

Information for Faculty

Marquette University's invention disclosure, patent and licensing process is important to all faculty engaged in research activities. Every invention is different, of course, and every inventor has different needs and expectations. Marquette's approach to technology transfer is flexible.

Why patent? Marquette wants the products of research to be made widely available for the public benefit. The exclusivity afforded by a patent is typically needed to encourage a commercialization partner to invest in development, production, and marketing.

Typical Pathway

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| 1 | Disclosure to ORSP | The inventor contacts ORSP and completes an Invention Disclosure form. The form provides essential information about the invention: What is the invention? Who are the inventors? Is the invention encumbered by sponsorship or collaboration agreements? When was the invention first reduced to practice? Is there prior art? Who are potential licensees? |
| 2 | Initial Assessment | ORSP works with the inventor(s), the chair or dean, General Counsel and other university stakeholders to conduct an initial assessment of the invention disclosure, including a prior art search. |
| 3 | Independent Expert & Legal Consultation | Typically, Marquette retains independent counsel with specific knowledge and experience in the field of the invention. The faculty inventor plays an essential role in selecting scientifically qualified counsel. The cost of expert consultation (usually at least \$3,000) is borne by the department, college and/or Provost. At this time, the university may elect to file a Provisional Patent Application. |
| 4 | Filing the Patent Application | After the assessment, Marquette may apply for a Utility Patent. Filing the patent involves a substantial commitment of time from the inventor(s) and the university, as well as a significant investment of university funds. The dean of the college must approve the action and is expected to share in the legal costs. Applying for a US Utility Patent can cost \$20,000-30,000, and applying for foreign patents can cost \$60,000. A US patent typically takes 2 years to issue and may involve numerous USPTO Office Actions that require timely response from the inventor(s), legal counsel and the university. |
| 5 | Developing Prospects for Licensing | In conjunction with steps 1-4, the inventor(s) and ORSP identify prospective licensees and may enter into confidentiality agreements and material transfer agreements to facilitate discussion and evaluation. |
| 6 | Licensing | The university prepares and negotiates license agreements in close consultation with the inventor(s). Inventors help the university delimit the licensee's fields of use and communicate with the licensee's technical personnel to help them understand and use the invention. |

Publish or Patent? Answers to Frequently Asked Questions

1. I described my invention in a poster or a presentation at an academic conference. Can we still apply for a patent?

To be valid, a patent application must be filed before the "bar date" established by a country's patent laws. The bar date is the date after which a patent application is barred or invalid.

In the United States, the bar date for filing a patent application is one year after the first public disclosure. In most foreign countries, the bar date is the same day as the first public disclosure. However, see question 6 for more on foreign filing deadlines.

Much depends on whether the information you disclosed constitutes an "enabling disclosure." An enabling disclosure is a description of your invention that is sufficiently detailed to enable a knowledgeable person to duplicate or use the invention.

2. **What constitutes public disclosure?**

Under US patent law, a public disclosure occurs when an invention is

- A. described in a printed publication anywhere in the world;
- B. placed in use in the US, or
- C. offered for sale in the US.

Foreign patent laws are much stricter. The invention cannot be publicly disclosed before filing the patent. For foreign patents, a verbal disclosure may constitute a bar.

3. ***What does "described in a printed publication" mean?***

US patent law holds that a public disclosure has the following three characteristics:

- 1. it appears in any fixed-media form – including web site and email;
- 2. it is considered to be available to the public -- either by intentional disclosure (e.g., a journal article) or a disclosure made without an obligation of confidentiality (e.g., an email to a friend); and
- 3. it describes the invention is enough detail that a person familiar with the field could duplicate or use it.

The third requirement may exclude some abstracts and articles from the definition of public disclosure. However, the sufficiency of a disclosure is not subject to what a "reasonable person" might think, but rather is determined at patent examiner's discretion.

Moreover, even if the publication is itself not enabling, it can contribute to the "prior art" which is evaluated during the patent examination and may raise questions about the non-obviousness of the application. Even your own "prior art" can block your patent.

As a practical matter, disclosure to the university before publication is the best way to avoid unnecessary loss of patent rights or, worse, investing effort and expense in filing a patent that is later deemed invalid.

4. ***What does "placed in use" mean?***

Public disclosure by being "placed in use" is determined in court. Typically, any use of the invention by someone not required to keep the invention a secret (e.g., someone not bound by a confidentiality agreement) will trigger the bar date. Any authorized commercial use of the invention will also trigger the bar date, even if the invention itself is kept secret.

An exception to the "use" rule may be a good faith experimental use, which should not trigger the patent bar date if the *only* motive is testing or perfecting the invention (and not, for example, demonstrating it for prospective buyers). When an invention is being provided to another party for testing, the only way to protect the invention is a legally binding agreement that limits that party's use.

5. ***What does "offered for sale" mean?***

Any offer to sell an embodiment of the invention triggers the bar date, even if the offer is declined. However, offering license rights in the invention does not trigger the bar date, if what is being offered for sale are rights and not an embodiment of the invention itself.

6. For foreign patents, does a patent application have to be filed in each country before the first public disclosure?

No. We only have to file a patent application in one country (typically the US) before you make the first public disclosure. We then have 12 months after that first "priority filing" to file in any other countries or regional territories in which patents are desired.

7. Can I talk to colleagues about my invention without fear of disclosure?

Generally, you can discuss your invention with other Marquette employees without a confidentiality agreement. Make sure your Marquette colleagues understand that the matter must be kept confidential.

For anyone who is not a regular Marquette faculty member or other employee, ask ORSP to prepare a confidentiality agreement before you discuss your invention. Students, for example, and visiting faculty are not bound by the same contractual terms as your other Marquette colleagues, so a confidentiality agreement is often required in the interest of diligence (see question 3, item 2).

8. How much of my time and effort is required?

The disclosure and patent process requires a fair amount time and effort on the part of the faculty inventor. The disclosure itself requires a careful review of lab notebooks and some thoughtful writing. The disclosure form is straightforward and usually takes a few hours to complete. At the initial assessment stage, the faculty inventor must be willing to discuss the invention and the completed disclosure form with his or her chair, dean, and ORSP. If the stakeholders decide to proceed with outside review, the faculty inventor may be invited to review biosketches of several patent attorneys in order to help the university select an attorney with appropriate scientific qualifications to draft the patent. Careful selection at this point can substantially reduce the amount of correspondence and discussion demanded of the inventor as the attorney drafts the application. Even so, the inventor must be prepared to read and edit drafts of the patent application over the course of several weeks before the initial filing. After the application has been submitted to the US Patent Office, the faculty inventor must be prepared to consult with counsel and with university officials over the next one to two years as various objections or decision points arise during the Patent Examiner's review.

9. Is a patent worth the effort?

The initial assessment aims to answer this question. Bear in mind that the aim of patenting is licensing to achieve the broadest possible dissemination of your invention for the public good. In many cases, companies are unwilling to commercialize an invention unless they can be assured that they have some measure of exclusivity. Inventions that have entered the public domain may be passed over by the marketplace and never reach the public in usable form at all.

Marquette inventors whose research is supported by federal grants have a special duty to disclose and participate in the initial assessment process. The Bayh-Dole Act (P.L. 96-517 as amended in P.L. 98-620), requires invention reporting and disclosure for recipients of federal research funding. In order to ensure continued eligibility for federal funds, Marquette must report all inventions resulting from federal grants and decide whether to file a patent or waive title in the invention to the federal sponsor.

9. Publish or patent: What are my options?

While there are strong expectations and rewards for publishing, patenting and licensing is an unfamiliar path for most faculty. Moreover, while an invention may be publishable at an early stage in its development, it may be too early to tell whether it has sufficient commercial potential to warrant a patent application or even whether it will stand up to examination by the US Patent Office.

Option A. Disclose inventions to ORSP and participate in the initial assessment process before publishing. The process typically takes no more than two weeks. In this way, the inventor can keep patenting and licensing options open. To minimize delay in publishing, **the university may elect to file a Provisional Patent Application.** The date on which the Provisional Patent Application is filed becomes the "effective filing date" of a subsequent patent application. Generally, after filing a Provisional Patent Application, you may publish without jeopardizing the right to file a subsequent US or foreign patent application. However, the US Utility Patent must be filed within a year of the Provisional Patent Application or the patent is irrevocably abandoned.

Option B. Proceed with publication and attempt to avoid disclosing details that might enable a person familiar with the field could duplicate or use the invention (see question 3). The risks of this approach are: 1) the article may not be viable without details, 2) the author may unwittingly include sufficient detail to enable someone skilled in the field to duplicate the invention, or 3) the article becomes part of the prior art and is deemed by the Patent Examiner to make the invention obvious.

Option C. Proceed with publication, abandon any hope of filing foreign patents, but reserve the right to file in the US within the one-year grace period.

10. I published more than a year ago. Do I have any options at all?

Yes, you should still submit a disclosure to ORSP and take part in the initial assessment. It is possible that some portion of the invention was not disclosed, and this portion may have sufficient value to warrant a patent and licensing effort. It is also possible that subsequent to publishing, you have modified the invention in some way that could enable a patent on the improvement.