

- UPR Invention Disclosure
  1. All relevant information from personal knowledge
  2. Mandatory

**Examination Process: United State Patent Office (USPTO):**

- Application review
  - The examiner evaluates grammar, drawings, claims, and forms.
- Prior Art Search
  - Search for patents relating to the invention by classification and keywords.
  - Search for non patents relating to the invention.
    - Examples:
      - Thesis
      - Journals
      - Internet
      - Conference
      - Publication
      - Other sources of information
- Patentability Determination
  - Meets the requirements for patentability.
- Notification of the Official Action
  - It is an Official document with a description and explanation of:
    - Examiner's findings
    - Notice of references cited by the examiner with copies of the references.
- Examiner's Decision

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# WHAT IS A PATENT?



## What is a Patent?

It is a document issued by the Federal Government, through the United States Patent & Trademark Office (USPTO), which grants the exclusive right of ownership over an invention for a limited time in exchange for public disclosure.

## What is Patentable?

1. Process or Methods
2. Machine
3. Manufacture
4. Compositions of Matter
5. Plants (asexually reproducing)
6. Designs

## What is No Patentable?

1. Physical or Natural Phenomena
2. Laws of Nature
3. Abstract Ideas
4. Mathematical Formula
5. Printed Matter (forms)

## Types of Patents:

1. **Utility:** Protects the structure, composition or operation of a product, or process. In other words, define what the invention is and how it works.
2. **Design:** Protects only the ornamental appearance of a product. Therefore, the protections not cover the structure, composition or function of the product. It cannot be used for anything that does not have an ornamental appearance.
3. **Plants:** Protect plants that are created by humans or discovered plants that are asexually reproduced.

## Three Requirements of Patentability:

1. Novelty
2. Utility
3. Nonobviousness

## Benefits of Having a Patent:

1. Limited monopoly to encourage production of utilitarian works in exchange for immediate disclosure and ultimate enrichment of the public domain.

2. Exclusive rights to make, use, sell, offer to sell, or import innovation.
3. Patent gives the inventor the right to sue not only those who steal his invention, but those who reverse engineer it and even those who develop the same invention independently.

## Federal Laws:

1. Bayh-Dole Act: Bayh-Dole grants nonprofit organizations, including colleges and universities, and small businesses the right to elect to retain title to inventions made in whole or in part with federal funds and to grant exclusive licenses to practice inventions made. In return for the elections rights, the nonprofit or small business must meet certain reporting requirements, federal licensing provisions, and other requirements.
2. Cooperative Research and Technology Enhancement (CREATE) Act of 2004: The Act made changes in U.S. patent laws to promote collaborating research and development among universities, government, public sectors, and the private sector by removing an obstacle to the patentability of inventions that result from their collaboration. Provides for the exchange of confidential information under a joint research agreement in effect on or before the date on which the invention was made.
3. Leahy-Smith American Invents Act (AIA): This Act makes substantial changes to Patent Law.
  - a. Establishing a "first-inventor-to-file," which will simplify the U.S. patent application system and harmonize it with others around the world;
  - b. Providing the opportunity for third parties to submit information regarding pending patent applications and creating a post-grant opposition proceeding to identify patents that should not have been granted. Both these changes will improve patent quality, which will promote investment and job growth;
  - c. Improving the system to administratively challenge patents, which will speed adjudication of meritorious challenges and

- a. provide faster resolution and certainty for patent holders facing unsubstantiated challenges;
- d. Create an additional evaluation process as an alternative to the regular process;
- e. Reducing fees for small and micro-entities by as much as 75%, which will foster innovation; and
- f. Prohibited from obtaining patents for tax strategies.

## Documentation for Record:

- Preserve all types of annotations, records, journal of the investigation or invention.
- Complete writing description
  - Step by step of the invention
  - Pictures, Drawings
- Legitimize the process
  - Signature
  - Date
- Confidentially Agreement

## Patent Application:

- Writing description of the Investigation:
  1. Title of the Invention
  2. References related to the invention
  3. Statement on research and development sponsored by the federal government
  4. Reference material on CD
  5. Background of the invention
    - Area of the invention
    - Description of related art
  6. Summary of the invention (Brief)
  7. Description of the drawings
  8. Detailed description of the invention
  9. Claims
  10. Abstract
  11. Sequence listing
  12. Drawings
  13. Forms
    - IDS
    - Signatures