

Fact Sheet on Patents at Oracle

1. What is a patent?

A patent is a monopoly granted to the inventor by the United States government for 20 years in exchange for a full written description on how to make and use the invention, so that after 20 years the invention can be made and used by anyone in the public without restriction. The monopoly gives the inventor or her assignee the right to exclude others from making, using, offering for sale, or selling her invention throughout the U.S. or importing her invention into the U.S.. The purpose of the patent system is “to promote the progress of science and the useful arts.” [United States Constitution]

The U.S. Patent and Trademark Office (USPTO) is responsible for administering the patent system and the birth-to-death lifecycle of each U.S. patent. The official process of obtaining a patent starts with a patent application (having a written description of the invention, figures about the invention, and claims covering the scope of the invention) filed with the USPTO. A USPTO Examiner, who is a skilled person in the subject matter of the invention, then does a search of the prior art and reviews the patent application to determine if it is patentable, i.e., novel, useful, and non-obvious. Typically, there is a back and forth between the Examiner and the inventor or his patent attorney to adjust the scope of the invention, i.e., the claims, to exclude the prior art and only cover what is new and non-obvious. If the Examiner decides that the claimed invention is patentable then the patent application is granted as a US patent. The US government maintains the enforceable patent for 20 years after filing.

The granted U.S. patent can be enforced against another’s product by a trial in U.S. Federal District Court. The court will decide whether an accused product infringes the asserted claims of the patent and whether the asserted claims are valid –typically new and non-obvious over the prior art. Trial is by judge or jury. Monetary damages and/or an injunction may be awarded, if one or more of the asserted claims are found to be infringed and valid. Appeal of the District Court decision can be made to the Court of Appeals for the Federal Circuit and then to the U.S. Supreme Court.

2. What is patentable?

To meet the statutory requirements for patentability, an invention must be novel, useful, and non-obvious. An invention is *novel* if it is different from what was previously known or used anywhere in the world before the invention was made. This objective narrow inquiry is directed to a very broad base of existing knowledge and experience (known as *prior art*). Practically, this novelty requirement is determined by the USPTO Examiner after doing a prior art search of publications published and published patent applications filed before the filing date of invention. An invention satisfies the *useful* requirement if it has some practical application. An invention is *non-obvious*, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would not have been obvious at the time the invention was made to a person having ordinary skill in the art. This inquiry is subjective [and somewhat circular] and addresses the broader question of whether the invention makes enough of an advancement to be patentable. Non-obviousness is a tricky and difficult legal question.

In addition, the written description must *enable* one reasonably skilled in the art, without undue experimentation, to make and use the invention from reading the description in the patent coupled with information well-known in the art. A prototype or an actual implementation is not

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required. However, mere ideas of what the invention is without a description of how to build the invention is not enabling.

3. When must I file my patent application?

There are certain time limits in which you must file your patent application, otherwise you lose the right to a patent. In the U.S. there is a one-year grace period from the time you first publically disclose your invention to when you must file. Public disclosure includes: publication (e.g., journals, white papers, manuals), public use (e.g., trade shows, demos), general product availability (G.A), sale or offer to sell the invention. Disclosure of the invention under a Non-Disclosure Agreement (NDA) or Confidential Disclosure Agreement (CDA) is not considered a public disclosure.

Patent protection is territorial [a US patent only protects you in the US]. Thus for foreign protection, Oracle must obtain patent protection country by country. For most foreign countries, there is no grace period and you must file a patent application before any public disclosure of the invention.

4. What should I try to patent?

While determining patentability is a legal question for patent counsel, Oracle's developers are first aware of the technological advancements they and their co-workers innovate. Essentially, those innovations which bring new functionality, enhance existing functionality, or solve problems are patent candidates, if they past the four-part test below:

- i. To your knowledge, is the candidate either new or an improvement over known industry solutions? [new]
- ii. To your knowledge, is there a significant technical difference between the candidate and the prior industry solutions? [non-obvious]
- iii. Do you have enough information to explain to a colleague how to build your invention, at least, at the functional level? [enabling]
- iv. Does the candidate significantly add or enhance functions or features or significantly improve performance? [business value]

If the inventor determines the patent candidate test above is passed, then disclosure of the patent candidate to Oracle Legal for a patent filing decision is initiated by completing the Invention Disclosure Wizard at: <http://www.oracle.com/webapps/token/fip>. Oracle Patent Operations will acknowledge receipt of the disclosure and assign an Oracle Invention Disclosure reference number (ORA#). Questions on the Invention Disclosure Wizard should be sent to patops_us@oracle.com. The ORA# should be referenced when assigned.

The invention is evaluated by Oracle's patent counsel and the Patent Review Committee (PRC) for the technical area of the invention (e.g., MW, Apps, DB/EM, GBU, ME, Labs/OS, or Storage/Systems). The inventor is notified whether or not a patent application will be pursued for the patent candidate.

If a patent application is approved to be pursued, then a patent attorney from an outside law firm will be assigned by Oracle Legal to draft the patent application. The patent attorney will arrange a disclosure meeting where the inventor will provide a detailed and complete description of the invention and disclose relevant prior art. The patent attorney then drafts the patent application

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(including the claims, written description, and drawings) for review by the inventor(s). Once an application has been completed, the inventor executes a Declaration as to inventorship and an Assignment transferring patent rights to Oracle. The application is then filed with the USPTO for examination.

From filing of the patent application till the patent is granted, the inventor has a duty to disclose to the USPTO via the outside patent attorney or in-house Oracle patent counsel any material information or prior art of which he/she becomes aware.

4. What is Oracle's policy on the inventor searching the prior art?

Oracle has a strict policy on searching for published patent applications and issued patents. Please read the "Policy on Patent Communications and Searches" under "Policies - Patents/Standards" on the [Oracle Patent Website](#).

You may search products and non-patent publications. While under US law, there is no duty to do a prior art search by the inventor, a search by you may be advisable if you are unsure of whether your invention is new in the industry. You will need to disclose in the invention disclosure or at the meeting with outside patent counsel any very relevant prior art you find. Besides being required by law, the disclosed prior art will make for a better patent.

5. Who is an inventor?

The most important consideration in determining inventorship is the *conception* of the invention. There can be several joint inventors so long as each contributes to the conception of the claimed invention. Conception starts when a definite and permanent idea of an operative invention including every feature of the subject matter sought to be patented is known. And is finished when the inventor is able to make a disclosure which would enable a person of ordinary skill in the art to make and use the invention without extensive research or experimentation.

6. What is the inventor award for participating in the patenting program?

Oracle employees worldwide who are named as inventors on a US utility patent application are eligible to receive up to US \$1500 upon filing of the non-provisional patent application. Awards are capped at US \$4500 for each patent application, so four or more inventors on a single patent application evenly split the capped amount of the award. A commemorative plaque is presented to Oracle employees in recognition of a granted patent. No monetary award is paid on the grant of a patent. Notwithstanding the above, award payments are subject to local law and the discretion of the Oracle patent department.

See "Oracle Patent Award Program" under "Links-Patents/Standard" on the [Oracle Patent Website](#).

7. How long does the patent process take?

Disclosure of the invention, review by the PRC, and preparation of the application generally takes 3-6 months. Once a patent application is filed, the USPTO examination ("prosecution" of

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the application) takes about four years till grant. When the patent is granted, the inventor will be notified, and an inventor plaque will be awarded.

8. What is the America Invents Act – the NEW Patent law? [first-to-invent -> first-to-file]

The Leahy-Smith America Invents Act (AIA) represents the most significant change to the U.S. patent system since the Patent Act of 1952. The AIA applies to all patent applications filed on or after March 16, 2013. One major goal was to harmonize U.S. patent law with the rest of the world by changing from a "first-to-invent" to a "first-to-file" system.

Under the U.S. patent law prior to the AIA, the first person to invent is granted the patent, even if a later inventor files a patent application first, as long as the first inventor can prove earlier invention conception date and diligence (no unreasonable delay in filing).

Under the AIA the first patent filer gets the patent and the date of invention is irrelevant. Thus it does not matter who thought of idea first and practically, it does not matter if someone took your idea and filed first, it is a race to the USPTO. Thus there is need to submit Invention Disclosures early, so Oracle Legal can file patent applications early.

9. Questions on Patents at Oracle?

You can ask the Oracle Legal Patent Counsel supporting your group or you can send email to patents_us@oracle.com.