

IV. HURDLE #4: The Fourth Hurdle To Cross (Promptness).

1. Standards for Grant (continued):

a. Promptness (Timely Filing).

- In the U.S.: a patent application must be filed within 1 year from the first public disclosure (e.g., public use, publication, etc.)
- In many foreign countries: a patent application must be filed before the first public disclosure.

HOWEVER: Emerging Technologies Often Take Many Years To:

1. Research and Develop (e.g., discovery may take many years of research and development).
In addition, emerging technologies often require substantial collaboration between entities, resulting in increased potential for disclosures that can thwart patentability.
2. Bring to Market (e.g., at time of discovery, marketable technology may be many years away).
If one rushes to file a patent application, the term of the patent may expire by the time industrial applications are viable.

b. Novelty (New).

c. Non-Obviousness.

1
00:00:05,269 --> 00:00:02,950
to or make you think that it's close to

2
00:00:07,269 --> 00:00:05,279
some value or something so it ends up

3
00:00:08,950 --> 00:00:07,279
just there's ways to go around it but

4
00:00:11,830 --> 00:00:08,960
just i want you to understand it's

5
00:00:14,230 --> 00:00:11,840
difficult but sometimes you can do that

6
00:00:18,630 --> 00:00:15,990
the uh

7
00:00:20,790 --> 00:00:18,640
this is actually kind of similar but um

8
00:00:22,230 --> 00:00:20,800
and i apologize because my eye should be

9
00:00:23,429 --> 00:00:22,240
over

10
00:00:26,950 --> 00:00:23,439
the um

11
00:00:28,150 --> 00:00:26,960
when you prepare a patent application

12
00:00:32,310 --> 00:00:28,160
i think

13
00:00:33,990 --> 00:00:32,320

probably along the same

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00:00:36,069 --> 00:00:34,000

genre and i'm gonna i'm thinking of

15

00:00:37,590 --> 00:00:36,079

maybe keeping my

16

00:00:39,510 --> 00:00:37,600

lecture short which would be a little

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00:00:42,389 --> 00:00:39,520

bit um maybe you need more time for

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00:00:44,389 --> 00:00:42,399

people the uh unusual for a lawyer i

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00:00:46,150 --> 00:00:44,399

suppose but i'm also thinking that it's

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00:00:47,270 --> 00:00:46,160

not the most interesting topic for all

21

00:00:49,029 --> 00:00:47,280

of you

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00:00:50,630 --> 00:00:49,039

but i think in preparing a patent

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00:00:52,470 --> 00:00:50,640

application

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00:00:54,549 --> 00:00:52,480

there's some requirements of having a

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00:00:56,549 --> 00:00:54,559

complete written description

26
00:00:59,750 --> 00:00:56,559
it has to be enabling disclosure to the

27
00:01:00,630 --> 00:00:59,760
public when you draft claims to protect

28
00:01:03,910 --> 00:01:00,640
your

29
00:01:06,550 --> 00:01:03,920
technology it has to be in clear terms

30
00:01:09,190 --> 00:01:06,560
and many of these terms that that are

31
00:01:10,710 --> 00:01:09,200
being used are not widely

32
00:01:12,550 --> 00:01:10,720
understood terms

33
00:01:14,390 --> 00:01:12,560
you know how do you focus

34
00:01:15,670 --> 00:01:14,400
your intent you know what does it mean

35
00:01:17,510 --> 00:01:15,680
by your intent

36
00:01:19,510 --> 00:01:17,520
feeling of you know certain types of

37
00:01:21,429 --> 00:01:19,520
things you have to mentally do and you

38
00:01:23,429 --> 00:01:21,439

describe that in terms

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00:01:25,429 --> 00:01:23,439

which the patent office will not

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00:01:26,789 --> 00:01:25,439

understand and so it's um i think it can

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00:01:29,830 --> 00:01:26,799

be very difficult

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00:01:33,109 --> 00:01:29,840

to uh draft applications and to focus a

43

00:01:36,390 --> 00:01:33,119

patent in a way that would actually

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00:01:40,390 --> 00:01:38,149

um well i guess one other thing and i

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00:01:42,390 --> 00:01:40,400

think this is probably important for

46

00:01:45,190 --> 00:01:42,400

people here too is if you are ever

47

00:01:48,149 --> 00:01:45,200

thinking about obtaining a patent is

48

00:01:50,310 --> 00:01:48,159

there's a time requirement to get it

49

00:01:52,789 --> 00:01:50,320

into the patent office if you publish

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00:01:54,710 --> 00:01:52,799

your technology you basically have a one

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00:01:55,670 --> 00:01:54,720

year period within which to file

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00:01:56,710 --> 00:01:55,680

something

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00:01:58,389 --> 00:01:56,720

so

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00:01:59,749 --> 00:01:58,399

that that can kind of start a ball

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00:02:02,389 --> 00:01:59,759

rolling you have to actually get moving

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00:02:03,670 --> 00:02:02,399

into the patent office however

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00:02:06,310 --> 00:02:03,680

sometimes

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00:02:08,070 --> 00:02:06,320

you don't know when you're going to

59

00:02:10,469 --> 00:02:08,080

market something you start at the

60

00:02:12,390 --> 00:02:10,479

beginning going i think i was sitting

61

00:02:14,150 --> 00:02:12,400

there and that thing buzzed right when i

62

00:02:15,670 --> 00:02:14,160

was it's like you get these ideas and

63

00:02:17,510 --> 00:02:15,680

then you come out and give a lecture

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00:02:19,670 --> 00:02:17,520

about that before you know it you've got

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00:02:22,070 --> 00:02:19,680

three years of background disclosures

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00:02:24,949 --> 00:02:22,080

before you realize the invention and so

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00:02:26,550 --> 00:02:24,959

you can kind of create um

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00:02:28,790 --> 00:02:26,560

all these earlier disclosures become

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00:02:30,550 --> 00:02:28,800

prior art against yourself

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00:02:32,309 --> 00:02:30,560

so it's like you could create kind of a

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00:02:34,229 --> 00:02:32,319

situation where it's um

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00:02:36,470 --> 00:02:34,239

difficult to be patenting so i think it

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00:02:38,869 --> 00:02:36,480

ends up you you end up with this balance

74

00:02:39,750 --> 00:02:38,879

of if you want to try to protect things

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00:02:41,910 --> 00:02:39,760

is

76
00:02:45,830 --> 00:02:41,920
something should be trade secret some

77
00:02:47,910 --> 00:02:45,840
things you can maybe disclose

78
00:02:49,750 --> 00:02:47,920
and actually with that i think that

79
00:02:51,750 --> 00:02:49,760
sometimes when people

80
00:02:53,190 --> 00:02:51,760
decide well i'll just i'll just disclose

81
00:02:56,630 --> 00:02:53,200
the general stuff

82
00:02:57,430 --> 00:02:56,640
is enough to

83
00:02:59,030 --> 00:02:57,440
uh

84
00:03:00,470 --> 00:02:59,040
negate the possibility of the patent

85
00:03:01,830 --> 00:03:00,480
because when when you apply at the

86
00:03:03,030 --> 00:03:01,840
patent office

87
00:03:05,430 --> 00:03:03,040
sometimes you're just speaking very

88
00:03:07,270 --> 00:03:05,440

general terms so i think it's just that

89

00:03:08,309 --> 00:03:07,280

one's an important thing to understand

90

00:03:10,630 --> 00:03:08,319

and

91

00:03:13,110 --> 00:03:10,640

i think it's definitely a problem in

92

00:03:15,110 --> 00:03:13,120

areas where you might some of the ideas

93

00:03:17,589 --> 00:03:15,120

that people are working on now

94

00:03:19,030 --> 00:03:17,599

might be in in inventions in 20 years

95

00:03:20,470 --> 00:03:19,040

from now you know maybe people will be

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00:03:23,190 --> 00:03:20,480

doing a lot of things with random event

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00:03:25,270 --> 00:03:23,200

generators or other things long term

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00:03:27,910 --> 00:03:25,280

done row but who knows you know when you

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00:03:32,309 --> 00:03:27,920

try to think about patenting now

100

00:03:32,319 --> 00:03:36,070

i think this is um

101
00:03:41,270 --> 00:03:39,270
maybe not the best organized this is a

102
00:03:44,390 --> 00:03:41,280
really more of a

103
00:03:47,350 --> 00:03:44,400
reiteration of some of the concepts that

104
00:03:49,110 --> 00:03:47,360
the emerging technologies are more um

105
00:03:50,789 --> 00:03:49,120
i think complex

106
00:03:52,630 --> 00:03:50,799
uh based on principles that are not so

107
00:03:55,030 --> 00:03:52,640
well understood

108
00:03:58,309 --> 00:03:55,040
um and i think a lot of times difficult

109
00:03:59,830 --> 00:03:58,319
to identify the inventive aspect

110
00:04:01,270 --> 00:03:59,840
a lot of things like you can obtain a

111
00:04:04,470 --> 00:04:01,280
patent when you know you do a certain

112
00:04:06,869 --> 00:04:04,480
process you obtain a patent on a process

113
00:04:09,110 --> 00:04:06,879

when you know the outcome is something

114

00:04:11,110 --> 00:04:09,120

you take certain steps to get there but

115

00:04:13,350 --> 00:04:11,120

if you don't understand what it is

116

00:04:15,910 --> 00:04:13,360

that's happening along the way it's hard

117

00:04:17,030 --> 00:04:15,920

to to get a patent on that and like i i

118

00:04:18,949 --> 00:04:17,040

think about the remote viewing it's

119

00:04:19,670 --> 00:04:18,959

something that i've been into now and

120

00:04:21,990 --> 00:04:19,680

like

121

00:04:23,430 --> 00:04:22,000

yeah you for me i see things you know

122

00:04:25,030 --> 00:04:23,440

and they're really close to the stuff

123

00:04:27,110 --> 00:04:25,040

that's there

124

00:04:28,790 --> 00:04:27,120

i don't exactly know why you know people

125

00:04:29,990 --> 00:04:28,800

talk about it's the higher self it's

126
00:04:31,189 --> 00:04:30,000
this it's that i don't know what's

127
00:04:33,749 --> 00:04:31,199
happening so

128
00:04:35,510 --> 00:04:33,759
can can i identify what it is

129
00:04:37,030 --> 00:04:35,520
that you know in a way that's clear and

130
00:04:39,510 --> 00:04:37,040
concise that would the panoply would

131
00:04:43,270 --> 00:04:39,520
like it i think it would be pretty hard

132
00:04:47,510 --> 00:04:46,150
this is a slide that just goes into uh

133
00:04:49,670 --> 00:04:47,520
talking about some of the complexities

134
00:04:52,310 --> 00:04:49,680
of software and i think i was focusing

135
00:04:53,830 --> 00:04:52,320
on thinking of focusing more on software

136
00:04:55,590 --> 00:04:53,840
because um

137
00:04:57,510 --> 00:04:55,600
i think a lot of the inventions that you

138
00:05:00,950 --> 00:04:57,520

guys might have would probably be in

139

00:05:05,510 --> 00:05:03,430

and one of the problems with software is

140

00:05:07,189 --> 00:05:05,520

a lot of times you maybe have

141

00:05:10,469 --> 00:05:07,199

you're trying to have

142

00:05:12,310 --> 00:05:10,479

interactions between different devices

143

00:05:14,710 --> 00:05:12,320

maybe a server that's

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00:05:16,310 --> 00:05:14,720

located you know anywhere in the world

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00:05:17,749 --> 00:05:16,320

you have people in different countries

146

00:05:20,390 --> 00:05:17,759

sending data back and forth it can be a

147

00:05:23,270 --> 00:05:20,400

lot more complicated than to patent a

148

00:05:26,070 --> 00:05:23,280

system that you can put on your desk

149

00:05:28,230 --> 00:05:26,080

and identify the components another

150

00:05:30,950 --> 00:05:28,240

thing with software

151
00:05:33,189 --> 00:05:30,960
a lot of times and you end up with

152
00:05:35,590 --> 00:05:33,199
you know the inventor comes up with an

153
00:05:37,510 --> 00:05:35,600
idea hires some programmer to do some

154
00:05:38,390 --> 00:05:37,520
stuff gives them general guidelines

155
00:05:39,909 --> 00:05:38,400
before you know it you got the

156
00:05:42,390 --> 00:05:39,919
programmer working on stuff and then

157
00:05:44,230 --> 00:05:42,400
it's a matter of well who invented this

158
00:05:45,430 --> 00:05:44,240
where's the invention lie and i think

159
00:05:47,830 --> 00:05:45,440
that's one of the reasons i brought up

160
00:05:49,350 --> 00:05:47,840
before is you know contracts it's very

161
00:05:51,189 --> 00:05:49,360
important when you are working with

162
00:05:55,670 --> 00:05:51,199
people that if you hiring someone for a

163
00:05:58,150 --> 00:05:55,680

task make sure you own the technology

164

00:05:59,029 --> 00:05:58,160

i only have 20 more

165

00:06:02,629 --> 00:05:59,039

so

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00:06:04,309 --> 00:06:02,639

patent applications

167

00:06:06,710 --> 00:06:04,319

basically

168

00:06:08,230 --> 00:06:06,720

i mean there's also plant patents which

169

00:06:10,550 --> 00:06:08,240

i would think that i don't really know

170

00:06:11,749 --> 00:06:10,560

anything about nobody i would think

171

00:06:13,029 --> 00:06:11,759

would care too much about them but

172

00:06:15,510 --> 00:06:13,039

perhaps in this

173

00:06:16,870 --> 00:06:15,520

room some people can find invention and

174

00:06:18,309 --> 00:06:16,880

i won't think of

175

00:06:20,230 --> 00:06:18,319

that's right yes if you're talking to

176

00:06:21,430 --> 00:06:20,240

plants perhaps will me come to me

177

00:06:23,110 --> 00:06:21,440

afterwards and i'll

178

00:06:24,790 --> 00:06:23,120

find out some more information but

179

00:06:25,670 --> 00:06:24,800

there's uh basically

180

00:06:27,430 --> 00:06:25,680

uh

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00:06:29,350 --> 00:06:27,440

there's utility patent applications it's

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00:06:31,670 --> 00:06:29,360

basically the main type is focusing on

183

00:06:33,189 --> 00:06:31,680

technical inventions and there's design

184

00:06:35,270 --> 00:06:33,199

patents which focus on the way something

185

00:06:36,230 --> 00:06:35,280

looks the orientation of it

186

00:06:37,830 --> 00:06:36,240

and

187

00:06:39,510 --> 00:06:37,840

there's two procedural things you can

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00:06:41,590 --> 00:06:39,520

sometimes file before talk and i'm

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00:06:43,270 --> 00:06:41,600

giving a talk tomorrow you can file a

190

00:06:45,670 --> 00:06:43,280

provisional application

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00:06:48,469 --> 00:06:45,680

uh which is more a filing mechanism to

192

00:06:50,870 --> 00:06:48,479

get you into that notice more quickly

193

00:06:58,070 --> 00:06:50,880

and that is the end of my talk thank you

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00:07:04,870 --> 00:07:02,550

all right we can have questions now sure

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00:07:06,469 --> 00:07:04,880

so uh first of all i want to say thanks

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00:07:08,469 --> 00:07:06,479

for coming and talking to us about

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00:07:10,029 --> 00:07:08,479

patents

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00:07:11,990 --> 00:07:10,039

i believe it's an

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00:07:14,309 --> 00:07:12,000

important thing it's an important

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00:07:17,670 --> 00:07:14,319

function particularly

201
00:07:19,189 --> 00:07:17,680
for the sorts of directions that the sse

202
00:07:21,670 --> 00:07:19,199
is going in

203
00:07:24,070 --> 00:07:21,680
because if you want if a company wants

204
00:07:26,309 --> 00:07:24,080
to develop a technology

205
00:07:27,670 --> 00:07:26,319
they will only invest in it if they know

206
00:07:29,670 --> 00:07:27,680
they can own it

207
00:07:30,790 --> 00:07:29,680
and so having a patent provides a real

208
00:07:33,350 --> 00:07:30,800
function

209
00:07:35,270 --> 00:07:33,360
in uh enabling a company to own

210
00:07:36,469 --> 00:07:35,280
something and therefore invest

211
00:07:39,110 --> 00:07:36,479
and make it real

212
00:07:41,430 --> 00:07:39,120
and tomorrow i'll be talking about a

213
00:07:42,710 --> 00:07:41,440

number of different patents

214

00:07:45,589 --> 00:07:42,720

technology

215

00:07:46,790 --> 00:07:45,599

and these patents have produced

216

00:07:48,950 --> 00:07:46,800

investment

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00:07:50,469 --> 00:07:48,960

and the ability to try to develop these

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00:07:52,790 --> 00:07:50,479

technologies

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00:07:53,990 --> 00:07:52,800

and it is something that we should be

220

00:07:55,350 --> 00:07:54,000

getting

221

00:07:57,430 --> 00:07:55,360

more and more

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00:07:58,950 --> 00:07:57,440

and

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00:07:59,670 --> 00:07:58,960

just want to uh i think this is a good

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00:08:03,270 --> 00:07:59,680

thing

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00:08:22,710 --> 00:08:03,280

uh

226
00:08:26,469 --> 00:08:24,790
if there's trade secrets if you keep

227
00:08:28,230 --> 00:08:26,479
your invention

228
00:08:30,390 --> 00:08:28,240
behind closed doors

229
00:08:32,870 --> 00:08:30,400
then right if you i'm sort of explaining

230
00:08:34,389 --> 00:08:32,880
that if you if you hide it then someone

231
00:08:37,110 --> 00:08:34,399
could come out and patent it if you

232
00:08:38,949 --> 00:08:37,120
disclose it you can actually then

233
00:08:39,829 --> 00:08:38,959
prevent others from being able to patent

234
00:08:41,750 --> 00:08:39,839
it

235
00:08:44,310 --> 00:08:41,760
one of the things you might run into is

236
00:08:46,150 --> 00:08:44,320
you disclose it and what is it you might

237
00:08:47,350 --> 00:08:46,160
disclose the basic idea and then someone

238
00:08:49,430 --> 00:08:47,360

comes out and finds the little

239

00:08:50,870 --> 00:08:49,440

improvement and patents that and stops

240

00:08:53,509 --> 00:08:50,880

the whole world so you

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00:08:55,269 --> 00:08:53,519

it's like sometimes being the first

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00:08:56,550 --> 00:08:55,279

to disclose doesn't necessarily mean

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00:08:58,710 --> 00:08:56,560

that you've

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00:09:00,550 --> 00:08:58,720

protected the whole area and that's

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00:09:07,269 --> 00:09:00,560

actually very common to have later

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00:09:10,150 --> 00:09:08,710

lot of you um associated with

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00:09:12,949 --> 00:09:10,160

universities

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00:09:15,750 --> 00:09:12,959

and uh you have to be very careful

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00:09:18,389 --> 00:09:15,760

because they all have policies of

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00:09:20,150 --> 00:09:18,399

technology transfer policies and you're

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00:09:33,910 --> 00:09:20,160

doing something while you're in the

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00:09:38,389 --> 00:09:35,990

and some don't have any of these

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00:09:39,430 --> 00:09:38,399

guidelines and in that case it belongs

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00:09:41,670 --> 00:09:39,440

to you

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00:09:49,350 --> 00:09:41,680

so you got to make sure you understand

256

00:09:52,550 --> 00:09:50,949

i've is done patent work with the

257

00:09:54,389 --> 00:09:52,560

university of virginia

258

00:09:55,910 --> 00:09:54,399

a good friend of mine is actually a

259

00:09:57,430 --> 00:09:55,920

patent counsel here

260

00:09:58,870 --> 00:09:57,440

and it took me a while to actually admit