

THE UNIVERSITY OF GEORGIA

## GUIDE TO PATENTS FOR FACULTY AND STAFF

PREPARED BY INNOVATION GATEWAY

*The University of Georgia Guide to Patents for Faculty and Staff* is designed to provide University of Georgia faculty and staff members with information about protecting intellectual properties that result from their scientific and creative activities. Innovation role in patenting and marketing intellectual properties is also described.

Faculty and staff members can benefit in several ways when an intellectual property is patented and licensed to a commercial establishment. These may include, but are not limited to, income from license fees and royalties, consulting fees, and research support. Arrangements with private establishments do not preclude dissemination of research findings. For further information about the contents of this booklet or any aspect of the subjects addressed here, please call Innovation Gateway at 706-542-1404 or [gateway@uga.edu](mailto:gateway@uga.edu).

### REPORTING INVENTIONS

University of Georgia faculty and staff members agree, as condition of employment, to abide by the [Intellectual Property Policy of the University of Georgia](#). The policy requires

the University be formally reported to Innovation Gateway through an Invention Disclosure. This can be done using our convenient online disclosure tool, [Sophia](#).

[Georgia Research Foundation.](#)

After licensing, legal, administrative, and other expenses are subtracted from the gross income, the net income is distributed on a quarterly basis as follows: the first \$10,000 to

to the department/unit; 15% to the University of Georgia Research Foundation (Innovation Gateway) operations, and 40% to the University of Georgia Research Foundation Research Fund.

## THE ROLE OF THE RESEARCH FOUNDATION

The Board of Regents of the University System of Georgia has designated the [University of Georgia Research Foundation](#), through Innovation Gateway, as the sole entity at the University of Georgia responsible for protecting intellectual properties and for the transfer of technology developed through the or by University personnel. Thus, in addition to assuming responsibility for protecting intellectual properties, Innovation Gateway also assumes responsibility for marketing intellectual properties and proprietary information to industry, and for reviewing intellectual property agreements related to industry-sponsored research. The ongoing objective of Innovation Gateway is to provide services to the research community and through those services to enhance the Unive institution. **If you think you have an invention that may be patentable, contact Innovation Gateway at 706-542-1404 or at [gateway@uga.edu](mailto:gateway@uga.edu).** After an Invention Disclosure is received, an appointment will be set up to discuss and evaluate your innovation.

## IDENTIFYING POTENTIALLY PATENTABLE INVENTIONS

To identify potentially patentable inventions, scientists should review their work periodically in the context of [United States patent law](#), which states that patents may be granted on:

- A process**, such as a method of using specific molecules for the diagnosis of viral diseases;
- A machine**, such as a new instrument for the synthesis of oligonucleotides;
- An article of manufacture**, such as an assay kit for an infectious disease, or class of diseases;
- A composition of matter**, such as a new molecule (characterized by amino acid sequence or basepairs), or a new chemical compound;
- New and useful improvements** of the above;
- Any distinct and new variety of plant** which is sexually or asexually reproduced;
- Any new, original, and ornamental design for an article of manufacture.**

If an innovation fits into one of these categories, United States patent law also requires that it be:

**New (or novel):** The invention must be demonstrably different from any existing include publications and/or availability of the invention to the public as a commercial product.

**Useful:** The invention must be useful in ways which represent improvements over existing products and/or

- 1) The idea must be protectable, preferably through broad, valid patents, so that the company developing and marketing it can control its use and sale for the life of the patents (20 years from the earliest priority filing date).
- 2) The idea must benefit a substantial segment of society and appeal to a potential development, manufacture, and marketing; the resulting product or process must be profitable.

In reviewing work for potentially patentable ideas as described in the preceding section, scientists should also consider these two additional factors.

## **APPLYING FOR A PATENT**

[Invention Disclosures](#) will be reviewed by Innovation Gateway to determine:

the probability that meaningful patent protection can be achieved, and whether the idea has sufficient commercial appeal to be the basis of a partnership with a company capable of producing and marketing products or processes based on the invention.

When an invention is judged to be both patentable and commercially attractive, a U.S. patent application will be drafted and filed. In most cases, the first filing will be a U.S. provisional patent application. This application does not mature into an issued patent but rather establishes an early effective filing date, provides additional time for an inventor to broaden proof-of-concept data, and allows the inventor to disclose their invention publicly. A provisional patent application must be converted into a non-provisional patent application (such as a U.S. utility patent application or an international patent application) within one year of the provisional filing date, otherwise the provisional patent application is automatically abandoned. Patent applications are submitted to the [United States Patent and Trademark Office \(USPTO\)](#) on behalf of the inventor and the University by outside patent counsel. Patent applications consist of:

an abstract;

it in broad terms and teaches the public how to make and use it;

statements describing exactly what the inventor claims as the invention.

In approximately 1-3 years (the timing of which depends on the backlog of patent applications in the USPTO unit that is examining the application), the patent office issues its first

obviousness; several references (either issued patents or scientific papers) are cited to support this contention. The inventor and patent attorney then must argue that the

