

Understanding Intellectual Property Decisions

For more information on GT and Emory's Intellectual Property Policies:

GT: <https://catalog.gatech.edu/policies/intellectual-property/>

Emory: https://cpb-us-w2.wpmucdn.com/sites.gatech.edu/dist/6/426/files/2019/03/Emory_Policy7p6_IP.pdf

I'm interested in patenting an invention. Am I ready?

If you believe that, through your research activities, you invented something, like a process or a device, that is worthy of being patented, file an invention disclosure (ID) through your organization's technology transfer office. While there is never a wrong time to file an ID, disclosures should only be submitted if there are **data that can justify an invention** and if the invention is **intellectually novel and has commercial value**. However, your tech transfer office (TTO) will ultimately determine whether the invention is patentable and has commercial value. If your invention is patentable, the tech transfer office will coordinate with patent counsel (internal or external) to file an application.

Before filing an ID, it is incredibly important to **understand the market size of the technology as well as the competitive landscape and prior art related to your technology**. These considerations represent a vital step toward ensuring that your technology has patentability.

File an ID through your primary institution's TTO:

Emory: <https://ott.emory.edu/resources/forms.html>

Georgia Tech: <https://disclosures.gtcr.gatech.edu/technology/login.php>

What factors go into a making a decision to file a patent application?

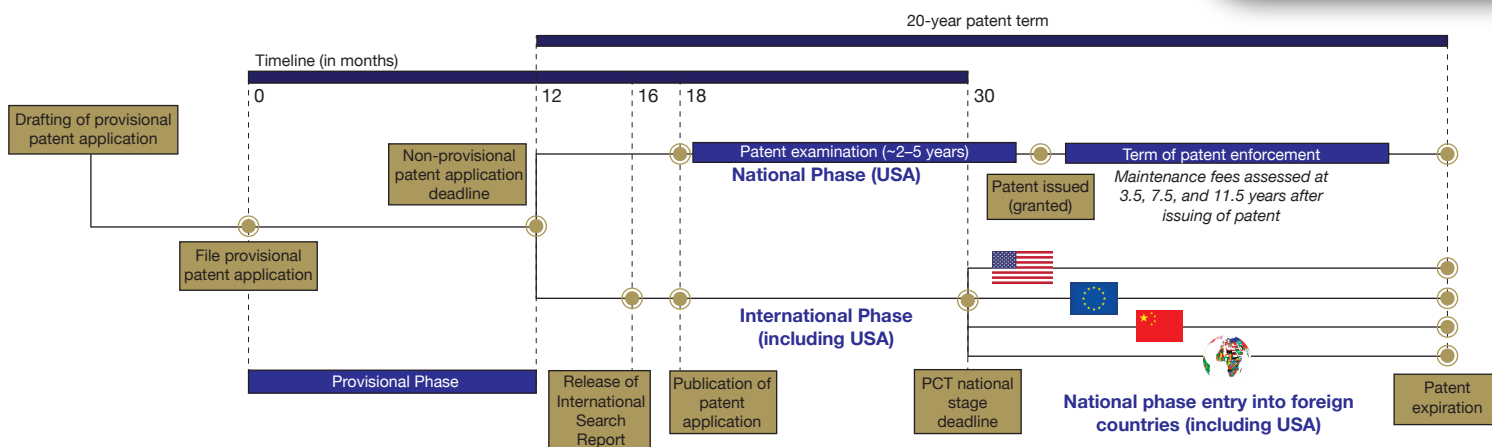
- For an invention to be patentable, it must meet certain criteria:
 - **Novelty:** is the invention unique?
 - **Utility:** how useful is the invention to the public?
 - **Non-obviousness:** can your invention be replicated based on prior art by someone with knowledge in the same field?
 - **Subject matter:** cannot patent natural and physical phenomena or abstract ideas.
- Upon submitting an ID, your institution's TTO will evaluate each ID and make an assessment on whether the technology is ready for submission of a provisional application, whether additional information is needed to support the submission of a patent application (i.e., applications, market analysis, etc.), or if the technology is not patentable. This will occur during or after consultation with the inventors.
- Oftentimes, ID's containing inventions that are similar to previous filed ID's and/or patents are submitted to TTOs. While it is still encouraged to disclose these technologies to your institution's TTO, the licensing associate managing the ID will need to ensure that the technology is **novel and non-obviousness** and has commercial applications that differentiate it from previous technologies patented and/or disclosed before proceeding with filing a provisional application.
- Have there been any public disclosures, enabling or not, about the invention?

What happens after a provisional patent application has been submitted?

Upon filing a provisional patent application with the United States Patent and Trademark Office (USPTO), inventors are allowed 12 months to decide whether to continue seeking a patent or abandon the application. During this period, the inventors can conduct market research, as well as gather additional data and specify claims relevant to their invention, so long as the data and claims disclosed within the non-provisional application are not outside the scope of the invention originally filed. **This is why it is essential to prepare a series of claims, even if broad, in the provisional application to ensure that the technology is specified as best as possible in the provisional.**

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Stages of IP Protection



What factors go into converting a provisional patent application into a non-provisional patent application?

- It is important to highlight that not every provisional patent application will be converted to a non-provisional application for a variety of different reasons. To increase the likelihood of the TTO converting a provisional to a non-provisional application, it is important that:
 - the technology has a high commercialization potential, especially in multiple markets outside the United States.
 - the inventors can identify potential licensees or have actual licensees.
 - the claims specified in the non-provisional application are robust enough to give the application a high probability of being allowed so the patent will be granted.
- Depending on the institution (either Emory or Georgia Tech), the progress on the development of the technology will be assessed around 9 months into the provisional phase. At this time, the inventors should demonstrate that significant progress has been made on the development of the technology and that the

Should I file only in the US or a PCT application?

- If the invention meets the criteria to file a non-provisional application, the next step is to decide where to file it. The most common path at academic institutions is to file a U.S. utility patent, in particular because the costs of filing a PCT application is more expensive than a U.S. utility patent application. However, the determination to file a PCT application can be made if:
 - there is a licensee or (promising) potential licensee who can pay for the patent costs through a license agreement.
 - the inventors have provided evidence that the technology has high commercialization potential in certain international markets.
 - the inventors have demonstrated a history of high-value patents that have been licensed.