SJSU Research Foundation Office of Sponsored Programs

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Whaiaae?

In the U.S., a patent gives the holder the right to exclude others from making, using, selling, o ering to sell, and importing the patented invention. A patent does not necessarily provide the holder any a rmative right to practice a technology since it may fall under a broader patent owned by others. Instead, it provides the right to exclude others from practicing the invention. Patent claims are the legal de nition of an inventor's protectable invention.

Wha e f bec a e ca be a e ed?

Patentable subject matter includes processes, machines, compositions of matter, articles, some computer programs, and methods (including methods of making compositions, methods of making articles, and even methods of performing business).

Ca e e a e a a a == cc i g b a ce?

Generally, no. A natural substance that has never before been isolated or known may be patentable in some instances, but only in its isolated form (since the isolated form had never been known before). A variation of a naturally occurring substance may be patentable if an inventor is able to demonstrate substantial non-obvious modications that over advantages of using the variant.

Wha i he U i ed Sae Pae a d Tade a O ce (PTO)?

The PTO is the federal agency, organized under the Department of Commerce, that administers patents on behalf of the government. The PTO employs patent examiners skilled in all technical elds in order to appraise patent applications. The PTO also issues federal trademark registrations.

Whaihede_ii faie aae ad h dee ie hi?

Under U.S. law, an inventor is a person who takes part in the conception of the ideas in the patent claims of a patent application. Thus, inventorship of a patent application may change as the patent claims are changed during prosecution of the application. An employer or person who only furnishes money to build or practice an invention is not an inventor. Inventorship is a legal issue and may require an intricate legal determination by the patent attorney prosecuting the application.

Whie ibefaeig?

San José State University Research Foundation (Research Foundation) contracts with outside patent counsel for IP

adjustments for San José State University and the San José State University Research Foundation. We are grateful to the sta of UM O ce of Technology Transfer for their kind permission to use their material and to the University of Michigan for permission to use its copyright.

Whai he ae ig ce?

Patent applications are generally drafted by a patent attorney or a patent agent (a non-attorney with a science education licensed to practice by the PTO). The patent attorney generally will ask you to review an application before it is led and will also ask you questions about inventorship of the application claims. At the time an application is led, the patent attorney will ask the inventor(s) to sign an Inventor's Declaration and an Assignment, which evidences the inventor's duty to assign the patent to the university.

An important international treaty called the a PCT application) to claim the bene t of the	Paris Convention p ling date of an a	permits a patent appl pplication led in a	ication led in a secor rst country. However,	d country (or pursuant to
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Whaiadeiaie?

A "derivative work" is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, ctionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modications, which, as a whole, represent an original work of authorship, is a