

# Ana G. Méndez University System

Vice-Presidency of Planning & Academic Affairs

Associate Vice-Presidency of Intellectual Property and Commercialization



## Guide to the university community on: **Patents**



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## **I. Introduction:**

The Ana G. Méndez University System (“AGMUS”) has a patent policy which establishes and sets forth what is a patent, what it applies to, and who owns the rights to works created and/or developed by AGMUS employees, among other things.

The purpose of this guide is to disseminate basic knowledge about patents and answer doubts the university community may have with regards to this topic.

## **II. What is a patent?**

A patent is the means by which the government of the United States bestows on an inventor or his licensee a set of rights over an invention for a limited period of time, in exchange for the public disclosure of the invention.

In granting a patent, the government of the United States grants the owner of the patent a monopoly over the exclusive use of the invention or development. The patent allows the owner to exclude and/or impede others from using, reproducing, developing, selling, or importing the goods protected by the patent for the life of the patent.

## **III. What does a patent protect?**

Patents aim to protect the developments and inventions made by the human being.

## **IV. What is not protected by a patent?**

The following, are not susceptible to patent protection:

- Ideas, literary or artistic works;
- Trademarks and/or service marks;
- Things that naturally occur in nature;
- Laws of nature;
- Inventions which are not useful and/or are offensive to public morality.

## **V. What are the primary requirements for something to be patentable?**

To be susceptible to protection as a patent, the invention, among other things, must meet certain essential and basic requirements. These are: (i) the invention has to be useful; (ii) it must be novel, or an improvement on something pre-existing; and (iii) it cannot be obvious to an expert in the matter.

## **VI. How many types of patents are there?**

There are three types of patents. These are: (i) utility; (ii) design; and (iii) plants patents.

## **VII. What is a utility patent?**

Utility patents are the most common patents. This type of patents protects an ample spectrum of things. Under utility patents, new and useful things are protected, such as but not limited to, technological and scientific developments, useful processes, machines, compositions of matter, and/or improvements to pre-existing developments.

## **VIII. What is a design patent?**

A design patent aims to protect the artistic and/or decorative elements of an object, in other words, its appearance. A design patent is granted to an inventor for the ornamental elements of an object. These ornamental elements must be novel and non-obvious for an article of manufacture.

These patents protect the decorative aspect of an object, not its functionality. If an object may only be designed in a particular manner, then its design is considered as being functional and it will not be subject to a design patent.

## **IX. What is a plant patent?**

Plant patents protect the discoveries and developments of asexually reproducing plants.

## **X. What does the term *novel* mean for purposes of a utility patent?**

An essential requirement for something to be patentable is that it be novel. The requirement that something be novel means that the invention or development will not be patented if previously:

(i) The invention was known or used by others in the United States or was described in a publication prior to being developed by the inventor. This requirement seeks to ensure that patents only be granted to the first person who developed the matter at hand. If it has been previously described by another, then it is no longer novel.

(ii) The invention was patented in another country, it was described in a foreign publication, or has been utilized, sold or was for sale in the United States more than one year prior to the patent application being filed in the United States. With this, the actions of the applicant are taken into consideration, and the applicant is given a one year grace period within which to file a patent application in the United States after having filed a patent application in a foreign country, describing the invention in a publication and/or convention, or using and/or offering for sale the invention in the United States.

**XI. May the invention or development be subject to more than one type of patent?**

Yes. It may be subject to a utility and a design patent. The utility patent protects the useful and/or functional aspects, while the design patent protects the artistic and aesthetic aspects.

**XII. How long does patent protection extend for?**

As a general rule, protection under a utility or plant patent extends for a period of twenty (20) years. Protection under a plant patent extends for fourteen (14) years. Both terms commence as of the date on which the patent application was filed.

**XIII. May an extension of the patent term be sought?**

Under certain specific circumstances an extension on the patent term may be sought for a utility patent.

**XIV. When may I disclose my invention?**

As a general rule, in the United States, an inventor has one year from the date he publicly discloses his invention within which to file a patent application. Disclosure includes, the publication of an article or paper, exhibition, verbal presentation, and communication by any

means to a person not affiliated with the investigation process, with the exception of the technology transfer representative of the institution.

Also, as a rule of thumb, universities require that their researchers and such maintain the university informed of any and all possible inventions and developments as soon as they occur.

For purposes of AGMUS and its universities, there exists a form which must be completed by the researcher and sent to the Associate Vice Presidency of Intellectual Property and Commercialization (the "Office"). It is recommended, that the researcher contact the Office or the Office representative in your university, prior to engaging in any communication or other disclosure regarding the invention or development.

In the event that a year or more transpires from the disclosure date without a patent application being filed, it is understood that the inventor resigned and/or lost his rights to apply for a patent.

**XVII. In order for my invention to be protected, do I need to file a patent application?**

Yes. In order to reap the benefits provided by the *Patent Act* and the exclusive monopoly granted by the United States government for a limited period of time, it is necessary and required to obtain a patent.

**XVIII. What government agency regulates patents?**

All patent applications are submitted to and revised by the United States Patent and Trademark Office (the "USPTO"). The patent examiners of the USPTO are the people who evaluate each application and determine whether or not a patent is granted.

**XIX. Do the patents granted by the USPTO protect the invention in other countries?**

No. All patents issued by the USPTO only protect the invention within the United States and its territories. In order to obtain international protection, a patent application must be submitted in each individual country where protection is desired.

Notwithstanding, in 1978, the *Patent Cooperation Treaty* (the "PCT"), an international treaty for patent protection, went into effect. The PCT does not waive the need to file individual patent

applications per country, but does facilitate the protection process of inventions within its member countries and signatories.

**XX. Does AGMUS have a patent policy?**

Yes. As per Executive order number 09-2011, AGMUS adopted its Patent Policy.

**XXI. What does AGMUS patent policy establish?**

AGMUS's patent policy establishes and sets forth the mechanism through which all employees, associates, faculty, independent contractors, and others, are to disclose to AGMUS about any and all inventions and/or discoveries that they may have developed.

Additionally, the policy sets forth the three categories under which all inventions and/or developments will be evaluated in order to determine ownership of the invention and/or development. The policy also establishes the mechanism by which the Office will evaluate the inventions and/or developments in order determine if AGMUS will initiate or not the process through which to seek a patent. The Office will have the responsibility to manage the patent application process and negotiate any potential commercialization, among others.

The patent policy also establishes the manner in which all monies received from the commercialization of the inventions and/or developments are to be distributed between the inventor and AGMUS. A copy of the patent policy may be obtained through the Office.

**XXIII. What is public domain?**

The phrase *public domain* is used to refer to the status of a work of art, a creation, an object and/or invention when it is no longer protected under the laws of intellectual property, regarding that particular subject matter. When an object is no longer protected under the law, it may be freely used by the general public.

**XXIV. When does something that has been patented enter the public domain?**

Inventions, object, and other things susceptible to patent protection are considered to have entered the public domain when (i) the term of the patent has expired, (ii) the patent application

was filed out of term, and/or (iii) when a patent application was never filed and therefore, patent protection was never obtained.

**XXV. Has AGMUS ever been granted and/or issued a patent?**

Yes. On February 28, 2012, the USPTO issued patent number US 8,124,770, also known as the Zayas-Cox patent, regarding fluorescent cellular markers. This application was filed with the USPTO on April 1, 2009.

Currently, AGMUS has various patent applications pending before the USPTO.

**XXVI. Are there any other laws discuss patent issues?**

Yes. The Bayh-Dole Act is a federal statute which permits universities, small business and non-profit organizations to retain ownership over those inventions whose research and/or development was funded by federal agencies.

This statute imposes compliance requirements on the researches and the universities that pursue and develop inventions and/or developments through donations and/or grants issued by the federal government.

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