

# ☞ 05hr\_AC-PH\_Misc\_pt03c



Details: INFORMATIONAL HEARING FOR PROPOSED PUBLIC HEALTH INSTITUTE

(FORM UPDATED: 07/12/2010)

## WISCONSIN STATE LEGISLATURE ... PUBLIC HEARING - COMMITTEE RECORDS

### 2005-06

(session year)

### Assembly

(Assembly, Senate or Joint)

### Committee on ... Public Health (AC-PH)

#### COMMITTEE NOTICES ...

- *Committee Reports ... CR*
- *Executive Sessions ... ES*
- *Public Hearings ... PH*
- *Record of Comm. Proceedings ... RCP*

#### INFORMATION COLLECTED BY COMMITTEE FOR AND AGAINST PROPOSAL

- *Appointments ... Appt*
- *Clearinghouse Rules ... CRule*
- *Hearing Records ... bills and resolutions*  
(ab = Assembly Bill)                      (ar = Assembly Resolution)                      (ajr = Assembly Joint Resolution)  
(sb = Senate Bill)                      (sr = Senate Resolution)                      (sjr = Senate Joint Resolution)
- *Miscellaneous ... Misc*

## **A Public Health Institute in Wisconsin**

---

**The Wisconsin Public Health Advisory Committee wrote to Secretary Nelson:**

*We enthusiastically support a Public Health Institute that builds on and enhances the existing resources in the public health system in Wisconsin. . . We cannot support creation of an institute with the primary (sole) purpose of shifting resources and staff from state government to achieve political goals of staff reduction that ultimately weakens the entire system.” (May 2004)*

**We need a public health institute in Wisconsin with a clearly identified mission.**

**The WPHA/WALDAB incubator study provides an opportunity to develop a mission and structure that adds value to Wisconsin’s public health system.**

**We must expect that an Institute will draw additional resources from a public health system that is already inadequate.**

**We must link any new public health activity to the infrastructure priorities already identified in the state health plan.**

**Our public health system is in crisis.**

**Only 2.4% of GPR funds support State operations for the Division of Public Health.**

**Most state DPH staff are funded by Federal grants which advocates have long called for sending to local communities.**

**Wisconsin ranked nearly last nationally in public health spending (\$57.73 per capita as compared to the median of \$100.90.)**

**Wisconsin ranked 7<sup>th</sup> of 8 similar states in our public health workforce (9.7 staff per 100,000 vs. 14.85 per 100,000).**

**State staff reductions that have no budgetary impact, should not occur to address a political agenda.**

**Respectfully submitted by:**

**Mary Jo Baisch, MS, RN**

**Assistant Professor, University of Wisconsin-Milwaukee**

**P.O. Box 413, Milwaukee, WI 53201**

**Chairperson, Wisconsin Public Health Advisory Committee**

**[baisch@uwm.edu](mailto:baisch@uwm.edu)**

**(414) 229-5545**

# **Wisconsin Public Health Advisory Committee**

## **"The Committee of Committees"**

---

### **Mission and Charge**

- Advises DHFS and the Division of Public Health about public health policy development and implementation
- Identifies and educates about issues of public health significance
- Coordinates public health activities of other advisory groups and professional organizations

### **Representative Agencies and Groups**

#### **Statewide Committees**

EMS Board  
MCH Advisory Committee  
Prevention Block Grant Committee  
MCH Coalition  
WI Diabetes Advisory Group  
WIC Program Advisory Committee  
Wisconsin Council on Immunization Practice

#### **Health Professions Schools and Groups**

Medical: UW Medical School and Medical College of Wisconsin  
Dental: Marquette Dental School  
Nursing: UW Madison School of Nursing, UW Milwaukee College of Nursing  
Wisconsin Area Health Education Center System  
Wisconsin Health Education Network

#### **Professional Organizations**

ABC for Health  
Black Health Coalition of Wisconsin  
Great Lakes Intertribal Council  
Hmong Community  
Managed Care/HMO Association  
National Black Nurses Association  
Wisconsin Association for Perinatal Care  
Wisconsin Dietetic Association  
Wisconsin Environmental Association  
Wisconsin Family Planning and Reproductive Health Association  
Wisconsin Association of Local Health Departments  
Wisconsin Counties Association  
Wisconsin Dental Association  
Wisconsin Hospital Association  
Wisconsin Home Care Association  
Wisconsin Medical Society  
Wisconsin Nurses Association  
Wisconsin Public Health Association  
Wisconsin State Laboratory of Hygiene



*Health Research, Inc.*  
*Guide to Technology Transfer*

“The Congress shall have the power — to promote the sciences and useful arts, by securing for limited time to authors and inventors the exclusive rights to their respective writings and discoveries.”

—Article 1, Section 8  
U.S. Constitution

“The patent system has added the fuel of incentive to the fire of genius”

—Abraham Lincoln

“To be practical, an invention must... be more than a solution looking for a problem”

—*Patents and the University Inventor*  
The Research Corporation

---

*Health Research, Inc.*  
*Guide to Technology Transfer*

---

*The Wadsworth Center Edition*

---

*Table of Contents*

---

Introduction .....	1
Why Patent? .....	2
What is Patentable? .....	4
Publication and Patenting .....	6
Materials Use Agreements .....	9
Will the Real Inventor Please .....	10
Inventorship .....	11
Inventorship vs. Ownership .....	12
Ownership of Joint Inventions .....	12
Sponsor Ownership of Inventions .....	13
Patenting: HRI, DOH and YOU .....	14
The HRI Role .....	15
Legal Review .....	15
Marketing of Inventions .....	15
To Patent or Not to Patent .....	17
Summary .....	18
Suggested Reading .....	19
Glossary .....	20

---

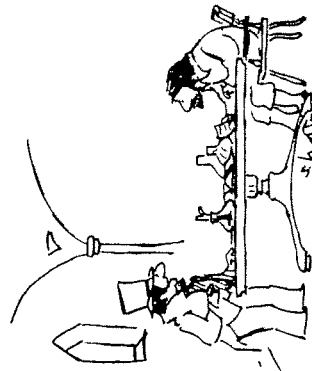
## Introduction

Inventions sometimes occur by design, but more often by accident or as a by-product of research.\* During the course of your research, you may develop an invention--if you do, it may represent valuable intellectual property that should be protected to preserve and possibly increase its value.

Inventions and technology developed by persons using Department of Health (DOH) facilities or in the course of a person's employment with either DOH/HRI or Health Research, Inc. (HRI), are the property of DOH/HRI. All matters related to patent administration and technology transfer are coordinated for DOH by HRI. The DOH/HRI Patent Policy establishes the guidelines for HRI's administration of patent matters. Copies of the full text of the **DOH/HRI Patent Policy** are available from either the Office of Technology Development located within the Wadsworth Center (WC) or from HRI, One University Place, Rensselaer, NY 12204.

Questions about the information included in this booklet should be directed to either the HRI Technology Transfer Office (431-1213) or the Wadsworth Center Office of Technology Development (474-7760).

### \* A Case in Point....



"Bunsen — I must tell you how excellent your study of chemical spectroscopy is, as is your pioneer work in photochemistry — but what really impresses me is that cute little burner you've come up with."

## *Why Patent?*

The DOH and HRI have an interest in protecting technology developed using DOH resources for several reasons:

### *Promoting Public Health*

Patenting technology provides potential commercial licensees with the incentive to invest further in the development of the technology. The patent system was designed to stimulate commerce by giving the patent holder the exclusive right to use, manufacture and sell the patented technology for a defined period. Having such an exclusive right gives the patent holder a way to recoup his/her investment in a technology--thus, President Lincoln's pronouncement, "the patent system has added the fuel of incentive to the fire of genius."

By protecting appropriate technologies through patents, DOH and HRI are preserving the incentive required to get healthcare technologies to the marketplace, and thus to the public.

Without a patent, companies may pass over a new technology for fear that, without benefit of a protected right to the market, research and development costs could not be recouped. This is particularly true in the area of health care technologies, where extensive testing and governmental regulation drive up the cost of getting new technologies to the marketplace.

### *Potential for Royalty Income*

Most patent holders do not actually produce and sell their invention, but rather find a company or companies interested in licensing the rights to manufacture, use, or sell the invention. This process involves the transfer of rights from one party to another, hence the term "technology transfer."

Patenting technologies clearly adds to the value of the technology. In recognition of that value, licenses usually involve a payment of a portion of the profits (a royalty) back to the patent holder in exchange for the rights to the invention. Patents can therefore be a source of income to the DOH to benefit its programs and research. The DOH/HRI Patent Policy allows for the sharing of 50% of net royalties with individual inventors as well.

### *Enhancing Connections with Industry*

Patenting and subsequent marketing of inventions brings the achievements and capabilities of an institution to the attention of the commercial sector. Through the process of technology transfer, the commercial sector can obtain rights to specific technologies, but also becomes aware of the capabilities of an institution--thereby increasing the potential for industry sponsored research and collaboration. An active technology sponsor program also provides the potential commercial sponsor with the assurance that technologies developed through research it funds will be recognized and properly protected.



## What is Patentable?

The first step is to recognize that a new development may be a patentable invention.

For the most part, patents are granted for inventions directed to processes, machines, manufacturers or compositions of matter, or any new and useful improvements thereof. In order to be patentable, an invention must possess three qualities:

**Novelty:**

*The invention must be new.*

**Utility:**

*The invention must be useful.*

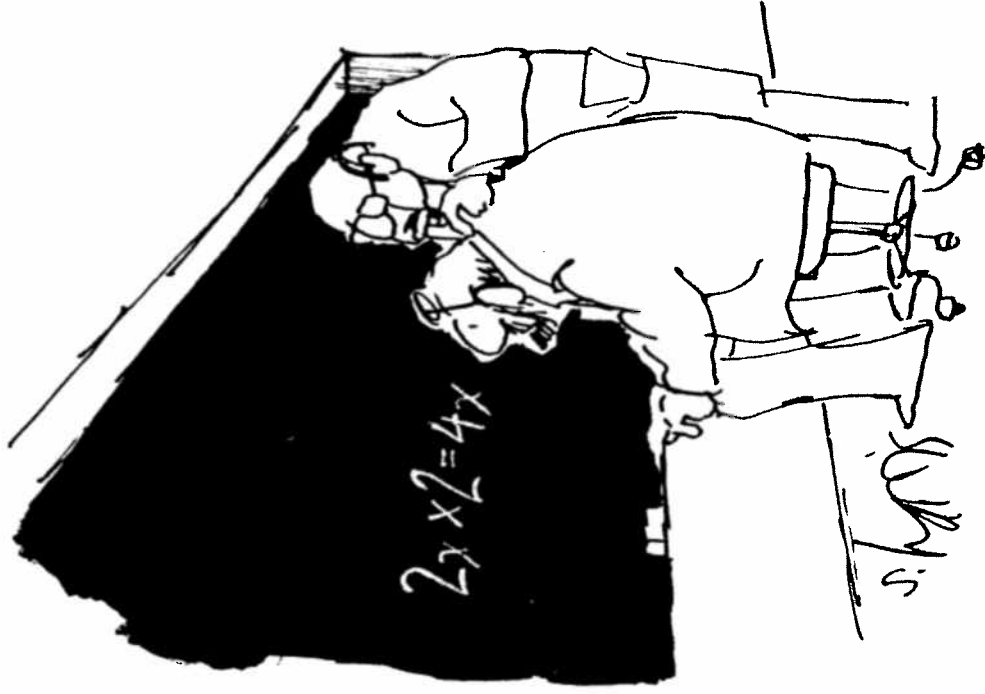
**Nonobviousness:**

*The invention must be more than just an obvious extension of existing technology (or "prior art") for a person of ordinary skill in the field of the invention.*

Under statute, if the invention is publicly known, used, described or patented prior to its invention by the inventor, the invention is considered unpatentable due to lack of novelty. For the most part, these conditions are out of the control of the patent applicant--he or she has simply "invented" something that has already been invented--by someone else!

However, there are certain situations that could result in a patent applicant inadvertently rendering his/her own invention unpatentable. These situations are of particular interest to the academic researcher as they involve publication and use of inventions prior to the filing of a U.S. patent application.

## Prior Art Illustrated.....



"But Gershon, you can't call it Gershon's equation if everyone has known it for ages."

## Publication and Patenting

If an invention was described in a publication--authored by the inventor or anyone else--anywhere in the world **more than one year prior to the date of the application for a patent in the United States**, the existence of the publication is considered a "statutory bar" (often referred to as a "publication bar") to obtaining a patent. In order for a bar to be declared, the publication must be "enabling" meaning that it must describe the invention in sufficient detail such that someone with ordinary skill in the field of the invention could reproduce the invention after reading the publication.

For the purposes of patent law, "publication" is broadly defined and includes any enabling description of an invention that is made available to the public either in oral or written form. Any of the following could potentially present a statutory bar to obtaining a patent:

- ◆ Publication in scientific journals
- ◆ Oral presentations and poster sessions
- ◆ Graduate student theses (that have been cataloged and placed in a library)
- ◆ Grant applications (once funded, they are subject to Freedom of Information at the federal level)
- ◆ Distribution of a prototype or product of an invention--even to another researcher--can result in a bar similar to a publication bar. (see the section of this booklet entitled "Materials Use Agreements")

A good rule of thumb is to check with either the HRI Technology Transfer Office or the Wadsworth Center Office of Technology Development if you are planning to include a detailed description of an invention in any format that could be made available to the public.

The U.S. grants an inventor a one year "grace period" from the time of publication in which to file a patent application. Publication does not result in loss of U.S. Patent rights as long as the patent application is filed within one year of the publication. However, foreign countries, with very few exceptions, do not grant such a grace period. In order to protect foreign rights, a "priority date" must be established by filing a patent application in the United States prior to **any** publication.

### Implications for Foreign Filing

Changes to patent law in the United States were made in 1995 to "harmonize" U.S. patent laws with much of the rest of the world. These changes were set out in the General Agreement on Tariffs and Trade (GATT). In addition to changing the term of a U.S. Patent from 17 years from date of issuance to 20 years from the date the patent application is filed, GATT also introduced a new form of patent application-- the **provisional application**. A provisional is an abbreviated application that serves as the patent filing to establish a "priority date" for protection of foreign rights, but **does NOT** serve as the date from which the 20 year patent term is calculated. The patent term is calculated from the date that the full U.S. Patent application is filed--which can be up to a year after the provisional.

### *In Summary*

An inventor can publish and patent--the key is to recognize that you may have an invention and to DISCLOSE it in accordance with the DOH/HRI Patent Policy. The policy specifically states "no inventor is inhibited from obtaining prompt publication of research results by this policy. Rather, this policy requires inventors to make timely application for a patent."

If you disclose your invention early enough to allow a U.S. patent application (whether a full application or a provisional) to be filed before you publish, you will not only secure the U.S. rights to the invention, but will preserve the ability to file patents in most other countries of the world.

One final note--even if the invention has been published, it is important to disclose it to allow an evaluation of whether or not the publication is enabling and to determine if any patent rights are still available.

## *Materials Use Agreements*

If an invention is used or sold for any commercial purpose more than one year prior to the filing of a patent application, the patent application would be disallowed by the patent office. This underscores the importance of obtaining a Materials Use Agreement prior to sharing any unique research resources or materials you may develop in the course of your research (clones, vectors, hybridomas and the like) with other researchers. A Materials Use Agreement prohibits the use of such materials for commercial purposes and formally establishes that the materials are being used for research/experimental purposes. HRI has developed a simple, standard Materials Use Agreement which should be used by any investigator distributing research materials. Failing to do so could result in loss of patent protection on the materials or their progeny.

Outside researchers providing materials to WC investigators may request a Materials Use Agreement be signed prior to providing the materials. These Materials Use Agreements--particularly ones from commercial organizations--may include restrictive clauses in the areas of publication and future patent rights that often conflict with DOH policies. Individual investigators do not have the authority to sign Materials Use Agreements.

Materials Use Agreements from outside organizations must be submitted for review and signature to the WC Office of Technology Development. In the majority of cases, minor changes can easily be negotiated to allow the material to be accepted by the WC investigator without violation of any DOH policies.

## *Will the Real Inventor Please...*

With many researchers working on similar projects, using similar methods, and sharing research methodologies and materials, it is almost inevitable that two or more people may invent the same thing.

In the United States, a patent is granted to the first person to invent—not the first person to file a patent application (it is interesting to note that in most foreign countries the first to file is granted the patent!). This "first to invent" distinction in the U.S. works to the advantage of the first inventor—in that, he/she has priority over anyone else who files a patent application on the invention **AS LONG AS THE INVENTOR CAN DOCUMENT THAT HE/SHE WAS THE FIRST TO INVENT.**

Having to prove that you were first to invent can be a lengthy and costly process in the courts. Disclosing and filing your invention as soon as possible is the best practice, but in certain instances, well documented notes of your work may be the only means of establishing your priority if another "inventor" should emerge.

### *Some keys to keeping good notes:*

- ◆ Keep notes in a bound notebook (appropriate bound notebooks are available in the WC stockroom).
- ◆ Make daily entries of ideas, work done and laboratory data collected—date and sign your entries.
- ◆ Have "significant" entries signed by someone who has witnessed the work and understands it, but has not participated in it.

## *Inventorship*

In a collaborative research endeavor with several scientists involved as well as lab technicians, graduate students and the like, it is not surprising that the question of who is an inventor frequently arises.

U.S. Patent Law requires that the inventor or inventors be named in a patent application. To be an inventor, one must have made an inventive contribution to the subject matter of at least one claim of the patent. Merely carrying out the details of another's conception by utilizing standard techniques or by following the instructions of another does not make someone an inventor.

One court put it this way:

*"A joint invention is the product of collaboration of the inventive endeavors of two or more persons working toward the same end and producing an invention by their aggregate efforts. To constitute a joint invention, it is necessary that each of the inventors work on the same subject matter and make some contribution to the inventive thought and to the final result. Each needs to perform but a part of the task if an invention emerges from all the steps taken together. It is not necessary that the entire inventive concept should occur to each of the joint inventors, or that the two should physically work on the project together. One may take a step at one time, the other, an approach at a different time. One may do more of the experimental work, while the other makes suggestions from time to time. The fact that each of the inventors plays a different role and that the contribution of one may not be as great as that of the other, does not detract from the fact that the invention is joint, if each makes some original contribution, though partial, to the final solution of the problem."*

## Inventorship vs. Ownership

The inventor of an invention is determined by U.S. patent statute. As long as an individual meets the criteria of "inventor" as set forth in the patent statutes, the individual is an inventor and must be so named in the patent application. Ownership of patent rights, however, can be established through contracts and agreements.

All DOH and HRI employees are required to sign a Patent and Copyright Agreement. By signing this agreement, employees are agreeing to assign the right and title to any patentable devices or techniques developed in the course of their employment or with DOH facilities to DOH/HRI. Virtually every academic institution and commercial organization requires the signing of such an agreement upon employment. It is interesting to note that most commercial organizations require such an assignment with no return to the inventor in the form of sharing in the royalties produced by an invention; whereas most academic and research institutions have provisions for the sharing of royalties with inventors. As mentioned earlier, the DOH/HRI Patent Policy provides for sharing of 50% of net royalties with individual inventors.

## Ownership of Joint Inventions:

Joint inventions may result in a situation where rights to an invention are jointly owned by two or more institutions. These situations are fairly common in the academic world, and the HRI Technology Transfer Office is experienced in negotiating agreements to share the rights to and management of inventions. Investigators should never hesitate to disclose an invention because the involvement of an outside inventor is perceived as a complication!

## Sponsor Ownership of Inventions:

The Federal Government allows the grant recipient to retain title and ownership of any inventions developed in whole or in part with the use of federal funds (subject to the granting of a royalty free license to the government to use the invention for its purposes). However, some other sponsors of research have policies requiring that title to inventions be assigned to the sponsor or that royalty income be shared with the sponsor.

Generally, these policies are referenced on the grant application form, and signing of the application signifies agreement with the sponsor policy. In the majority of cases, HRI is able to obtain exemption from such sponsor patent policies upon submitting the DOH/HRI Patent Policy. Usually, sponsors are looking for assurance that inventions developed with the use of their funds will be utilized for the public good--which is the prime goal of the DOH/HRI Patent Policy. When submitting grant applications through HRI, investigators should point out any unusual patent requirements to their HRI Grant Administrator.

## Patenting: HRI, the DOH and YOU

Now that you know something about the law and theory behind patents, how does it all work in practice?

### **DISCLOSE!**

The HRI form used for disclosure of inventions is intended to allow the inventor to provide a disclosure of the invention with as little additional work as possible--after all, inventing should be the hard part!

Staff of the WC Office of Technology Development and the HRI Technology Transfer Office are available to assist inventors with preparing disclosures.

The disclosure form requires a description of the invention. In most cases a draft manuscript that describes the invention is sufficient. The form also requires information on publication and public disclosure of the invention, as well as some general administrative information (inventor name(s), funding sources used, etc.)

The inventor completes the form and forwards it to his/her supervisor. The supervisor forwards the signed disclosure to the WC Office of Technology Development which arranges for the disclosure to be included in discussions at the monthly meeting of the WC Intellectual Property Review Committee. (The Committee consists of a group of WC scientists appointed by the Director of the WC). If the committee has questions or concerns regarding the invention, the inventor is contacted directly. The Committee then forwards the disclosure, along with a recommendation, to HRI.

## The HRI Role

### Legal Review:

Once an invention disclosure is received by HRI, it is sent to a patent attorney for review. The patent attorney conducts a search for relevant "prior art" (issued patents, publications, etc. in the same field as the invention) to determine if the invention is novel and non-obvious.

The attorney utilizes the prior art and knowledge of patent law to give a "patentability opinion." The patentability opinion generally states whether or not the invention meets the three criteria of novelty, utility and non-obviousness (i.e. is patentable under patent statute) and gives an opinion as to the likelihood of securing a patent--this is a judgment as to what, based on the attorney's experience, potential objections the patent office may cite and whether they can be overcome. A patentability opinion also gives an indication of what the expected strength and scope of a patent might be in terms of how easy or difficult it would be for competitors to "get around the patent"--allowing them to effectively use the invention without technically infringing the patent.

### Marketing of Inventions:

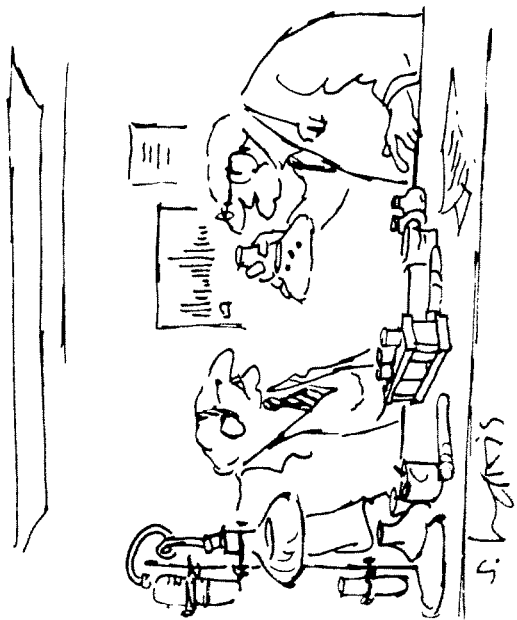
It is important to note here that indeed, an invention "must be more than a solution looking for a problem." An invention may meet all of the criteria for patenting (novelty, utility and non-obviousness) but may not be commercially viable. Perhaps there are products already available that, although different from the invention, already serve to fill the needs of the marketplace. The existence of these other products may not detract from the utility of a new invention in the eyes of the patent office--but the commercial sector may view the invention as a "solution looking for a problem."

On the other hand, the invention may have significant advantages over existing products (lower cost, better results, etc.) and therefore, have potential value to a company trying to break into an existing market, or to a company trying to improve its current product.

HRI may test the commercial viability of the invention prior to filing a patent application. HRI has several ways to accomplish this, including directly contacting companies in the field, publication of non-disclosing summaries of the invention in trade magazines, and/or using outside marketing consultants or agents.

Research stage inventions pose a particular challenge to the technology transfer process. "Cutting edge" research may produce patentable inventions that are "ahead of their time." The marketplace may not immediately recognize the value of certain technologies. Marketing information is therefore looked at in conjunction with other available information about the field of the invention.

#### *A Commercial Viability Problem Illustrated...*



"It may very well bring about immortality, but it will take forever to test it."

© 1992 by Sidney Harris, "Chalk Up Another One," AAMS Press, Washington, DC

## *To Patent Or Not To Patent*

HRI is charged with coordinating and evaluating patent issues for the DOH. HRI evaluates inventions, taking into account:

- ◆ The patentability opinion
- ◆ Publication dates and filing deadlines
- ◆ Commercial value and viability
- ◆ Rights of outside sponsors of the research (if any)

HRI then makes a recommendation to the DOH Internal Practices Review Committee (which consists of the Executive Deputy Commissioner of Health, the Deputy Commissioner for Administration, Department of Health General Counsel, the Director of the Institutional Management Group and the Executive Director of HRI). The inventor is advised of the recommendation and asked for his/her input. The Committee approves or recommends alternative action to the Commissioner of Health. The final decision as to whether a patent application will be filed rests with the Commissioner of Health.

## Summary

The ultimate goal of this process is to provide the broadest, most efficient, and most rapid dissemination of the benefits of DOH inventions to the public. Often, this involves transfer of technologies to the commercial sector.

The costs of obtaining patent protection can be substantial. Early disclosure of potentially patentable inventions is key to allowing as much time as possible for a full review of the invention and its market potential to be conducted before committing DOH and HRI resources to pursuing a patent. Early disclosure also assures that those inventions with substantial market potential can be protected by patent prior to any bars, thereby preserving their value and securing worldwide rights.

The information about patenting provided on the preceding pages is intended for your information and to help you understand some of the intricacies of the patent process. It is not intended to make you an expert on the patentability of inventions. Any potential invention should be disclosed so that it can be reviewed by those skilled in determining its patentability and commercial potential.

## Suggested Reading

"Patent Applications Handbook," by Stephen A. Becker. Clark/Boardman/Callaghan, 1992.

"Patent Law for the NonLawyer-A Guide for the Engineer, Technologist and Manager," by Burton A. Americk. Van Nostrand Reinhold, 1986.

"Patents and the University Inventor," The Research Corporation, 1984.

"Protecting Biotechnology Inventions: A Guide for Scientists," by Roman Saliwanckik. Science Tech Publishers, 1988



## Glossary

### *Terms Used in Technology Transfer*

**Disclosure** - A formal document, signed by the inventor(s) and witnessed which describes an invention in sufficient detail to enable a technical and legal evaluation of the invention.

**Enabling Publication** - A publication or oral public disclosure that describes an invention in sufficient detail to allow someone with ordinary skill in the field of the invention to reproduce the invention after reading the publication or hearing the disclosure.

**Infringement** - Use, manufacture or sale of a patented technology in the country where a patent has been granted on the technology without a license from the holder of the patent.

**License** - A formal, legal agreement granting rights to a technology (whether patented or not) in exchange for some form of consideration, to the owner of the technology--usually a royalty based on a percentage of sales of the technology. Licenses can be exclusive or non-exclusive.

**Licensee** - The person or entity to whom the license is granted

**Licenser** - The person or entity granting the license.

**Non-Obviousness** - Under patent statute, the requirement that, in order to be patentable, an invention must be more than just an obvious extension of existing technology or knowledge (see "Prior Art") for a person of ordinary skill in the field of the invention. An invention must be non-obvious. One of the three statutory requirements for patentability of an invention (see Utility, Novelty)

**Novelty** - Under patent statute, the requirement that an invention possess novelty demands that the invention be new and original, or possess unexpected or surprising results or qualities. One of the three statutory requirements for patentability of an invention (see Utility, Non-Obviousness.)

**Patent** - A legal document issued by a government granting the holder of the document the exclusive right to use, manufacture and sell the patented technology in the particular country or region for a defined period of time (in the United States, and in most foreign countries, this period is 20 years from the filing date of the patent application.)

**Patentability Opinion** - A formal legal opinion rendered by an attorney skilled in patent law and practice that states whether an invention meets the three statutory criteria of novelty, utility and non-obviousness and gives an opinion as to the likelihood of securing a patent.

**Prior Art** - The body of existing technology and knowledge (patents, publications, existing products, etc.) in the field of an invention. Prior art describing a technology for which a patent is being applied may serve to make the invention un-patentable due to lack of Novelty. An invention can also fail to meet the non-obvious requirement if it is merely an obvious extension or progression from the prior art.

**Provisional Patent Application** - An abbreviated patent application which serves as the patent filing to establish a "priority date" for protection of foreign rights. A provisional application is automatically abandoned after one year if a full patent is not filed.

**Publication Bar** - Under U.S. Patent statute, the existence of an enabling publication or oral public disclosure authored by the inventor (or anyone else) anywhere in the world **more than one year prior** to the date of the application for a patent. A publication bar prevents granting of a patent application. Note, in most foreign countries, a publication bar is caused by an enabling publication or oral public disclosure at **anytime** prior to filing a patent application (there is no one year grace period as in the U.S.)

**Royalty** - A monetary payment to the owner of the rights to a technology as consideration for the granting of rights to make, use or sell the technology. A royalty is generally based on a percentage of the sales of the technology or products made using the technology.

**Technology Transfer** - Commonly used term in both academia and industry for the entire process of licensing and acquiring rights to technologies.

**Utility** - Under patent statute, the requirement that an invention have a useful purpose. One of the three statutory requirements for patentability of an invention (see Novelty, Non-Obviousness.)

---

## Notes

---