

Top 3 Inventor Traps

And how to avoid them

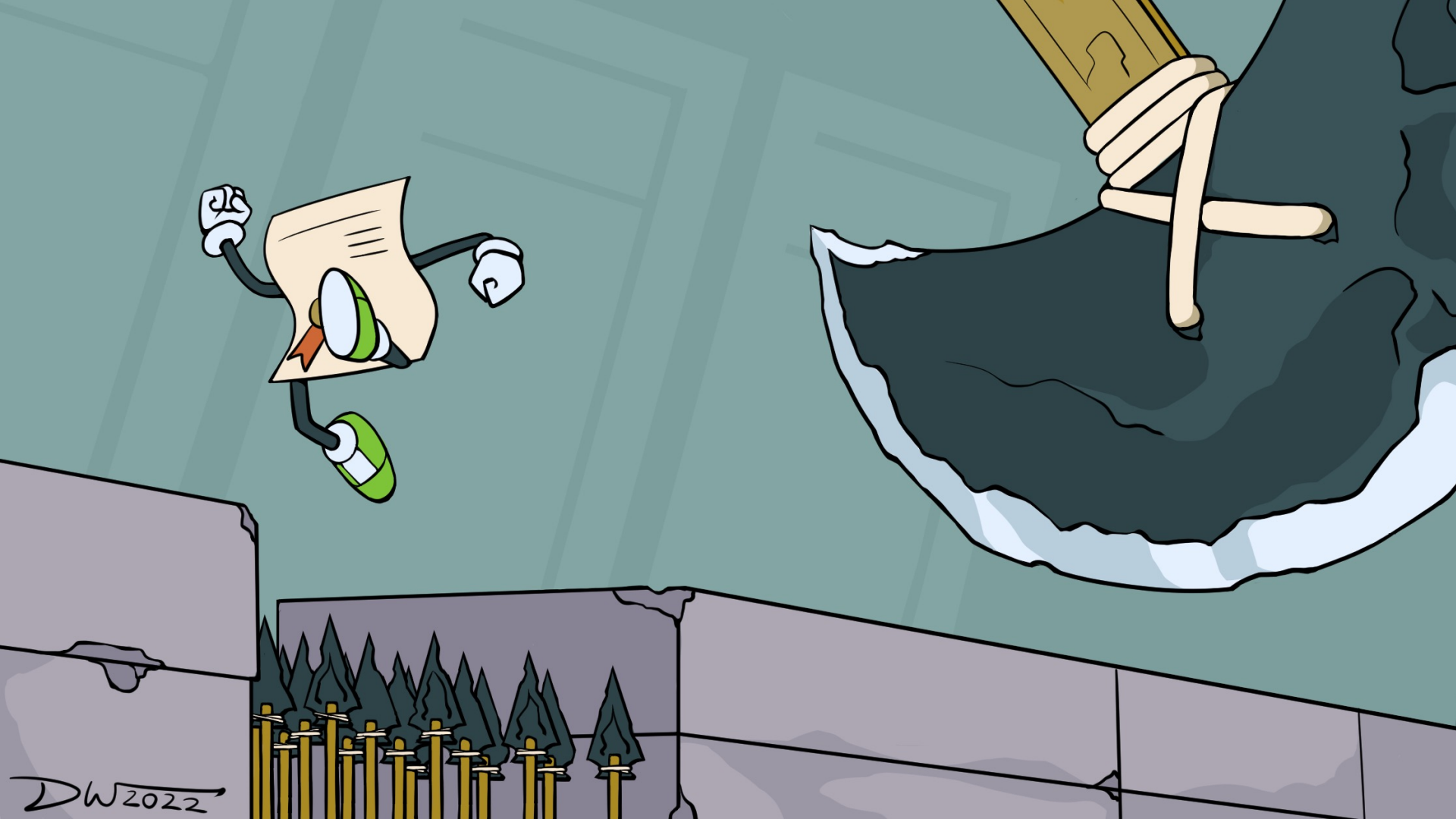
ASHLEY SLOAT, Ph.D. | August 18, 2022

This presentation is for information purposes only and does not constitute legal advice.



Ashley Sloat, Ph.D.

President & Director of Patent Strategy



DW2022

The value of a patent

- **Goal:** Maximize use of funding, grow, and protect your IP from being copied.
- **Patents** are the strongest form of protection and one of the best possible returns on investment.

\$338,000
median portfolio
value with
1 issued
patent

\$1.1 MM
avg valuation
per patent in
software co
IPOs

35X
higher growth
for companies
that apply for
patents

Introductions.

Top 3 Traps.

1
Disclosure

2
Search

3
Ownership

Overview: **Public Disclosure**



- Trade Exclusivity for Public Disclosure
- Rejection Risk: Sales and Disclosures
- What constitutes Public Disclosure / Sale?
- The Opportunity Cost Problem
- Provisional Patents and Grace Periods
- First to File System
- Workshop Interactive

Patent:

limited monopoly of 20 years in exchange for publication of the invention, to promote the progress of the useful arts

Disclosure **Rejection** Risk

A person shall be entitled to a patent unless—

the claimed invention was ... **on sale, or otherwise available to the public** before the effective filing date of the claimed invention...

What constitutes **public disclosure?**

- Presenting or publishing your patent-ready invention
- Responding to an RFP if the technology is patent-ready
- Selling or offering for sale your technology

What constitutes **public sales?**

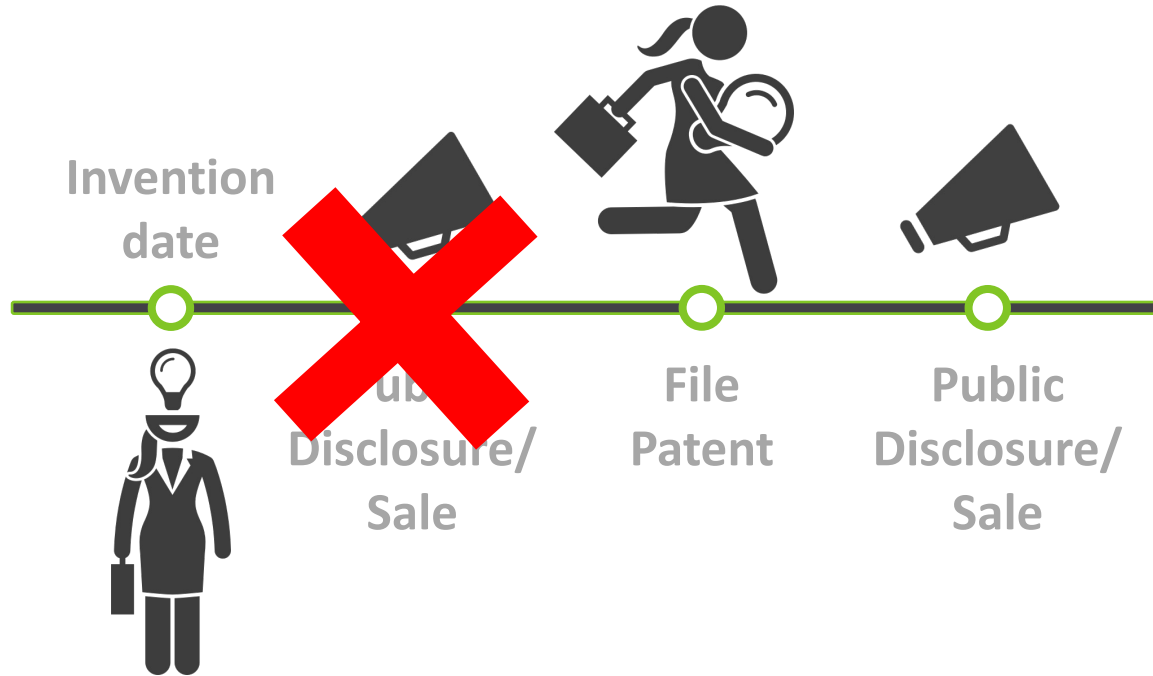
Not an offer for Sale

- Advertising a product not yet developed
- Pre-announcing a product
- Transferring technical knowledge about a process
- Manufacturing agreements
- “Experimental” use

Likely an offer for sale

- Licensing agreements
- Performance of services related to a product
- Providing technical drawings to a potential licensee
- Unaccepted/cancelled orders
- Secret sales

When to publicly disclose...

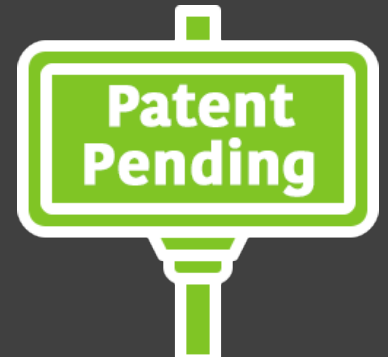


The **Opportunity Cost** Problem



Solution: **provisional** patent

- Placeholder patent application
- Pends for one year
- Priority document for future filings



But, But, But... if you did publicly disclose:

- **One-year** grace period:

- U.S.
- Brazil
- Australia*
- Canada*
- S. Korea
- Mexico

- **6-month** grace period:

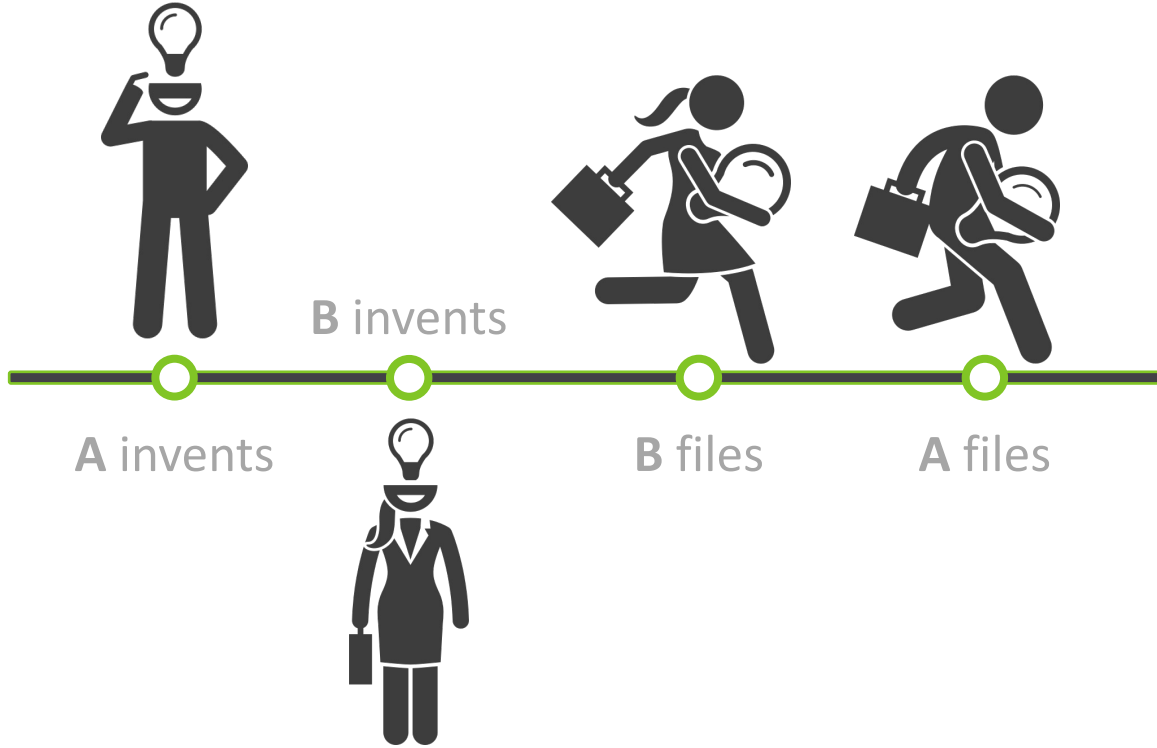
- Japan*

- **No** grace period:

- China
- Europe
- India

* Prior to International Filing

First (Inventor) to File



File early and often!



B WINS!

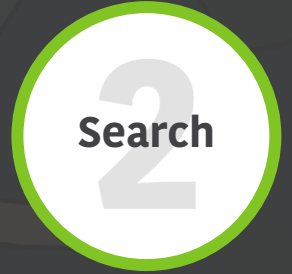
Top 3 Traps.

1
Disclosure

2
Search

3
Ownership

Overview: Search



- Short and long-term interests
- Prior art
- Patentability, Freedom to Operate, and Invalidity
- Anatomy of a patent
- Workshop Interactive

Short and long-term interests

Short: Getting a patent / practicing without infringing others

Long: Keeping a patent / enforcing patent rights

Prior Art – The Target of your Search

Prior art is any evidence that your invention was already publicly known or available, in whole or in part, before the effective filing date of your patent application.

Prior Art Examples

- Available products
- Selling or offering for sale the invention
- Confidential sales
- Articles, publications, websites
- Tradeshows, presentations, demonstrations
- Previously filed patent applications or patents

Patentability, FTO, and Invalidity





PATENTABILITY

Patenting your
invention

FREEDOM-TO-OPERATE

Right to practice
your invention

Patentability **vs.** Freedom-To-Operate

- Patentability: **others are excluded** from making, using, offering for sale, selling, or importing your invention into the United States
- Freedom-To-Operate: **you are not excluded** from making, using, selling, or importing your invention into the United States



Patentability **vs.** Freedom-To-Operate

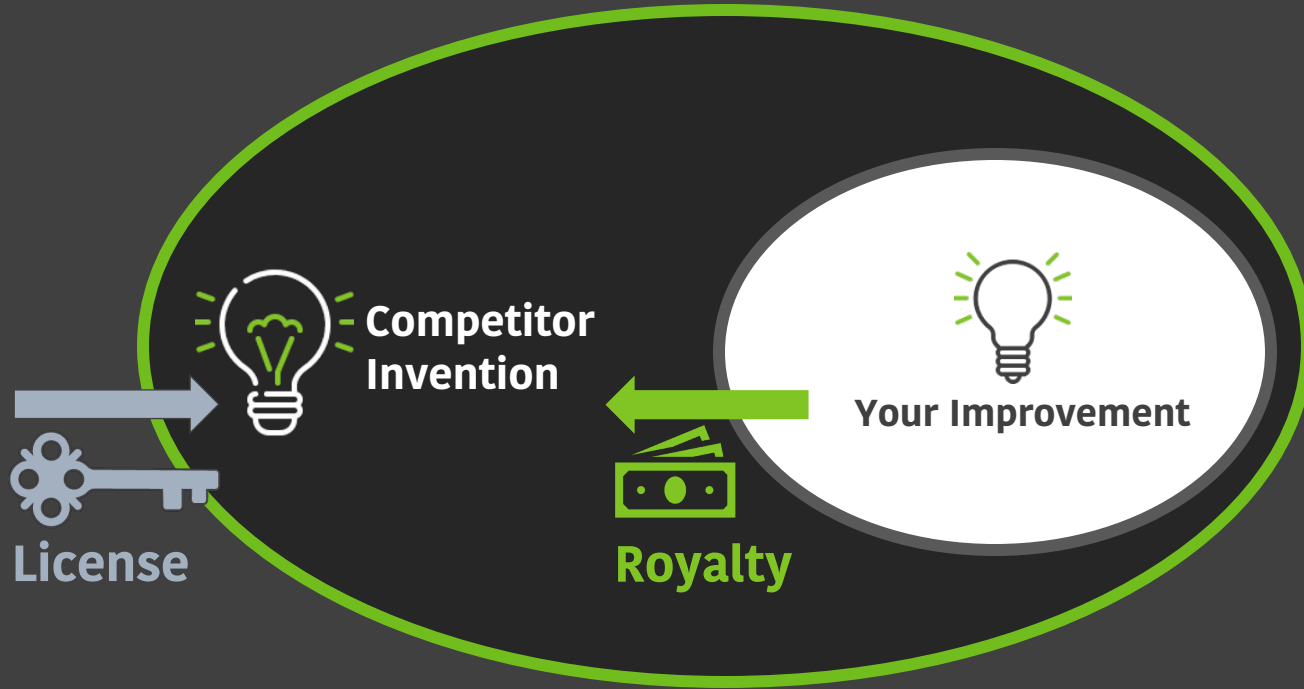


Your Improvement



Competitor Invention

Patentability vs. Freedom-To-Operate



“Art” or “references” used...

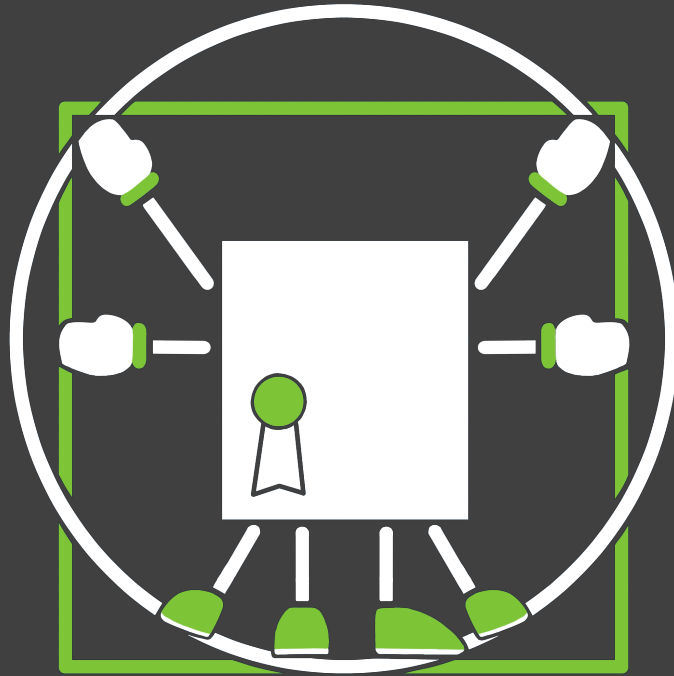
Patentability/Invalidity

- Websites
- Journal Articles
- Patents and patent apps
- Dissertations
- Videos

Freedom-To-Operate

- Issued patents
- Not expired
- Maintenance fees paid

The **Anatomy** of a Patent



Parts of a Patent

1. The front (or cover) page(s)
2. Drawings
3. Specification
4. Claims

Patentability



Search Tools

- **Patent Databases** – Google Patents, Espacenet, USPTO, Lens
- **Non-Patent Literature Databases** – NCBI, Google Scholar, Lens, your favorite search engine
- **AI Databases** – PQ.AI



SEARCH TERMS ⓘ



About 242 results



((noninvasive) (arm OR wrist) (stroke) × or (temperature sensor) (wearable) (left side and right side asymmetry))

+ Synonym

+ Synonym

SEARCH FIELDS

📅 Date · Priority ▾

YYYY-MM-DD — YYYY-MM-DD

👤 + Inventor

📅 + Assignee

Patent Office ▾ Language ▾

Status ▾ Type ▾

Litigation ▾

Sort by · Relevance ▾ Group by · None ▾ Deduplicate by · Family ▾ Results / page · 10 ▾

System and method for multivariate stroke detection

[WO US CN AU CA · CN113347916A](#) · 迈克尔·斯特拉瑟 · 因普瑞缇夫护理公司

Priority 2019-10-15 · Filed 2020-10-14 · Published 2021-09-03

56. The **wearable** system of claim 54, wherein the stimulus source comprises a power source. 57. The **wearable** system of claim 54, wherein the comparison includes determining a change in a vasodilation response. 58. The **wearable** system of claim 54, wherein the stimulus source comprises a Peltier ...

Systems for collecting thermal measurements of the face

[US DE · US10113913B2](#) · Arie Tzvieli · Facense Ltd.

Priority 2015-10-03 · Filed 2016-10-03 · Granted 2018-10-30 · Published 2018-10-30



100 (right periorbital region), respectively. Thermal cameras 95 and 96 are located on **arms** on the left and right sides of the bottom of the frame 90, respectively, and they take thermal measurements of ROI 101 (left side of bottom half of face) and ROI 102 (right side of bottom half of face), ...

Method and apparatus for determining critical care parameters

[WO EP US CN HK IL · US20120245439A1](#) · David Andre · David Andre

Priority 2008-11-20 · Filed 2009-11-20 · Published 2012-09-27



wherein the physiological parameter is determined by a method selected from the group consisting of measuring heart rate, skin surface potential, chest volume change, surface **temperature probe**, esophageal or rectal probe, heat flux, skin conductance, skin surface potentials (EMG, EEG), eye movement ...

Workshop Interactive 2: Search



Hi there!

Register/Sign in ▾

Apps ▾

Search

CPCs

GAUs

Concepts

Keywords

</> Resources <

🔗 Links <

● What's new?



Website Blog

Search

Apps / Search

Search form

Search query

Sample queries ▾

Wearable device on a wrist or arm for detecting a stroke using temperature asymmetry between left side and right side

Search

Clear

Published after



YYYY-MM-DD

Published before



YYYY-MM-DD

Document type

Patents ▾

Search type

Novelty ▾

Page 1

Results

Insights

<https://ppubs.uspto.gov/pubwebapp/>

Reset Layout New

Quick Search Advanced Search

Search x

(wearable) AND (wrist OR arm) AND (noninvasive) AND (temperature) AND (sensor) AND (asymmetry) AND stroke

Pos 52

Options Clear Search

Document Viewer x

Highlight: temperature wrist asymmetries asymmetry arm arms sensor's wearable Highlights

Methods And Apparatuses For Assessment And Management Of Hemodynamic Status

DOCUMENT ID	DATE PUBLISHED
US 11363956 B2	2022-06-21

INVENTOR INFORMATION

NAME	CITY	STATE	ZIP CODE	COUNTRY
Robinson; Mark Ries	Albuquerque	NM	N/A	US
Allen; Elena A	Albuquerque	NM	N/A	US

ASSIGNEE INFORMATION

NAME	CITY	STATE	ZIP CODE	COUNTRY
Medici Technologies LLC	Albuquerque	NM	N/A	US

APPLICATION NO	DATE FILED
15/780408	2016-12-06

Search Results x Help x Search History x

Settings Find Within

Highlight: temperature sensor arm temperatures sensors arms stroke wearable Hit Terms

L2: 221 results found. Currently displaying all results. Filtered by Family ID (72 families).

Select	+	Res...	X	1	2	3	4	5	Document ID	Date Publish
<input type="checkbox"/>		2	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	US 20220192588 A1	2022-06-23
<input checked="" type="checkbox"/>		3	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	US 11363956 B2	2022-06-21
<input type="checkbox"/>		4	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>	US 20220160200 A1	2022-05-26

Top 3 Traps.

1
Disclosure

2
Search

3
Ownership

Overview: **Ownership**



- Patent ownership rights
- Ownership vs. Inventorship
- Two's a Company
- Assignment and Work-for-Hire
- Workshop Interactive

Exclusive **Inventor** Rights

“To promote the Progress of Science and useful Arts, by securing for limited Times to **Authors and Inventors** the exclusive Right to their respective Writings and Discoveries”.



exclusive right to exclude others from **making, using, importing, and selling** the patented innovation for a limited period of time

If you're not doing
EVERYTHING ...

Prenuptial: Inventorship \neq Ownership




Ownership. An entity with the authority to file patent apps and enjoys all the rights and benefits granted by the patent, *if the patent is assigned to the entity.*



Inventorship. A person who has contributed to conception of the invention, to the point that their idea is clear enough to reduce to practice.

Transfer IP Ownership: **Assignment**

- Employees and contractors must assign ownership to your business
 - Best expressed in employment agreements and client service agreement contracts up front
 - Also needs to be done later via signing an assignment agreement
 - Be kind – this is a long-term deal
 - Don't create your own competitor
- 

Transfer IP Ownership: **Made for hire**

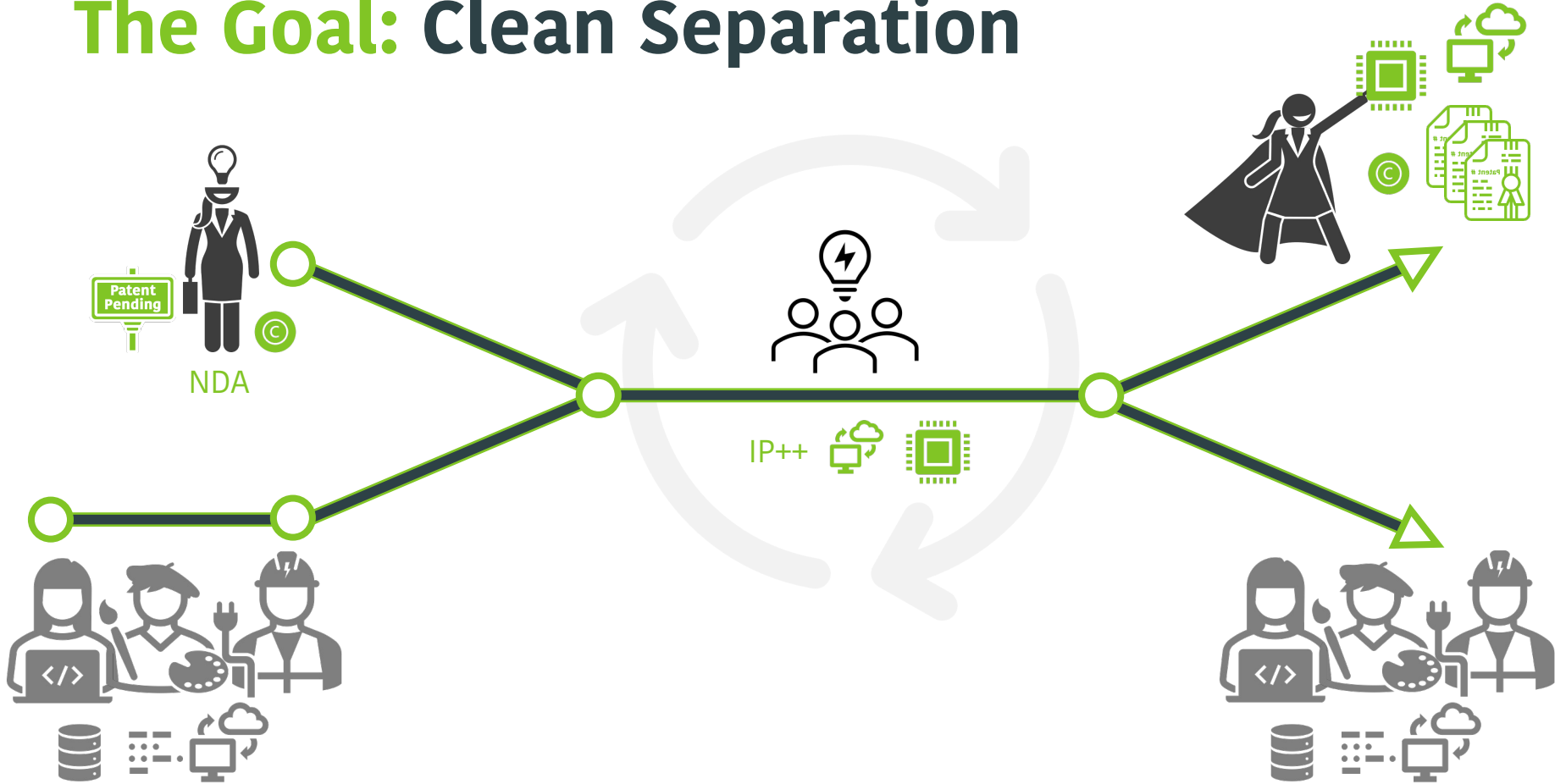
- Creator is the owner unless contract says otherwise
- Include “Work made for hire” provision



The jigsaw problem



The Goal: Clean Separation



Successful **Separation**

- **File provisional(s)** to establish clear lines before engaging
- **Execute an NDA** before sharing confidential info
- **IP Assignments** contractually expressed up-front
- **“Work made for hire”** provision
- **Participation** by your employees, contractors, and their employees.

NDA Over Reliance

- Do get one before discussing, but ...
- Many investors won't sign
- Mileage may vary on compliance
- **NDA's don't define ownership lines**



Key Takeaways

- **File provisionals before you share.** Protect as much as possible before disclosure or working with external partners.
- **Search** the prior art landscape for patentability and freedom-to-operate.
- **Own your IP.** CONTRACTS – pay particular attention to assignments and work for hire.



**Questions or Comments?
Contact us!**



ashley@aurorapatents.com

(650) 380-6913

aurorapatents.com

[@AuroraPatents](https://twitter.com/AuroraPatents)



New podcast @ patentlystrategic.buzzsprout.com