

Developing Your Patent Portfolio

January 31, 2018

A GC3 Startup Network Webinar



What is the GC3?

- A cross-sector, full value chain business membership organization
- A convener of collaborations to advance green chemistry innovation & practice
- An advocate for government policy & funding that advances green chemistry R&D and innovation

Mission: To make green chemistry standard practice – **Mainstream** – in industry, for innovation, public health, and environmental protection



More than 120 Members Across Sectors and the Value Chain





GC3 Green & Bio-Based Chemistry Startup Network

*Creating an innovation ecosystem for green and
bio-based chemistry technologies*

Goals

- Support green and bio-based chemistry start-ups
- Introduce large strategics to new chemical technologies, partnership and investment opportunities

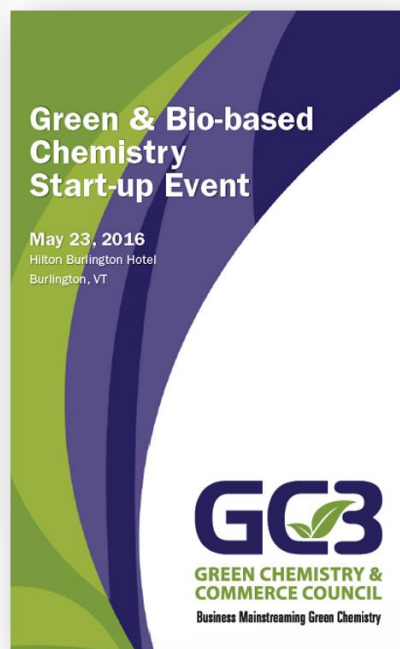


Members of the GC3 Startup Network Include:



GC3 Startup Network Technology Showcases

Workshop on Leveraging Partnerships
to Accelerate Green & Bio-Based
Chemistry Innovation



February 1, 2017

Hosted by

LEVI STRAUSS & CO.

<http://greenchemistryandcommerce.org/startup-network/>





**Calling all innovators developing
green chemicals, materials, products
or manufacturing technologies!**

10 startups will be selected to present
their technology to large companies

Apply by February 16, 2018

Funding for travel costs is available.

<https://greenchemistryandcommerce.org/startup-network/tech-showcase-2018>

**3rd Annual Green & Bio-Based Chemistry
Technology Showcase & Networking Event**

May 8, 2018

Eastman Chemical Company, Kingsport, TN



Technology Needs for the 2018 GC3 Technology Showcase

Adhesives	Fabric Finishes	Monomers/Polymers	Recyclable Latex
Coating Technologies	Flame Retardants	Plasticizers	Recycling Technologies
Corrosion Inhibitors	Fungicides	Polyurethanes	Solvents
Raw materials for formulated consumer products (including personal care and household products)			

The following GC3 members contributed to the list of technology needs:

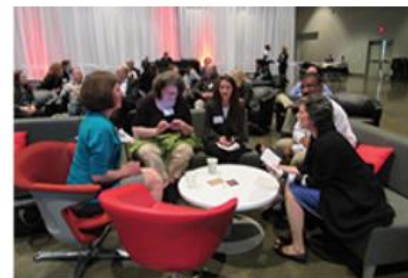
Apple	Johnson & Johnson	Procter & Gamble Company
BASF Corporation	Kingfisher plc	Patagonia
Beiersdorf AG	L'Oréal USA	Sherwin Williams
Best Buy Company, Inc.	Levi Strauss & Co.	Steelcase
Eastman Chemical Company	New Balance	Target





GC3 INNOVATORS ROUNDTABLE

May 8-10, 2018 • Kingsport, TN
Hosted by
EASTMAN



**13th Annual
GC3 Innovators Roundtable**
May 8-10, 2018

**3rd Annual Green & Bio-Based
Chemistry Technology
Showcase & Networking Event**
May 8, 2018

Registration is now open!



Ground Rules

- Due to the number of participants in the webinar, all lines will be muted
- If you have a question or comment, please type it in the “Questions” box located in the control panel
- Questions will be answered at the end of the presentation

Today's Lineup

Moderator



Shana K. Cyr, Ph.D.

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Presenters



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FINNEGAN

Developing Your Patent Portfolio

By

Adriana Burgy and Tom Irving

January 31, 2018



**GREEN CHEMISTRY &
COMMERCE COUNCIL**

Disclaimer

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To File OR Not to File?

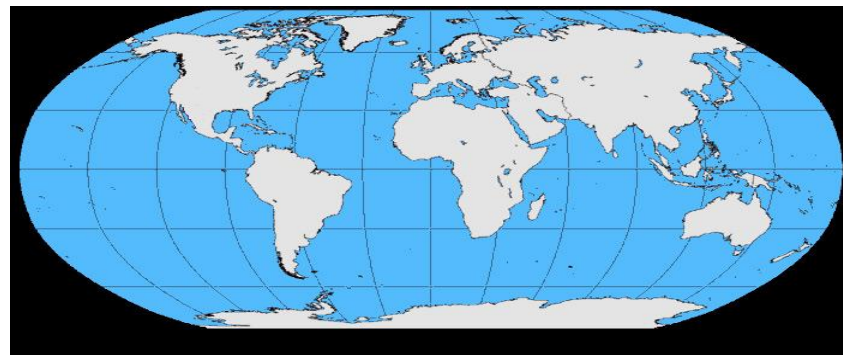
- **Considerations WHEN to file . . .**

- What is your market?
- Patentability . . . new, useful, nonobvious?
- Timing . . . upcoming public disclosure, use or sale?
 - Submission of article, Abstract, poster, meeting with investors or customers
- Type of Application . . . Utility or Design application
- Status of R&D on the invention
- Status of competitors



WHERE to File?

- Where is YOUR Market?
- General Approach:
 - Priority Document
 - File PCT // Non-PCT countries
 - Designate all countries
 - Enter national phase, depending on markets, in selected countries
 - US, Europe, China, Japan, and Taiwan (non-PCT)
- Considerations for prioritizing where to file and maintain patents:
 - Filing/annuity costs vary based on country
 - Enforcement considerations
 - Emerging markets
 - Partners



HOW Many Applications to File

- 35 U.S.C. § 101

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain **a patent** therefor, subject to the conditions and requirements of this title.

- It depends . . .

- By filing a basic application, any later application should contain claims separately patentable over the claims of the basic application. If not, any U.S. patent issuing from the later application may end up expiring on the same day as the basic application.



HOW to Share Information

- Ensure relevant factual information is covered by filed patent applications and/or patents.
- Share with investors *factual* information, not legal conclusions.
- Want to try to avoid later investor suits for fraud in the inducement.
- Confidentiality agreements in place before sharing.
- Consider staggered confidential disclosures of information.
- Trade secret protection vs. U.S. legal requirement of best mode disclosure in patent application.



Other Patent Right Considerations

- **Avoid FORFEITING patent rights:**
 - Pre-issuance:
 - Publishing/presenting with no confidentiality **MORE than ONE year** prior to filing patent application;
 - Failing to respond to an Office Action;
 - Abandonment.
 - Post-issuance:
 - Abandonment;
 - Failing to enter national stages;
 - Failing to pay maintenance fees.



Obviousness

- Chemical examples from USPTO post-KSR tables (MPEP 2143)
 - Combining prior art elements according to known methods to yield predictable results.
 - Anderson's-Black Rock, Inc. v. Pavement Salvage Co., 396 U.S. 57, 62-63 (1969)
 - Simple substitution of one known element for another to obtain predictable results.
 - In re Fout, 675 F.2d 297 (CCPA 1982)
 - Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.
 - DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 464 F.3d 1356, 1360 (Fed. Cir. 2006)

- Other categories from USPTO post-KSR tables (MPEP 2143)
 - Use of known technique to improve similar devices (methods, or products) in the same way.
 - Applying a known technique to a known device (method or product) ready for improvement to yield predictable results.
 - “Obvious To Try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success.
 - Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art.

ASK Questions

- During the preparation and prosecution process, **ASK** your attorney about everything to achieve **VALID** and **ENFORCEABLE** rights.



- The PATENT holder obtains . . .

The right to exclude others from *making, using or selling* the invention throughout the U.S., as well as the right to prevent others from *importing* the invention into the U.S. (35 U.S.C. § 271).

No per se right to use the invention.

Thank you



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Question & Answer

Please enter questions or comments in the “Questions” box located in the control panel.

Upcoming Patent Webinar Series

A GC3 Startup Network Webinar

Part 2: Protecting Your Patents from Post-Grant Challenges

Tuesday, February 27, 2018 at 12:00 PM EST

Part 3: Enforcing Your Patents

Wednesday, March 28, 2018 at 12:00 PM EDT

Visit www.greenchemistryandcommerce.org to register.





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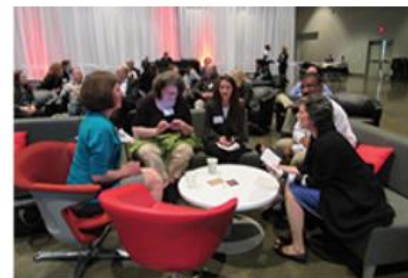
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Thank you for joining us!

For more information about the GC3:
www.greenchemistryandcommerce.org

