fewer Formal Requirements than Regular US Filing
• Only as good as the Material Presented
• Good way to Preserve Absolute Novelty - Impending Publications, Conference Presentation Starts the One-year Clock Ticking for Priority Date
One-Year Clock for Priority Date

- Paris Convention of 1883
- 35 USC 119 - Foreign and US Provisional
- 35 USC 120 - US Regular Filing
Is the Invention Patentable?

- 35 USC 101 - Not Eligible Subject Matter, Lacks Utility, Double Patenting
- 35 USC 102 - Novelty, Promptness
- 35 USC 103 - Nonobviousness
- 35 USC 112 - Formal Requirements
35 USC 101

Eligible Subject Matter

• Any New and Useful
  • Process
  • Machine
  • Article of Manufacture
  • Composition of Matter
  • Improvement Thereof
Utility
No Perpetual Motion Machines
No Cold Fusion

Double Patenting
Only One Patent Per Invention
Identical Claim Language
Similar Claim Language - Obviousness-type
Terminal Disclaimer Practice
35 USC 102

- **Novelty** - Invention Exactly Disclosed by Another? - **Firstness**

- **Promptness** - Did you File Quickly Enough?
35 USC 103
Nonobviousness

State of the Prior Art
Differences Between Invention and Prior Art
One of Ordinary Skill in the Art
Suggestion or Teaching in Prior Art to Combine References
35 USC 112

• Enabling Disclosure
• Adequate Written Description
• Best Mode
• Clarity in Claim language
Regular US Filing

• Filing Receipt

• Notice to File Missing Parts
First Office Action

- Restriction Requirement
- More than One Invention
- Patentably Distinct Inventions
First Office Action on the Merits

- 35 USC 101 - Not Eligible Subject Matter, Lacks Utility, Double Patenting
- 35 USC 102 - Novelty, Promptness
- 35 USC 103 - Nonobviousness
- 35 USC 112 - Formal Requirements
Second Office Action on the Merits

Allowance - Pay Issue Fee

Final Rejection - File Appeal Brief /Abandonment
Patent Granted

Maintenance Fees
6 Months Prior to 4 Years
6 Months Prior to 8 Years
6 Months Prior to 12 Years
Technology Transfer
CRADAs- 15 USC 3710a

• Leverages the Resources of a Federal Laboratory
• Federal Labs May Work with: Persons, Companies, Nonprofit Organizations Including Universities
• Federal Labs May **NOT** Work with Foreign Governments
• CRADAs with Foreign Entities - Must Consult with US Trade Representatives
• Mission-Related
• Federal labs Shall Not Directly Transfer Money to CRADA Collaborating Party
CRADA Provisions

- Intellectual Property Rights
- Nondisclosure Terms
- Publication Provisions
- Duration - Typically 3 to 5 Years
- Exemption from FOIA Requests
Domestic Technology Transfer

PLAs 35 USC 207, 209

- Nonexclusive Licensing
- Partially Exclusive Licensing
  - Geography, Field of Use
- Exclusive Licensing
Domestic Technology Transfer

PLAs 35 USC 3710a, 3710c

- 15 USC 3710a - Lab Directors May Sign PLAs
- 15 USC 3710c - Royalties
- First $2000 to Inventors + 20% of Remainder Per Year
- Statutory Purposes - Lab May Keep Monies Collected
- Exception to Miscellaneous Receipts Rule
- Money not Spent or Obligated after 2 Years Returned to Treasury
Federal Trade Secrets Act

- Prohibits Knowing Disclosures of Trade Secrets
- You Don’t Disclose Proprietary Data to Anyone!
- Shall be Fined Not More than $1000
- Shall be Imprisoned Not More than One Year
- Both Fine and Imprisonment
- Shall be Removed from Office or Employment
• How could a Gov’t Employee get access?
  • Procurement Contracts
  • CRADAs
  • Cooperative Agreements
  • Technical Data Package