

When and How to File Patent Applications
on University Discoveries
- Considerations That Apply

- 1) conception (prior to or in the course of a research project)
- 2) documentation of the invention
 - a) laboratory notebooks - witnesses
 - b) invention disclosure forms - witnesses
 - c) reports to sponsor, etc.
- 3) reduction to practice
 - a) actual
 - b) constructive
- 4) novelty search
 - a) literature and open market
 - b) patent art
- 5) evaluation of invention in view of prior art. (realistic appraisal)
 - a) potential market
 - b) commercial interest
- 6) what is to be licensed, sold, or leased - claims to cover
 - a) product
 - b) process
 - c) royalty base
 - d) royalty rate
- 7) decision to file -- on what and when
 - a) product
 - b) process or method
 - c) product-by-process, etc.

- 8) Instructions to patent attorney
 - a) Complete disclosure
 - b) Fraud on Patent Office -- patentability report
- 9) Contents and form of the application
 - a) Abstract
 - b) Description of the prior art
 - c) Summary of the invention
 - d) Brief description of the drawings
 - e) Detailed description of the preferred embodiment
 - f) Claims
 - g) Formal papers
(Petition, Oath, Declaration, Power of Attorney, and Assignments)
- 10) Foreign filing - export license
- 11) Office Actions - cited art etc.
- 12) Amendments and arguments
- 13) Allowance and final fees