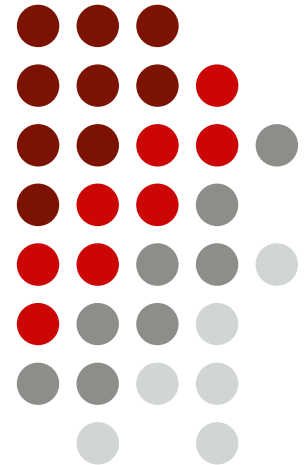
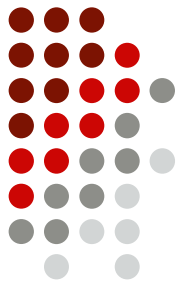


# Introduction to IP *and* Interacting with the OTL

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Jessica Connor  
*IP Manager, Baxano, Inc.*  
*Patent Agent, ShayGlenn, LLP*



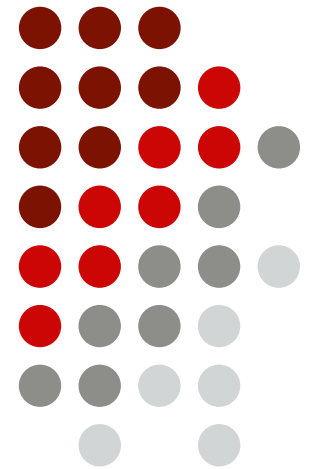


# Background

- BS:ME (U of M) and MS:BME (Stanford)
- Stanford Biodesign Innovation Fellow (2006)
- Baxano, Inc., Intellectual Property Manager
- ShayGlenn, LLP, Patent Agent
- Schox Patent Group, Senior Patent Agent
- Lecturer at Stanford Schools of Law and Engineering
- Engineer: IDEO, J&J (Ethicon), Stryker

# Introduction to IP

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US000435610S

**United States Patent** [19]  
**Krämer**

[11] **Patent Number: Des. 435,610**

[45] **Date of Patent: \*\* Dec. 26, 2000**

[54] **JUMPING SNAIL.**

[76] **Inventor: Rolf Krämer, Teslastr. 6, 74670 Forchtenberg, Germany**

[\*\*] **Term: 14 Years**

[21] **Appl. No.: 29/106,579**

[22] **Filed: Jun. 16, 1999**

[51] **LOC (7) Cl. .... 21-01**

[52] **U.S. Cl. .... D21/650**

[58] **Field of Search .... D11/158; D21/415, D21/419, 576, 585, 587, 588, 650; D30/160, 446/72, 97-98, 268, 278, 327, 328, 367, 368, 369, 396**

[56] **References Cited**

**U.S. PATENT DOCUMENTS**

D. 163,254 5/1951 **Burke** ..... D21/415

D. 182,525 4/1958 **Lavenson** ..... D21/650  
D. 244,224 5/1977 **McClary** ..... D21/585  
D. 388,839 1/1998 **Itskob** ..... D21/419

**OTHER PUBLICATIONS**

Folkmanis Puppets 1994/95 Catalog, p. 13, Snail Puppet.

*Primary Examiner*—Sandra L. Morris  
*Attorney, Agent, or Firm*—Klaus J. Bach

[57] **CLAIM**

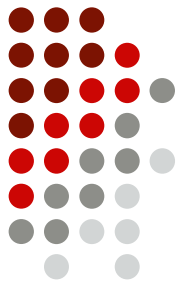
The ornamental design for a jumping snail, as shown and described.

**DESCRIPTION**

FIG. 1 is a front view of the jumping snail; and, FIG. 2 is a perspective side view of the jumping snail shown in FIG. 1.

**1 Claim, 2 Drawing Sheets**





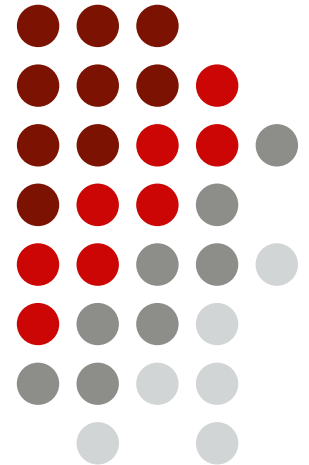
# Sections of a Patent

- Bibliographic Information
- Drawings and the Detailed Description
  - form the **Technical Section** of the patent
  - enable the reader how to make and use the invention
- Claims
  - form the **Legal Section** of the patent
  - define the rights of the patent

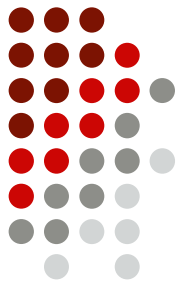
# QUESTION

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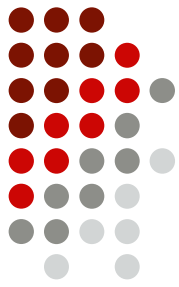
What are the requirements to obtain a patent from the Patent Office?



# Requirements for Patentability



- Useful
  - the invention, when made, must perform some useful function
- Novel
  - the invention must not have been “known or used by others in this country, or patented or described in a printed publication in this or a foreign country”
- Not Obvious
  - “the differences between the subject matter sought to be patented and the prior art ... [must not] have been obvious at the time the invention”



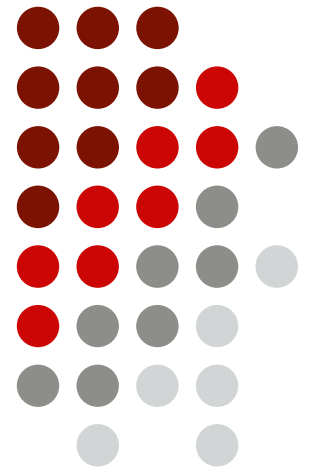
## Note:

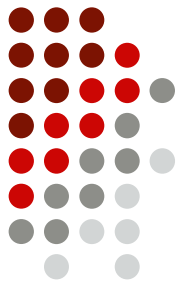
- Claims define the subject matter that must meet the requirements of patentability
- An invention may be patentable if claims can be written that distinguish the invention from previous inventions
  - the claims can define novel and not obvious subject matter



# QUESTION

What are the requirements to be an inventor on a patent?

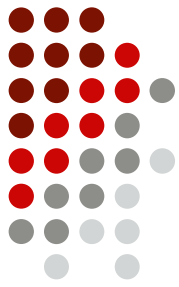




# Test for Inventorship

- The inventor of patent application is the individual (not a corporation) who conceived of (or made a contribution to the conception of) the invention

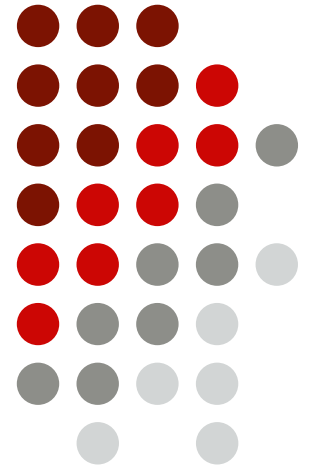
# Test for Inventorship



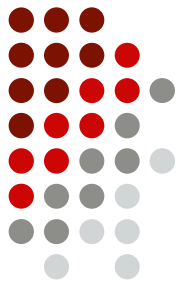
- Conception has been characterized as “the complete performance of the mental part of the inventive act”
- Conception is "the formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention....”
  - An invention is complete and operative “only when the idea is so clearly defined in the inventor's mind that only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation.”

# QUESTION

Who are the owners of a patent?

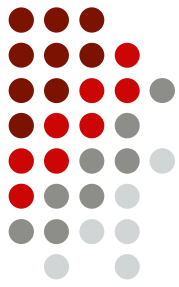


# Test for Ownership



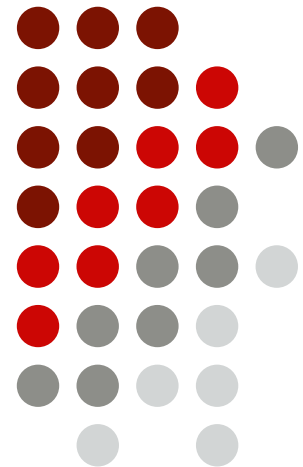
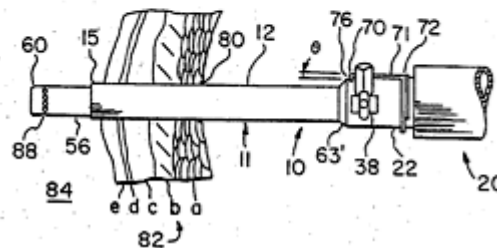
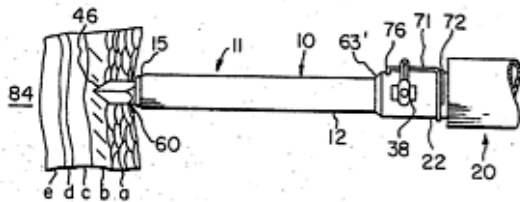
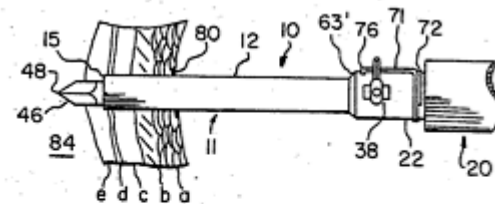
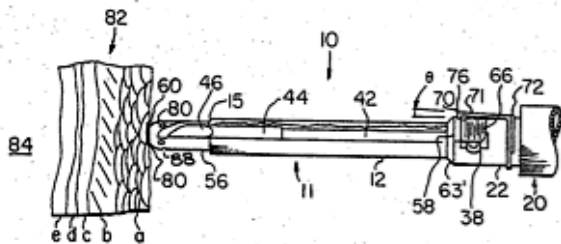
- The inventors named on a patent application are the owners of the patent until and unless they transfer their interest to another person or entity.
- Only the inventors themselves, or those who receive interest from the inventors, can own a patent or patent application.

# Joint Ownership

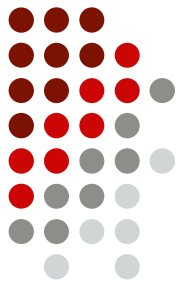


- “In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use, offer to sell, or sell the patented invention ...without the consent of and without accounting to the other owners.” (35 U.S.C. 262).
- Each of the inventors has ***full*** rights to the ***entire*** patent

# Ethicon Inc. v. U.S. Surgical Corp. (Fed. Cir. 1998)



# FACTS



- Yoon (the only inventor listed on the patent) exclusively licensed his rights in the 4,535,773 patent to Ethicon.
- US Surgical infringed the patent for several years.
- Yoon/Ethicon brought an infringement lawsuit against US Surgical regarding the 4,535,773 patent.

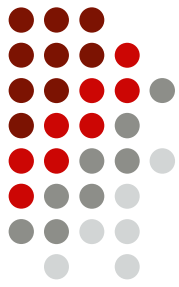


# FACTS

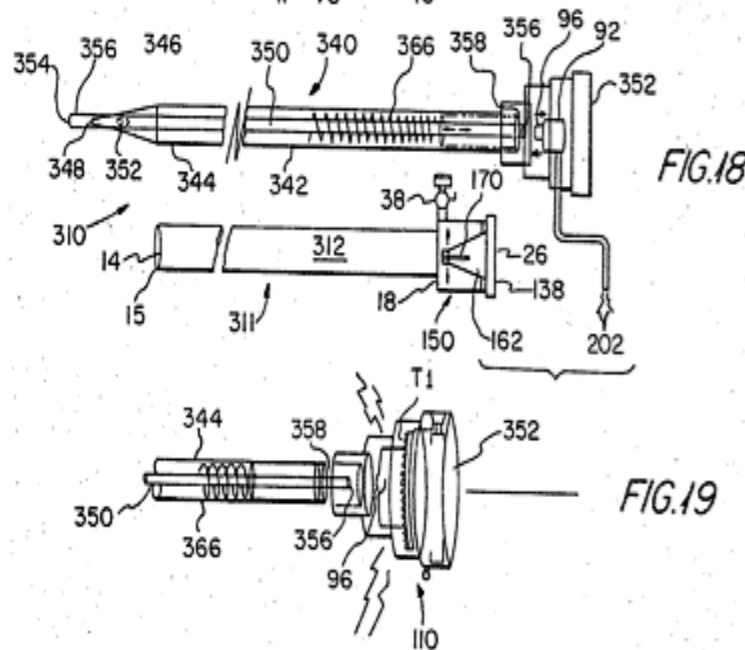


- The district court ruled that Choi was an omitted co-inventor of two claims of the patent.
- Choi did not consent to the lawsuit against US Surgical.
- Choi, an omitted co-inventor of the patent, offered US Surgical a retroactive license to the patent.

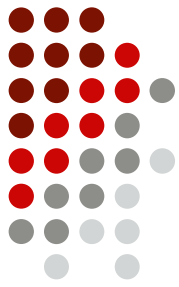
# HOLDING - INVENTORSHIP



- Choi conceived of at least one of the elements of the claims and, therefore, is co-inventor of the patent.



# HOLDING - OWNERSHIP

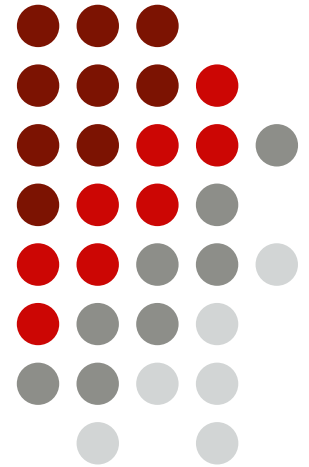


- One co-inventor cannot release a party for past infringement against another co-inventor.
- Both inventors, however, must agree to bring a lawsuit.
- Since Choi did not consent to an infringement suit against US Surgical, the lawsuit lacks the participation of a co-owner of the patent.
- Accordingly, the court must order dismissal of this suit.

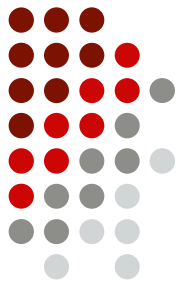
# GROUP QUESTION

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When considering the acquisition or licensing of a patent, what questions would you ask the inventor(s) to ensure that the proper inventors have been named?



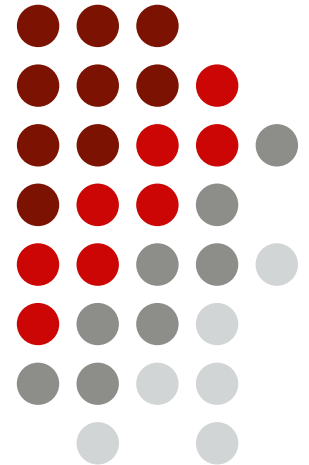
# Ownership issues arise in...

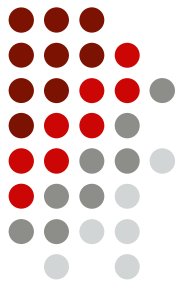


- long term relationships with suppliers and other third parties, such as joint development arrangements, licenses, joint ventures and supply agreements
- purchase orders with both customers and suppliers
- handling of confidential technology developed by others
- **University research settings**

# Interacting with the Stanford OTL

OTL Mission: *“To promote the transfer of Stanford technology for society’s use and benefit while generating unrestricted income to support research and education.”*

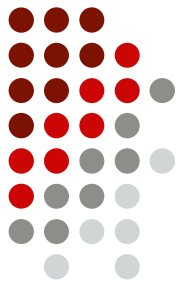




# IP Ownership Policy

- Who do Stanford Policies Apply to?
  - All faculty, staff, and student employees (most graduate students are student employees)
- What do Stanford Policies Apply to?
  - Work done in the course of one's University responsibilities or with more than incidental use of University resources

# IP Ownership Policy



- Patentable Technology

- University takes title to all inventions created with more than incidental use of University resources
- [www.stanford.edu/dept/DoR/rph/5-1.html](http://www.stanford.edu/dept/DoR/rph/5-1.html)

- Copyrighted Works

- University takes title to copyrightable works created with significant University resources
- [www.stanford.edu/dept/DoR/rph/5-2.html](http://www.stanford.edu/dept/DoR/rph/5-2.html)

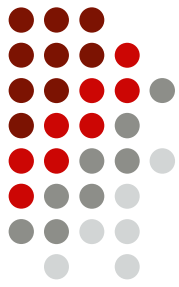


# Royalty Distribution Policy



- Start with Cash Royalties
- Deductions
  - 15% for administrative expenses
  - out-of-pocket expenses (e.g., patent costs)
- Net Royalties
  - 1/3 to Inventors
  - 1/3 to Inventors' Departments
  - 1/3 to Inventors' Schools

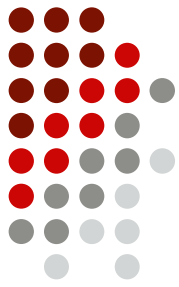
# Typical Steps in the Licensing Process



- Evaluation
- Licensing Strategy
- Patenting Decision
- Marketing Strategy
- The License
- Maintaining the Relationship

*<http://otl.stanford.edu/inventors/process.html>*

# Typical Steps in the Licensing Process



- Evaluation
  - Invention development status
  - Inventor profile
  - Intellectual property position
  - Commercial potential
  - Licensing potential

*<http://otl.stanford.edu/inventors/process.html>*

# Inventors' Role in the Licensing Process



- Disclose inventions
- Identify potential licensing prospects
- Participate in patent preparation and prosecution
- Host visits and/or provide technical information to potential licensees
- Provide input into the licensing strategy
- Sometimes consultant to licensee(s)