

A Short Introduction to Intellectual Property Rights



Trina Voss, Arvin S. Paranjpe, Travis G. Cook, and Nicole D.W. Garrison

Intellectual property (IP) is a term that describes a number of distinct types of intangible assets. IP protection allows a rightsholder to exclude others from interfering with or using the property right in specified ways. The main forms of IP are patents, copyrights, trademarks, and trade secrets. Each type of IP protection is different, varying in the subject matter that can be covered, timeframe of protection, and total expense. Although some inventions may be covered by multiple types of IP protection, it is important to consider a number of business and legal factors before selecting the best protection strategy. Some technologies require strong IP protection to commercialize, but unnecessary costs can derail bringing a product to market. IP departments of organizations weigh these various considerations and perform essential IP protection functions. This primer introduces researchers to the main forms of IP and its legal aspects.

Tech Vasc Interventional Rad 20:116-120 © 2017 Elsevier Inc. All rights reserved.

KEYWORDS intellectual property, patent, copyright, trademark, technology transfer

Introduction

Intellectual property (IP) is a term that describes a number of distinct types of intangible assets. Without a clear understanding of the different types of IP protection, it is easy to confuse them. Further, patents are often written in abstruse language, embedded with both complex scientific material and sophisticated terms with specific legal meaning. An entrepreneurial-minded researcher can make costly mistakes when trying to obtain valuable patent protection. These mistakes not only result in the loss of IP rights but also result in the loss of potential investors and business partners.

Fortunately, there is help. Most universities, nonprofit research institutions, and innovative companies have created IP departments to evaluate and protect new technologies. In academic and nonprofit research organizations, these departments also license the technologies to companies and are commonly referred to as technology transfer offices (TTOs). TTOs have experts with legal, scientific, and business backgrounds. Their

multidisciplinary background reflects the multiple factors they must consider to properly manage the IP protection and licensing processes. It is simply unreasonable, and unfair, to expect most researchers and clinicians to be experts in their field as well as in business, IP, and contracting. Furthering the issue, most institutions have poorly integrated the business and legal units into research and clinical units. Consequently, IP portfolio development fails to fully meet its potential due to ineffective management of available resources.¹ In most cases, it makes sense to bring in advisors with the specific subject matter expertise throughout the development of the IP to help with the esoteric steps so researchers can focus on their core responsibilities. In addition to an organization's IP department that governs and manages the IP portfolio, in-house general counsel and outside patent and copyright attorneys serve important roles in their specialized areas of expertise.

Protecting IP begins with keeping good records. Laboratory notebooks or thorough notes can be invaluable in completely describing what is, and is not, included in IP. A thorough description of the creation will allow a clear separation of what needs to be protected and what rights cannot be secured. The level of detail required to write a good patent application is similar to what is required to write a research journal article. In addition to describing the invention, it is important to name all contributors and

Technology Transfer and Business Development, Oregon Health & Science University, Portland, OR.

Address reprint requests to Arvin S. Paranjpe, Technology Transfer and Business Development, Oregon Health & Science University, Portland, OR. E-mail: paranjpe@ohsu.edu

what they worked on, any publications or public discussions of the ideas, and any funding agencies. Review of potential IP should never prevent or unreasonably delay publishing and disseminating ideas. When planning to publish or otherwise publicly disclose research, it is recommended that the materials of concern be evaluated by a professional for potential IP before it becomes available to the public to preserve rights. It takes time to properly evaluate inventions and draft materials in support of property protection, involving the IP department several months before a publication generally results in better IP protection.

IP Protection

IP protection allows a rightsholder to exclude others from interfering with or using the property right in specified ways. Although the government will not monitor and prevent unauthorized infringers, the owner (s) can use the courts and legal system to obtain monetary damages and injunctive relief. Penalties can be set by the court and can be up to 3 times the income lost if someone clearly intentionally violated IP rights. The length of time one can assert IP rights is finite, ranging from approximately 15-75 years, depending on the type of protection. The main types of IP protection are in the form of a patent, copyright, trademark, or trade secret.

Patents

The United States patent system is based on Article I, Section 8, Clause 8 of the U.S. Constitution, and the first United States Patent Act was passed in 1790. The purpose of the patent system is to promote innovation by granting exclusive rights to inventors. In exchange, inventors must provide a detailed description of how to make and use the invention that is made available to the public; this promotes innovation and competition resulting in technological advancement.

Patentability

To be patentable, an invention must be human made, not something discovered in nature, and must have an actual physical embodiment. It cannot be an abstract idea or one where parts of the process are not understood. Patent Examiners at the United States Patent and Trademark Office (“USPTO”) will review the application. They are instructed to issue any patent that does not fail certain tests of patentability. To a certain extent, an examiner's job is to find a reason to refuse to issue a patent, so the application must be drafted and sometimes amended to overcome rejection from the respective patent authority. In some cases, an invention is not considered to be patentable subject matter, such as European patent applications related to human cloning.

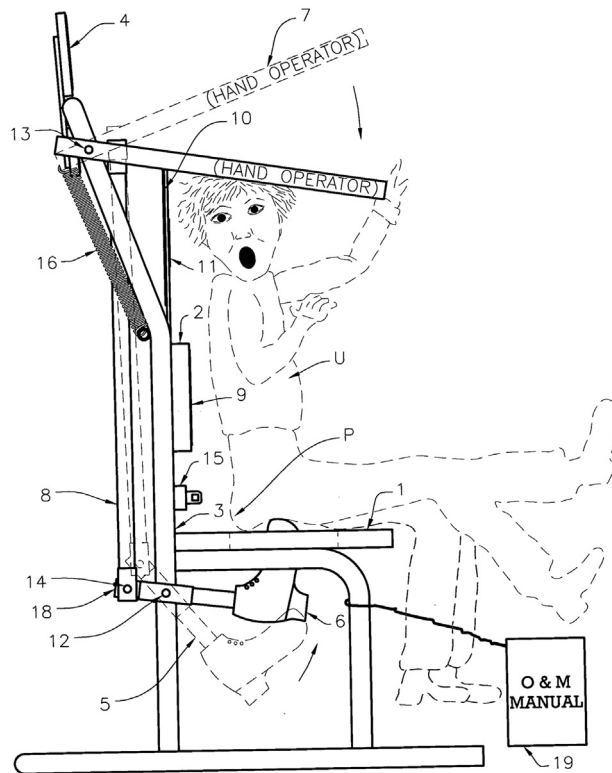


Figure “Utility” of a patent.

One test of patentability is “Utility”. This means the invention must actually do something useful. “Useful” is a somewhat of a broad term in this case. For instance, entertainment is considered a valid use. An example of this is a particularly interesting patent application, found at <https://www.google.com/patents/US20060094518>, “Manually self-operated butt-kicking machine” (patent application number 10/977,894). “Self-Operated Butt-Kicking Machine.” (Fig.) The abstract of the patent speaks for itself:

The “Manually Self-Operated Butt-Kicking Machine” is in the form of a chair with a hole in the bench. The user sits on the bench with his posterior centered over the hole. A seatbelt holds the user in place. There is a kicking mechanism located below the hole, which has a boot attached to it. When the user or operator pulls the hand-operated lever, the boot kicks the users’ posterior through the hole in the bench. This invention is a new, novel, and unique machine with multiple uses, which range from amusement to fundraising and from motivation to discipline. The objectives of this invention are also many, including, but not limited to, teambuilding, self-therapy, to inspire creativity, and to be used as a model for future devices and works of art.

Another test of patentability is “Novelty”. The invention must be completely new, never discussed in public, or seen anywhere. In the United States, there is a “grace period” afforded to public disclosures made by an inventor within 1 year of filing the patent application, thereby preserving novelty. In most other countries, any publication of the details of an invention, even if made by an inventor, releases the invention to the public domain and therefore no longer patentable in those territories. A relatively small change can be enough to consider an invention novel. Often, when patent applications run into

Download English Version:

<https://daneshyari.com/en/article/5728415>

Download Persian Version:

<https://daneshyari.com/article/5728415>

[Daneshyari.com](https://daneshyari.com)