

# The Basics Every Researcher Must Know About Patents & Reporting Inventions to Syracuse University

Syracuse University

Office of Research Awareness Session

October 13, 2021

# Presenters

**David L. Nocilly**  
**Patent Counsel and Member**  
**Bond, Schoeneck & King**



**Jennifer M. Crisp**  
**Director**  
**Office of Technology Transfer**



# Your presenters and our approach to this webinar:

- Dave

Focus: Training university researchers to recognize when they have discovered something patentable

What potential inventors need to know

- Jennifer

Focus: Guidance specific to Syracuse University researchers

Why universities have rules around patents and intellectual property (IP)

Patenting in the context of a university, generally

**“I have been told I need to alert certain offices that I created intellectual property (‘IP’) ....”**

 This program is for you!

- SU IP Policy
- Office of Technology Transfer (OTT) website
- Peers and co-inventors at SU or other universities
- Office of Sponsored Programs
  - “Intellectual Property Agreement”
  - “reg sheet” for a new award
- SOURCE funding
- External funders: grant proposals and awards

# What this program isn't

- A focus on “other types Intellectual Property (IP)”
- Why the SU IP policy exists, and what it says
- Other elements of the technology transfer lifecycle
- A group forum to assess whether something discovered by an audience member is an invention
  - That would create a real danger of describing an invention such that it becomes unpatentable.

Complementary offerings related to this program

Past webinars | CITI program | other online tools and resources

When should I contact OTT?

# Is there an invention?

Patents are directed to inventions, not ideas

- An invention is a working solution to a problem
- An invention is not the discovery of how or why something works



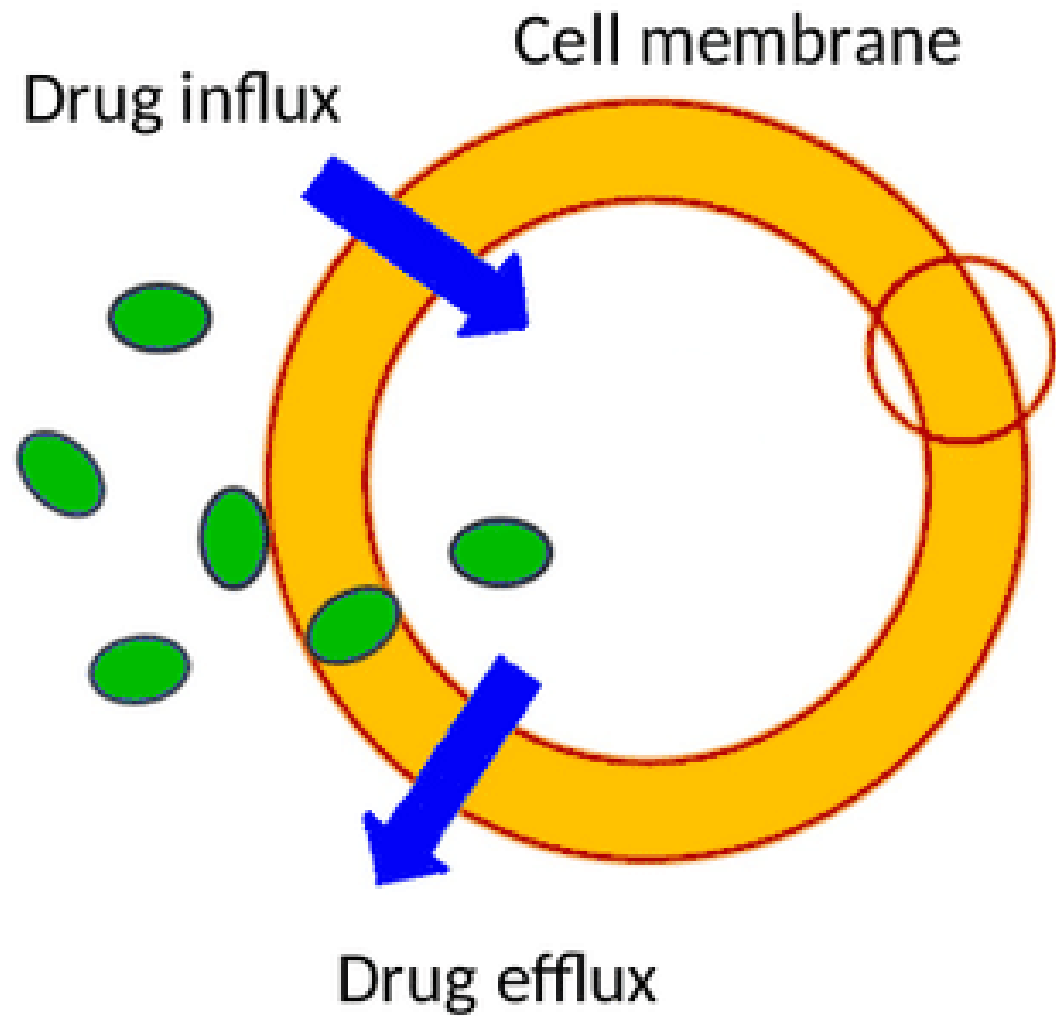
# Is there an invention?

University research is often directed toward understanding or determining scientific principles - the HOW and WHY

Does this mean the research is not patentable????

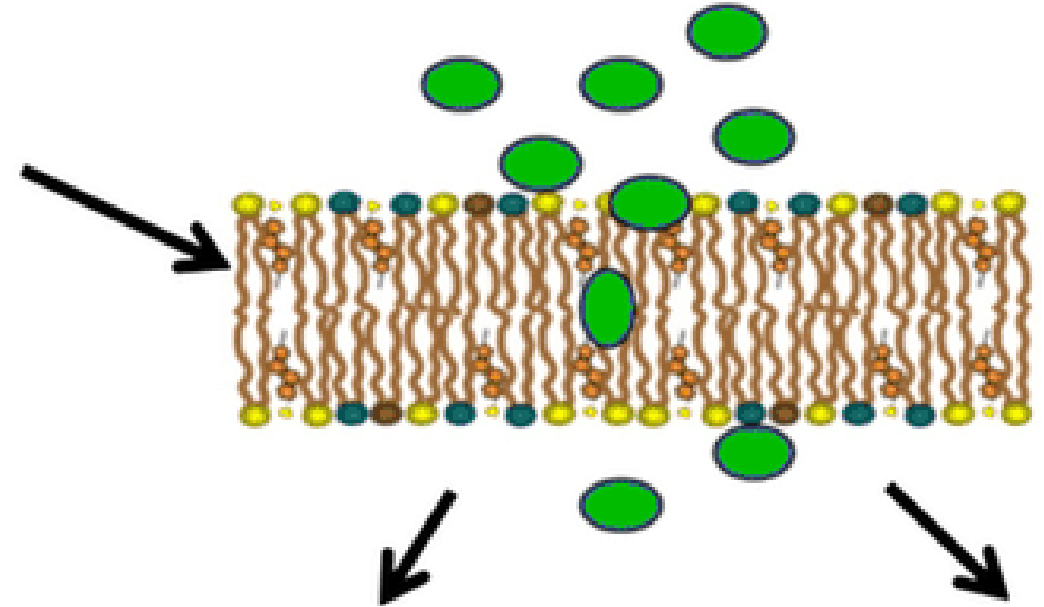


Is there an  
invention?



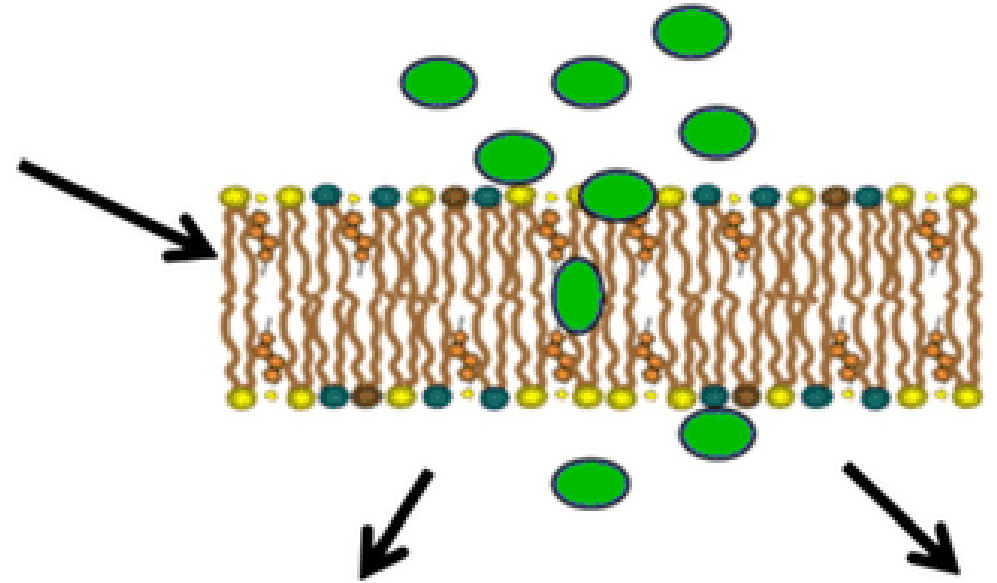
# Is there an invention?

- NEW discovery of how the drug works



# Is there an invention?

- Mechanism of action is not patentable, but ...



Does this  
mean I should  
not contact  
OTT?

Even if the 'invention' is the discovery of the mechanism of action, there can still be potentially patentable inventions . . .

- New diagnostic approaches
- Identification of new drugs
- Etc. . . .

What does  
this  
knowledge  
open the door  
to?

How can I or others (in industry, for example) leverage this finding to solve a problem, or address a need?

Ask yourself: what are some concrete applications of the knowledge?

# What do I need to disclose to OTT?

It's as easy as completing a form!

Provide enough detail so that OTT and patent counsel can evaluate the innovation to determine if it meets the criteria for patentability.

OTT will also evaluate commercial viability. That said, “technology readiness levels” out of universities tend to be on the lower end. This is OK! It is what we are accustomed to seeing...

The form is treated as a confidential document.

# Report innovations to Syracuse University Office of Technology Transfer

<https://techtransfer.syr.edu/innovators/submit-an-invention/> \

SU's IDF: Invention Disclosure Form

**What:** Description/Abstract - Technical Description | Non-Technical Description

What are the immediate/future applications of this invention?

Why is this invention better/more advantageous than what is currently available?

**Technology Readiness/R&D Status:** Is work on this invention continuing?

Include information on whether there are limitations to overcome, or tasks to be done prior to practical application. Also, what further research and development is necessary; is there test data?

**Technology Readiness/R&D Status** (*continued*): What is your understanding of the “market opportunity” for this tech/innovation?

**When:**

**Past:** Has this innovation been disclosed in an abstract, paper, talk, news story, or a thesis?

**Future:** Is there a paper that will be submitted for publication? When? Will the paper be submitted to an Open Access repository? Which one? When (earliest date)?

**Agreements of Note:** Was this invention created or discovered under one or more funded projects?

**Who:** Who contributed to this innovation/invention? In what way?



# Should I complete an IDF?

## Maybe it's not even patentable.

- I don't want to waste OTT's time with this.



The vast majority of invention disclosures received by OTT identify something that qualifies for patent protection!

## Guidelines to remember...

- OTT is a service unit
- We provide group training as well as 1:1 guidance
  - That 1:1 guidance often occurs in context of the earliest contacts with OTT, and outside counsel, when a researcher believes there might be a patentable invention
- In addition to determining how SU will proceed with your completed IDF, we work with you to:
  - Cultivate IP literacy and acumen
  - Connect you with a patent professional to accelerate your understanding of how to identify potential patentable innovations

# What does OTT do with the disclosure?

**Threshold question: Preliminary determination of patentability or suitability for other types of IP protection**

- If protectable, then also assess for
  - Federal government and other external funding sponsorship and reporting
  - Commercialization potential
  - Recent or imminent publications
  - And more!

# I don't need to contact OTT because...

...I'm not interested in  
commercializing this  
technology / I don't  
want be an  
entrepreneur



# Is the invention patentable?

- (i) Eligible subject matter
- (ii) Novel
- (iii) Non-obvious



# Is it eligible subject matter?

$$k = Ae^{-\frac{E_a}{RT}} \quad \text{or} \quad \ln k = -\frac{E_a}{RT} + \ln A$$

$$E=MC^2$$

I don't need to contact OTT because...

...I heard that  
software isn't  
patentable





# Is it new and nonobvious?

Patentability is assessed from the standpoint of one of ordinary skill in the art

What an expert thinks is obvious is not the standard





# Is the invention patentable?

It is just a minor  
improvement or  
discovery



# What happens next? (first weeks and year)

## Office of Technology Transfer

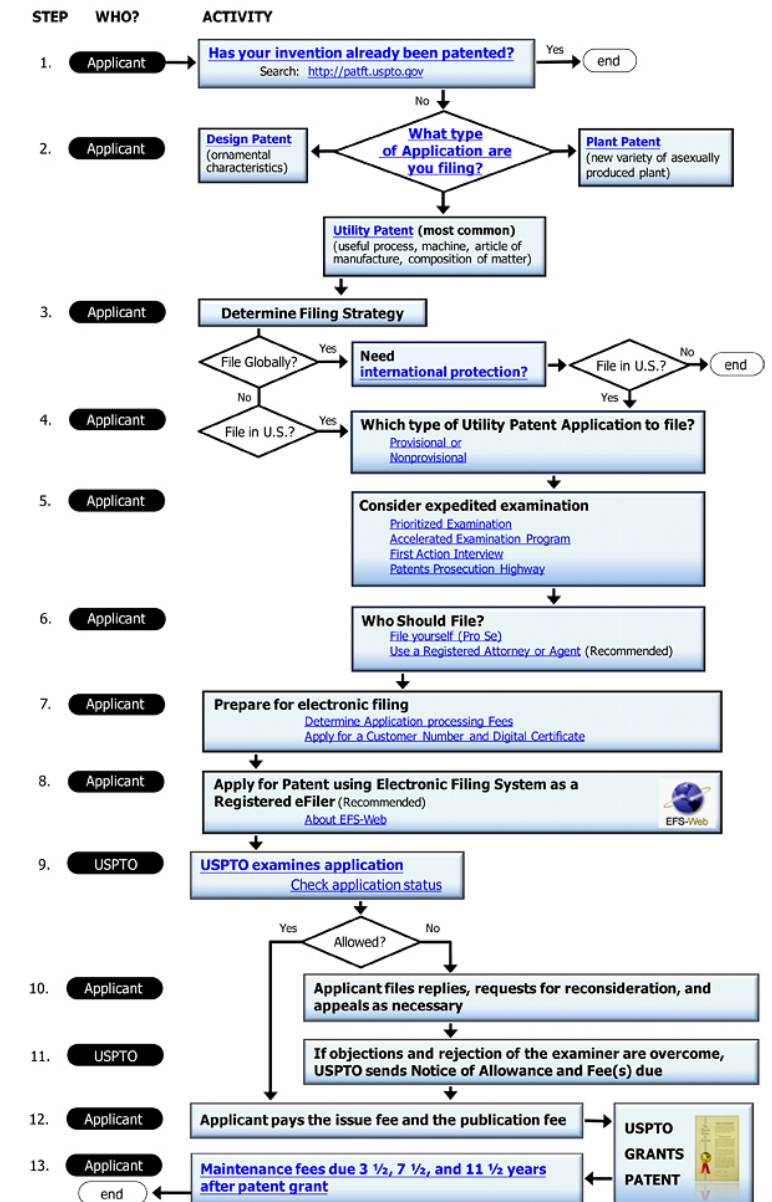
- Like many universities, SU generally starts with a provisional patent application
- No claims needed
- Followed by an assessment of the invention at the 8 or 9 month mark to inform decision making regarding filing a utility patent application

## Outside Counsel

- Preparation and filing of a provisional application
- If approved by OTT, transition to a utility patent application

# Elements of, timing and steps associated with a filed utility patent application

- Prepare a U.S. Utility patent application
- File it with the U.S. Patent Office
- Significance of patent claims
- Other elements of a patent application (abstract, figures, specification, etc.)



I don't need to contact OTT because...

...I want to make it  
publicly available, or at  
least freely available to  
other academics



I don't need to contact OTT because...

...I already published,  
so I can't get a patent





Questions?



# Office of Technology Transfer Team

Jennifer Crisp, J.D.

Director

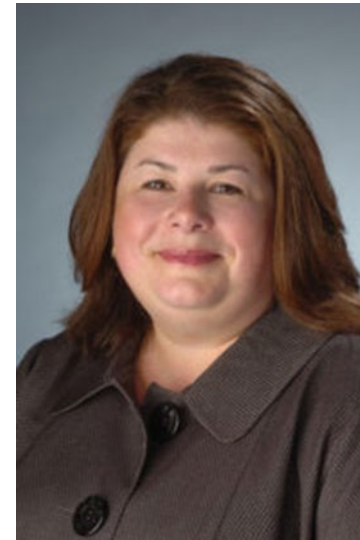
[jmcrisp@syr.edu](mailto:jmcrisp@syr.edu)



Elizabeth Jeffery

Operations Specialist

[jeffery@syr.edu](mailto:jeffery@syr.edu)



Point of contact for  
**intellectual  
property (IP)**  
matters including  
patents, software,  
copyrights, and data  
rights

Syracuse University  
Office of Technology Transfer  
224-226 Lyman Hall, Syracuse, NY 13244  
315-443-5196  
[techtransfer.syr.edu](http://techtransfer.syr.edu)