

# Student Inventions

Public Disclosure

Constructive Reduction to Practice

Ownership & Assignment

# Three common Questions from student inventors:

- If I tell someone my idea can I still apply for a patent?
  - Public Disclosure
- Do I have to build my invention in order to apply for a patent?
  - Constructive Reduction to Practice
- Who owns my invention?
  - Ownership and Assignment



If I tell someone my idea can I still  
apply for a patent?

Answer: It depends

- When did you disclose your idea?
- In what countries would you like patent protection?



# Public Disclosure and US Patents

- Public Disclosure of the invention by anyone more than one year before patent application is filed eliminates rights to a US patent
- 35 U.S.C. The Patent Statute 102(b):

“A person shall be entitled to a patent unless... the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country more than one year prior to the application for patent in the United States . . .”



# What constitutes “Public Disclosure”?

- traditional printed publications, journal articles
- posting on a website
- poster presentations
- class presentations
- public use (exception: “experimental use”)
- non-confidential discussions with others
- offer for sale (even if you do not fully disclose the invention details)



# Public Disclosure and International Patent Rights

Most countries do not have a one year grace period. Public disclosure before the application is filed eliminates patent rights in most countries.

- Exceptions: Canada, Australia and New Zealand have a 1 year grace period similar to US law

## Use of PCT applications

- Patent Cooperation Treaty – Includes most countries where patent filing may be desirable.
- Allows for filing a single application in any PCT member country to establish a “filing date.”
- This means you can file a US application prior to your public disclosure and later pursue coverage in other PCT countries.
- The PCT application must be filed within 1 year of the first “filing date.”

# Do I have to build my invention in order to apply for a patent?

Answer: No, however

- Application must describe in words and with figures how to make and use your invention to the extent that a person of “ordinary skill” would be able to duplicate your invention by reading your patent.
- Application must convey with reasonable clarity that the inventor was in possession of the invention at the time of filing.
- Filing a patent application with such a description is considered “Constructive Reduction to Practice.”



# Who owns my invention?

Maybe . . .

- You and your co-inventors?
- The organization where you work?
- The university?
- A funding agency?







# Inventors

- Patent is the right granted to the inventor(s) to prevent others from making and using the claimed invention.
- If no pre-agreements exist, co-inventors have equal right to use the invention or allow others to use the invention without any obligation to the other inventor(s)
  - Regardless of who pursues and pays for the patent



# Ownership by Assignment

- If you develop an invention in your future career you will likely have an obligation to assign ownership of your inventions to the company or organization where you are employed.
- Usually, this is one of many documents you sign when you begin with a new employer.
- Often it is incorporated into a standard confidentiality agreement.



# Ownership of inventions at UW

- If you develop an invention as part of a class project under University of Wisconsin Policy, inventors are allowed to own the patent.  
(Unusual policy)
- Exception: specific funding was used to make the invention (Unusual for undergraduate design projects).
  - Federal funding(if UW decides not to patent the federal government owns the invention)
  - Specific funding that has patent/intellectual property provisions (industrial or other non-profit grants)



# More on Public Disclosure & Patentability

- If the invention has been described in a printed publication anywhere in the world, or if it was known or used by others in this country before the date that the applicant made his/her invention, a patent cannot be obtained. If the invention has been described in a printed publication anywhere, or has been in public use or on sale in this country more than one year before the date on which an application for patent is filed in this country, a patent cannot be obtained. In this context it is immaterial when the invention was made, or whether the printed publication or public use was by the inventor himself/herself or by someone else. If the inventor describes the invention in a printed publication or uses the invention publicly, or places it on sale, he/she must apply for a patent before one year has gone by, otherwise any right to a patent will be lost. The inventor must file on the date of public use or disclosure, however, in order to preserve patent rights in many foreign countries.
- Obviousness: Even if the subject matter sought to be patented is not exactly shown by the prior art, and involves one or more differences over the most closely related thing already known, a patent may still be refused if the differences would be obvious. The subject matter sought to be patented must be sufficiently different from what has been used or described before that it may be said to be nonobvious to a person having ordinary skill in the area of technology related to the invention. For example, the substitution of one color for another, or changes in size, are ordinarily not patentable.