Seeking a Patent?

If filing a patent is an outcome of your research, you may be bewildered in where to start. To assist this process, the following tips were provided by Dr. Tania Bubela during the 2011 FGSR Professional Development Week session on Intellectual Property for Graduate Students.

Tips

- In determining whether to seek a patent, the following questions should be addressed:
  
  (a) Why am I interested in seeking a patent?;
  (b) Who are the inventor(s) and have I listed all of them?;
  (c) What can I patent (a product or a process);
  (d) Is my invention patentable (Do I have patentable subject matter and meet the 3 patent criteria of novelty, utility and ingenuity));
  (e) Have I (or can I) adequately described my invention (i.e., is my patent fully enabled)?
  (f) When should I seek patent protection?
  (g) Where should I seek patent protection? and
  (h) How should I seek patent protection (provisional patent application, full application at a National Patent Office, under the Paris Convention, full application at a Regional Office, or under the Patent Cooperation Treaty)?

- In determining inventorship as well as obligations to your employer or research institution, become familiar with the terms on intellectual property in your employment contract and/or your institutional intellectual property policy/policies.

- A confidentiality agreement is important to protect your invention and its patentability when discussing it with others (including companies and technology transfer offices) especially prior to filing a patent application. In addition, if you are working in a lab that intends to patent its inventions, all employment contracts should contain confidentiality or non-disclosure terms to ensure that all employees and students are aware of their duty to keep confidential information confidential.

- Whether your research institution has an inventor-owned (University of Alberta), institution-owned or joint intellectual property ownership policy, you should first discuss any potential inventions with the institutional technology transfer office or equivalent. Such offices can provide you with useful guidance, even if you decide to “go it alone” in commercializing your invention.

- Regardless of how you choose to proceed, it is probably worthwhile to seek independent legal advice, since your best interests may not fully align with those of other inventors or with those of the institution.

- Seek assistance in developing the best commercialization strategy (assign, licence or create a start-up). If licensing to an existing company, consider AUTM’s Nine Points to Consider in Licensing University Technology: <http://www.autm.net/source/NinePoints/ninepoints_endorsement.cfm>

At the University of Alberta, information on the intellectual property policies may be found at:

- [http://www.gradstudies.ualberta.ca/degreesuperv/ip.htm](http://www.gradstudies.ualberta.ca/degreesuperv/ip.htm)