KILPATRICK TOWNSEND

5 KEY TAKEAWAYS

From Physician Innovator to Physician Patentee

Kilpatrick Townsend's Rodney Rothwell presented at the 2019 American Association of Pediatric Urologists on the topic of "From Physician Innovator to Physician Patentee." The presentation provided attendees with a high-level overview of patents and how to avoid common pitfalls on the way to procuring a patent for their innovation.

Key takeaways from the presentation include:

1

What is a patent: A patent is a form of intellectual property. And just like a house or any other type of property, the owner has certain rights granted them by a government entity for a predetermined period of time once that property is procured. The patent rights are granted in exchange for an enabling public disclosure of the invention. However, those rights do not include giving their owners a limited monopoly to the invention. Instead, it's a negative right—it gives its owner a right to exclude others from making, using, selling, offering for sale or selling the invention or importing the invention into the US.

2

Patent Components: In order to enable public disclosure of your innovation in exchange for a patent right there a number of key components that each government entity requires in your patent application. These components include a Title, Abstract, Figures if they would help in describing the invention, Background, Summary of the Invention, Detailed Description. And at the end of every patent, there is a list of one or more numbered sentences called claims. These are the real meat of the patent and provide the legal metes and bounds of the patent right claimed by the inventors. Each claim is one long sentence written to describe the invention as clearly as possible. During examination, the claims are the focus for the Examiner's search and examination, and once granted, the claims are the focus of any legal action brought to enforce your patent rights.

3

What can I patent as a physician – *The medical device*: When we think of patents most think of a gadget, which falls under the "machines" classification and is typically referred to as a "device" or "apparatus" when writing a patent. Many physicians patent new medical devices and improvements to known medical devices that they use every day in their practice. For example, Dr. Julio Palmaz was credited with inventing the first balloon-expandable coronary stents to solve the problem of restenosis of arteries. Similar to a machine, physicians could obtain a patent on a manufacture, which is "articles" resulting from the process of manufacture. For example, a shoe, scrubs, cast metal tools, or a piece of furniture (e.g., new operating table). Additionally, if a physician were to come up with a new composition for a pharmaceutical, then the new composition could be patentable.

4

What can I patent as a physician – *The process*: Keep in mind the less trendy but potentially just as powerful process patents. Medical process patents can protect various types of innovations such as therapeutic treatments and diagnostic and genetic testing methods. In certain instances, the therapeutic compound or diagnostic technique used in the medical process does not even have to be new. For example, a "repurposing" of an existing compound or diagnostic technique may be worthy of a patent. Imagine as a physician you are the first to notice that your patients on Ditropan come back from their vacations mentioning that they now had no problem with motion sickness on the airplane? You could get a patent on a process of preventing motion sickness by taking Ditropan. Additionally, medical procedures, such as methods for performing surgery, are generally patentable. However, no remedy is available if the patent is infringed by a medical practitioner who is infringing in order to perform a medical activity.

5

Common pitfalls to be aware of in procuring a patent: Typically any invention created by an employee during the course of their employment automatically belongs to the employer. In contrast, typically any invention created by an independent contractor is owned by the contractor, regardless of the price paid for the contractor's services. It is important that any and all agreements for services, including employment agreements, contain clauses specifying who owns the intellectual property rights in any work product created. Further, before disclosing any new product or invention to a client, supplier or potential investor, it is helpful to ensure that a proper confidentiality agreement is executed. A properly executed confidentiality agreement will not only help ensure that the invention remains confidential, but it could also provide an addition to the paper trail outlining the chain of title for the invention. Further, before investing a great deal of time and effort into a new product line or invention, it is advisable to scope out the field of the invention to ensure that there are no potentially conflicting patents or publications blocking the development of the invention and procurement of a patent. Lastly, it is strongly advised that a patent application be filed before details of the invention are disclosed to the public and before the invention is offered for sale. A premature public disclosure of public offering can prejudice your patent rights especially in most foreign jurisdictions. The US gives you a grace period of one year from date of disclosure to file.

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