

Patentable Inventions Versus Unpatentable: How to Assess and Decide

Rodney L. Sparks, JD, PhD

Rodney L. Sparks, JD, PhD, is biotechnology patent counsel in the Patent Department at the University of Virginia Patent Foundation in Charlottesville, Virginia.

Introduction

When a technology transfer office receives an invention disclosure, the technology must be assessed for its potential marketability and patentability. Patentability opinions prepared by patent lawyers can be quite expensive, and the opinions are usually not guarantees that a technology is either patentable or unpatentable. Therefore, in most cases, the initial assessment is performed by the technology transfer office. If the technology passes initial scrutiny, an application can be filed or a patent attorney can be consulted if a more expert opinion is needed. This chapter summarizes some of the laws governing patentability and how they can be applied during an assessment of a new invention disclosure. Included at the end of this chapter is a glossary of commonly used patent or related terms, particularly terms used in this chapter.