Intersection of Patents and Medicine: 5 Tips to Maximize the Inventor’s Rights

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As the medical industry evolves and technology in medical devices becomes more advanced, it is necessary to protect those ideas. Medical device engineers and manufacturers often look to the physician to improve such devices and make related procedures more efficient. To protect their ideas, the inventor must spot the patent-related issues and take advantage of patent law at an early stage, thus avoiding related problems.

Patentable Subject Matter
Patentable subject matter includes medical devices (e.g., a drug-eluting stent), processes (e.g., a method for using a drug-eluting stent), and chemical composition (e.g., a pharmaceutically useful agent), plus new and useful improvements.

Genesis of an Invention
The genesis of an invention process begins with conception of the invention - the formulation in the mind of the inventor(s) of a complete and operative embodiment. Then there is a need to define the conceived idea, often with the help of a patent attorney. The Constitutional policy behind patents is to "[e]ncourage the progress of the useful sciences . . .[s]ecure for the inventor . . . exclusive rights . . . [f]or a limited period", which is 20 years from the filing date.

Types of Patent Applications
There are several types of patent applications - provisional, non provisional utility, design, original, and continuation. They remain secret until published, which is usually 18 months after filing.

Stages of the Patent Process
Stage 1 – Conception to Issuance
Conception to Issuance begins with invention conception, definition and then careful disclosure - if to others and patent counsel - in confidence. The preliminary patent search assesses the invention's novelty and is a useful precursor to a patent application. The patent application often discloses relevant prior art and unsolved problems, describes the invention & how it solves those problems. Drawings depict the invention. The claims (numbered paragraphs) define its scope. The application is examined in the USPTO for novelty and satisfaction of the written description and enablement requirements.

Stage 2 - Issuance to Enforcement
Issuance to Enforcement includes considering the term, maintenance and territoriality of patent coverage. The patent gives you the right to exclude others from use defined by the patent's scope. You can sell it, license it, do nothing or just

frame it. Opinions of counsel may relate to infringement issues.

Top 5 Patent Tips for Inventors

1. Seek a patent for recognition, reward to acquire rights, to exclude others, and to grant a license in return for royalties paid to you.
2. A patent search is prudent before initiating the protection process by filing a patent application. Be sure to recognize your contribution for what it is - a potentially valuable intellectual property.
3. Don't give it away; avoid untimely unprotected disclosure; get professional help early on; be aware of intellectual property issues & opportunities.
4. Be aware that patents can block your research if your use infringes another's valid patent and is unauthorized. Ignorance may be bliss but is not an excuse.
5. "Prior art" may defeat your right to get a patent or limit its scope. Your own prior art includes public disclosure or publication. Beware of premature disclosure.

How Can a Patent Attorney Help?
Dealing with a patent attorney includes thinking about how to select one, things to ask, cost, timing, requesting a written retainer agreement, asking about alternative billing arrangements, seeking opinions, designing around the patents of others and launching patent watch services.

Inventors and entrepreneurs may face the challenges of prototyping, funding, valuation, and writing a credible business (including an exit) plan. There are various funding models including paying with your own funds or seeking an investor. In return for his investment, he will likely receive a percentage of potential profits and you probably will relinquish at least some control.

Your patent attorney may offer or be invited to contribute services or money for equity. Quickening the investor's interest often begin with a non-disclosure (confidentiality) agreement before you make the pitch. There is a due diligence process that should be considered by the serious investor. Valuation of the deal is a key consideration.

For more information, visit Brooks Kushman [1].

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