



Intellectual Property Workshop

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Intellectual Property Basics

This information is provided as part of an Intellectual Property and Technology Management Seminar to familiarize audience members with the basic elements of intellectual property issues. It is not legal advice and should not be used as a substitute for advice of competent counsel.





Understanding IP & Technology Transfer Different Views

◆ Intellectual Property - knowledge “ownership”

Patents

Copyrights

Know-how

Trade Secrets

Trademarks

◆ Technology Transfer Professional Views

Licensing

Sponsored Research Agreements

Cooperative R&D Agreements

◆ Researcher Views

Consulting

Publications

Collegial Interchange

Seminars

Conferences

Graduates

◆ Company Views

Licensing

Consulting

“Body Snatching”





Researcher Motivation

- ◆ **The Bayh-Dole Act of 1980**
 - **Allowed Universities to take ownership of Intellectual Property from Federally funded research.**
 - **Obligates the university to proactively protect and market the technology or return it to the Federal funding agency.**
- ◆ **Researcher Motivation to Seek IP Protection**
 - **University employees are legally bound**
 - **Attract industrial sponsorship**
 - **See the fruits of your research commercialized**
 - **Hit the Royalties Jackpot - less than 1% chance**



Universal Researcher Concerns

- ◆ **The technology disclosure and patenting process is tedious - true, but help is available**
- ◆ **It stops me from publishing, which is my primary mission - false, especially with provisional patents**
- ◆ **I haven't been familiarized with the processes of intellectual property protection and commercialization - that's why we're here**

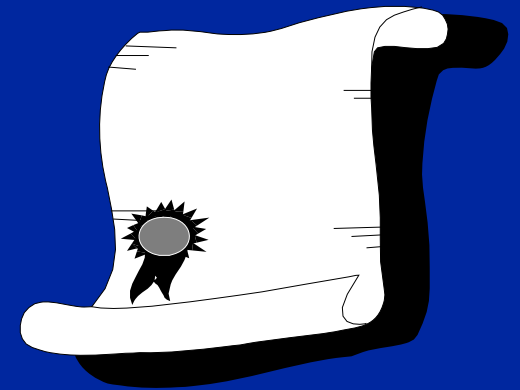


Who is an Inventor

- ◆ **First person(s) who conceives and reduces the invention to practice**
- ◆ **Inventorship dependent on idea generators (originality)**
- ◆ **Co-inventors can work independently, but stream of ideas must lead to invention**
- ◆ **Technology Disclosure should list inventors, review by patent counsel**



What is a Patent?



- ◆ A patent is a vehicle which details the invention which one 'owns'. Allows one to exclude others from making, using, or selling
- ◆ A patent must:
 - Be enabling (teach)
 - Show the best mode for one to practice the invention
- ◆ A patent contains a title, abstract, narrative, etc. and *CLAIMS*



Patentability is Dependent on:

◆ Statutory Class

- Machines
- Articles of manufacture
- Composition of matter
- Processes
- Improvements on the above

◆ Newness - (1) Novelty (2) Non-Obvious

◆ Usefulness - not easily defined, don't have to supply prototype, just good faith justification in confidence of results



Patent Categories

Type	Applies To:	Life
Utility	process machines compositions of matter etc.	20 years from application
Design	Ornamental Design	14 years from issue
Plant	Asexually Producible Plants	17 years from issue



Patent Application Process

Patent Applicant

Patent Filing

Response

8-12 months

3 months

3 months

3 months

3 months

Office Action

Final Office Action

Allowance

Issue

US Patent & Trademark Office





Public Disclosure

- ◆ **Public disclosure can include:**
 - **Publications in open literature**
 - **Poster Sessions & Abstracts**
 - **Presentations to open forum**
 - **Can be personal communications without some confidentiality agreement**
 - **Catalogues and libraries**

- ◆ **Primary discriminators are**
 - **good faith attempt to maintain secrecy**
 - **substantiality of material disclosed**



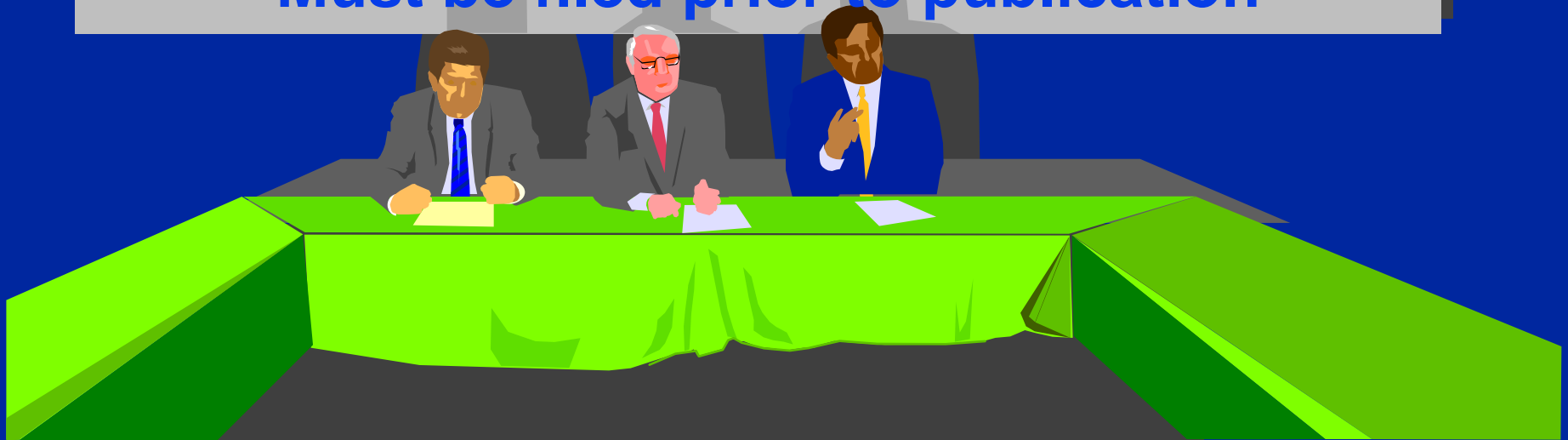
Public Disclosure vs. Patent Filing

US Patents Application

Must be filed within one year of disclosure

Foreign Patent Application

Must be filed prior to publication





US vs. Foreign Patents

- ◆ **First to file (foreign) vs. first to invent (US)**
- ◆ **Foreign patent time frame:**
 - **File within one year of US patent application**
 - **No previous disclosure allowed**
- ◆ **Reasons to file foreign**
 - **Global economy**
 - **Company interest in locking out competitors in foreign countries**



Provisional Patent Application

- ◆ **Primarily of use to entrepreneurs, small companies, and universities in a time bind**
- ◆ **Allows 1 year protection before patent application**
- ◆ **Sets Priority Date without counting against 20 year patent term**
- ◆ **Less expensive (maybe), but delays examination by US Patent & Trademark Office**



Patents vs. Trade Secrets

- ◆ **Trade Secret - information concerning a technology held in confidence by an organization**
- ◆ **Basic issue revolves around best protection. Dependent on:**
 - **Can it be kept secret longer than 20 years**
 - **Projected life of technology**
 - **Value of technology**
 - **Competitors, market entry barriers, etc.**



Copyrights

- ◆ Protects expression of an idea
- ◆ Must show originality (not trivial) & fixation in a tangible form
- ◆ Unlike patents, no requirement for exclusion of prior art
- ◆ Simple filing by UF Office of Technology Licensing to Library of Congress
- ◆ Term - life of author + 50 years



Copyrighting Software

- ◆ **Protection for any type of code**
- ◆ **Copyright, University of Florida 1998, All Rights Reserved - recommended on**
 - **distribution medium**
 - **when program is executed**
 - **within executable code, to appear if program is reverse-compiled**
- ◆ **Copyright protection provides right to control:**
 - **Duplication other than for archival purposes**
 - **Preparation of derivative versions for distribution**
 - **Distribution of copies of the software**



Trademarks / Servicemarks

- ◆ **Covers use of a name to describe a product or service - Gatorade®**
- ◆ **Term - for life while in use**
- ◆ **Filing Requirements - USPTO does a search for name and use**



UF IP Policies and Trends





Florida University Commercialization

Gatorade



Taxol



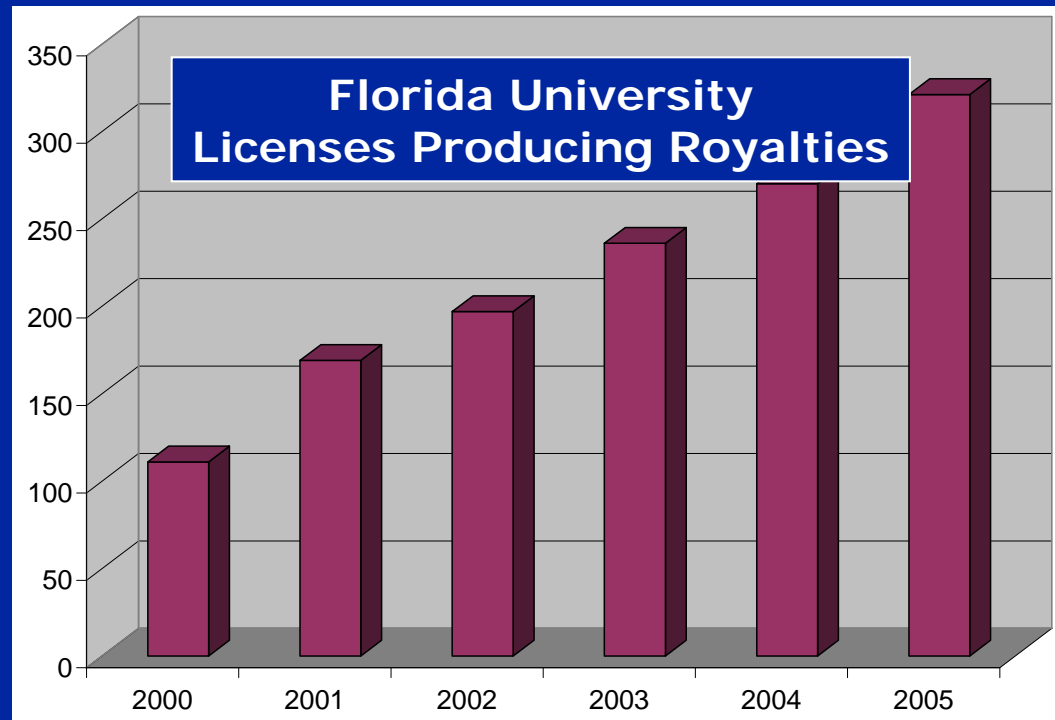
Trusopt



Gossamer Fans



Sentricon





UF Technology Disclosure

- ◆ **What needs to be disclosed? All Technologies.**
UF interest:
 - In the field of expertise or
 - With use of university resources
 - Invention Disclosure Form (www.otl.ufl.edu)

- ◆ **When do consulting activities / outside interests need to be disclosed? Better early than late.**
 - Protection of technology
 - Initiate the process / get a ruling early



UF Disclosure Review

- ◆ Disclosures are reviewed monthly in Office of Technology Licensing based on:
 - interested potential licensee(s)
 - US and foreign patent opportunities
 - potential market size, penetration, returns to UF
 - administrative complications
 - enforceability
- ◆ Office of Technology Licensing options
 - Accept UF's right to the technology
 - Waive UF's right to sponsoring agency or inventor
 - Incomplete disclosure requiring further input



Distribution of Net License Revenues

- ◆ About 10% of patented technologies ever earn more than the cost of the patent.
- ◆ Less than 1/2% chance that a patented technology will be a big winner.

	<i>Net Revenue < 500k</i>	<i>Net Revenue > 500k</i>
Inventor(s)	40%	25%
Program(s)	10%	10%
Dept(s)	7.5%	10%
College(s)	7.5%	10%
ORTGE	35%	45%

Source: UF ORTGE and OTL



Record Keeping Requirements

Record all lab information in a bound notebook

Each entry must be signed and dated

Corroborate all entries by a knowledgeable person

Original entries should never be erased

Revue and retain all records

Data stored on a computer must be printed,
permanently bound, signed, and dated

