

An introduction to intellectual property at UniServices

UniServices seeks to protect and commercialise the University's IP. Patents (which cover inventions) are one key way of doing this.

A patent is an exclusive monopoly right granted by the state over a strictly defined invention. The term of a patent is 20 years from the filing date.

The principle of the patent system is that the inventor discloses their invention to the public, and in return receives the state-granted monopoly over the invention.

Requirements for patent grant

To grant a patent, the state patent office must be satisfied that several criteria are met. The most important are Novelty, Inventive step and Sufficient Description.

1. Novelty

An invention is novel provided it has never before been publicly disclosed.

Disclosure includes:

- Presentation, poster or paper at a public seminar/conference
- Public use or commercial use (e.g. selling the invention)
- Publication on the internet or in any journal/book/magazine.

If the invention has been publicly disclosed before the filing date, it is no longer novel therefore will not be granted a valid patent.

2. Inventive Step

An inventive step means that the invention is not "obvious". The assessment of obviousness differs between jurisdictions. The key question to ask is:

"Based on the prior art would a person of skill in the field of the invention find the invention to be an obvious development of the prior art?"

Prior art means the body of knowledge available before the filing date.

If the invention is surprising or unexpected, this indicates that it has an inventive step.

If the invention is merely a combination of knowledge that would normally be combined, this indicates that the invention is obvious (i.e. lacks an inventive step).

3. Sufficient description

The patent specification must include a description of the invention that enables it to be understood and repeated.

Evidence that the invention works is also often required. If evidence is not available, this indicates that it is too early to file a patent application.

Working examples of the invention are typically included within the description. These demonstrate to the reader that the invention has been made and works. Patent examiners may refuse to grant a patent if evidence supporting the invention is not presented in the specification.

IP team

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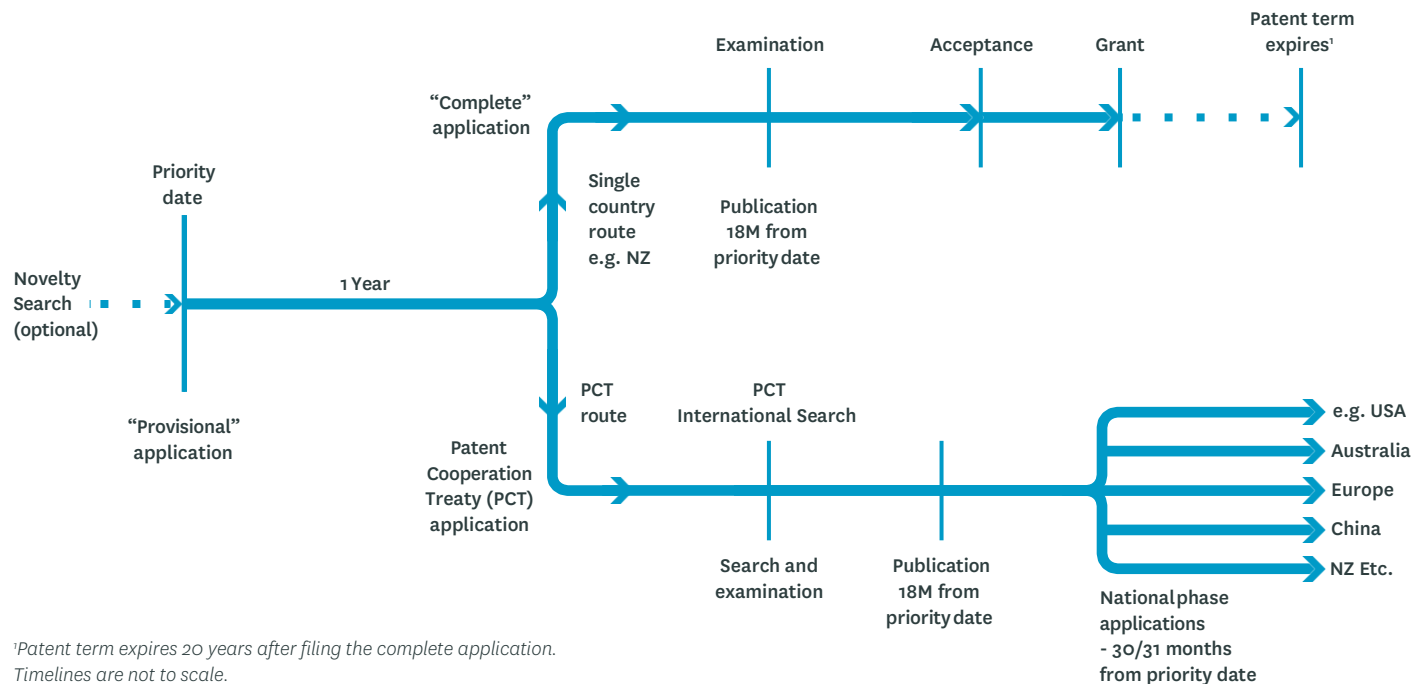
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Patent application timeline



Infringement of claims

The patent claims are numbered statements defining the exclusive rights granted by the patent. They can generally be divided into either product claims or process claims.

Product claims cover a particular entity, e.g.

- a chemical compound
- a medical device

Process claims cover a process/method, e.g.

- a method of manufacturing
- a method of treatment of disease

A claim is infringed if a third party makes, uses or sells the product or process.

Freedom to operate (FTO)

Freedom to operate refers to the ability of a party to use or sell a product or service without infringing the patent rights of another party.

FTO searching is an assessment of existing rights in a particular jurisdiction to check whether the commercialisation or use of a product will infringe the claims of a granted patent.

FTO searching is an expensive and time-consuming exercise that should only be carried out by patent attorneys. Likewise asserting that a party has freedom to operate should only be done after consultation with a patent attorney.

Ownership of University IP

The IP developed by all staff members at the University of Auckland is owned by UniServices under an agreement between the two. IP developed by students is owned by themselves. However, student IP is rarely created solely by the student. If the idea is conceived or developed by their supervisor, the University is a joint-owner.

As owner or joint-owner of IP, UniServices has the opportunity to commercialise the IP from the University.

Benefits to Researchers

Researchers will be invited to sign a Revenue Sharing Agreement where they share in a percentage of any profits made from commercialisation of the research (e.g. through licensing royalties or sale of a product).

If a spin-out company is established to develop the technology, some Researchers may prefer to be involved as founders or employees of the new company, or consultants to the company. If so, the Researchers will obtain equity, a salary and/or consultancy fees.

Often commercialisation leads to follow-on funding opportunities to develop the research further, or address specific problems encountered.