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Patenting Strategies that Increase Commercialization Success

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Stage 1: Patent Advisor

- **Review Employee Invention Report (EIR)**
 - **Inventorship**
 - **Ownership**
 - **Statutory bar issues**



Stage 1: Patent Advisor

- If statutory bar is imminent, Patent Advisor will:
 - File a “cover sheet” provisional patent application with both broad and narrow claim sets
 - This can now be done online at the USPTO using EFS
 - Online PCT applications are coming next year but since these are more labor intensive, this may not benefit a tech transfer office



Stage 1: Patent Advisor

- If no statutory bar is obvious, Patent Advisor will:
 - Conduct a preliminary marketability assessment based on inventor and licensing/marketing group input
 - Gather additional information from web research, USPTO search, and possibly NERAC search results
 - Prepare a package of all this for a more formal marketability report and a contract law firm oral patentability opinion



Stage 1: Patent Advisor

- Patentability Assessment
 - Focus on novelty
 - Non-obviousness is nearly impossible to determine beforehand
 - Even novelty can be difficult to assess since US-only filings are not published until issue
 - Survey both issued and published applications
 - Read the specification in the broadest light possible to assess novelty bars
 - Don't forget to search international applications at the EPO website



Stage 1: Patent Advisor

- If the invention has great potential, there are questions as to novelty, and you have a budget that permits, it can be useful to hire a Washington, DC based search firm for a more thorough novelty search
- Someone in the TTO or contract law firm will still need to evaluate the prior art pulled up in the search



Stage 2: Formal Marketability Assessment

- Foresight, NERAC, Medtracks, TreMonti, etc.
 - Adds another layer of objectivity
 - But shouldn't be the sole determinant
- May also be useful in preparing the nonconfidential summary and other marketing materials
- May provide marketing leads/contacts
- May also provide a rough patentability opinion in some cases
- Cost=\$800-\$3500, but is money well spent in light of the non-provisional filing and prosecution costs



Stage 3: Contract Law Firm

- Patent attorney with expertise in relevant technology area provides a preliminary oral patentability opinion based on package of information put together by the Patent Advisor
- Generally involves only 1-2 hours of attorney review time at this stage



Of course, it goes without saying that . . .

- At each stage it is important to review the results to determine whether it is appropriate to even proceed to the next stage



Decision Points

- Not marketable and not patentable
- Marketable but not patentable
- Patentable but not marketable
 - Do we need to a future position on this invention?
- Patentable and Marketable
 - But should we patent and market?
 - Will the invention be transferred without a patent?
 - Do we need a defensive position?
 - Will a patent speed translation or hinder it?
 - Will a patent spur an industrial collaboration?



Were to File?

- Provisional in US unless a licensee is on hand and an issue patent is needed quickly
 - Provides a year to assess the market
- Non-provisional filed via the PCT
 - The extra cost keeps the foreign doors open for an additional 18-19 months
- Non-provisional in the USPTO if and only if foreign patent rights are not possible or not desired



Consider Other Forms of Protection

- Plant Variety Protection Act and Plant Patents
- Copyright
 - If there is a non-Federal collaborator
 - In Canada or other foreign jurisdiction and rely on the Berne convention
- Biological Material License Agreement (for Public Health Service only)
- New FTTA authority to license patentable but not patented materials



The bottom line is that we seek to achieve the most appropriate protection for the least upfront investment while allowing as long a marketing period as possible to find a licensee or other partner to move it to practical application and hopefully pick up the past and/or ongoing patent costs.

