

Intellectual Property Technology Transfer

Joe Figueira
Associate Vice Chancellor

Montana Tech

The University of Montana

Purpose of Presentation

- What is Intellectual Property (IP)
- How we Protect and License IP
- What is Technology Transfer
- Resources

Montana Tech Mission Statement

"To meet the changing needs of society by
supplying knowledge
and education through a strong
undergraduate curriculum augmented by
research,
graduate education and service"

Types of Intellectual Property

- Know How
- Copyright
- Trademark
- Trade Secrets
- Patents

Patent

"...the right to exclude others from making,
using, or selling the invention throughout
the United States"

- But, must be
 - Novel
 - Useful
 - Non-Obvious

Montana Tech Patent Policy

- Employees assign patent rights to Montana Tech as a condition of employment
- Applies to salaried student workers
- Can be extend to unsalaried students
- Montana Tech obtains patent
- Revenue sharing with Inventors
 - Tech – 50% of royalties and licensing income
 - Inventors – 50% of royalties and licensing income

Typical Sponsored Research Agreements

- If there is a MT Invention, MT Files Patent(s) and Retains Ownership
- Inventorship specified in filing and may include company employees
- Company May Have Option to License
- University Can Publish Results

What is Patentable?

- Processes
- Machines
- Compositions of Matter
- Improvements on the Above
- Software – under certain circumstances

When to File a Patent

- U.S. – Must File Within One Year of Public Disclosure
- Foreign – Must File before Public Disclosure
- Provisional Patents add one year of coverage

Patent Costs

- U.S. \$5,000 - \$25,000
- Provisional Patent ~ \$500
- Foreign ~ \$200,000 or More
- Who Pays
 - Licensee Commitment before Incurring Patent Costs
 - Use of program generated IDCs

Public Disclosure Examples

- Publication (including enabling abstract)
- Seminars/Conferences
- Sale or Distribution of Product
- Electronic Disclosure

Methods of Protecting Intellectual Property

- Laboratory Notebooks
- Confidentiality Agreements
- Material Transfer Agreements
- Research Agreements
- Provisional Patent Applications

Laboratory Notebooks

- Evidence in Patent Disputes
- Establishes Dates of Conception and Reduction to Practice
- Use Best Practices, Date Entries, and obtain witness signature
- Notebooks Are MT Property Under the Management of the PI

Confidentiality and Non-Disclosure Agreements

- Recipient Agrees in Writing Not to Disclose
- Allows Disclosure Without Impacting Patentability
- Obtain Review by Research Office

Material Transfer Agreements

- Allows Sharing of Proprietary Materials without Barring Patentability
- Materials Typically Must Be Destroyed or Returned After Use
- Must Be Reviewed by Research Office

Testing Agreements Works for Hire Agreements

- Recognizes that MT is Testing or Studying IP Owned by Another Entity
- Used When Testing or Studying Services Are Not Expected to Develop New IP
- These Types of Agreements are Discouraged

Patents - Where to Start: MT Invention Disclosure

- File MT Invention Disclosure with RO
 - This is Not a Public Disclosure
 - Starts Process for Market Evaluation, IP Protection, and Potential Patenting
- What is the Invention, Who are the Inventors, Who Funded the Work
 - Bayh Dole Filing if Necessary
- Must Process Disclosure in 18 Months
- Form Available on WEB

Invention Disclosure Form

—In Confidence—

Montana Tech # _____
Date Rec'd _____

THE UNIVERSITY OF MONTANA
INVENTION DISCLOSURE

In order to afford maximum protection and to comply with the requirements of College Policy and Government Contracts and Grants Policy it is important that inventions or discoveries, which may be patentable, be reported to the Office of Research and Graduate Studies at the earliest possible date.

PLEASE COMPLY WITH THE FOLLOWING DIRECTIONS IN COMPLETING THIS FORM:

- Fill out and retain one copy as a permanent record.
- Use supplemental sheets if necessary to amplify this information.
- If you cannot answer any questions at this time, please so indicate.

1. Full names, addresses, and phone numbers of the inventor or inventors. Title and position (or other status) _____
2. Invention Title _____
3. Concise description of invention: Attach a description of the invention, with photographs, drawings, sketches, or any other descriptive material. Description should be sufficiently detailed to enable one skilled in the art to understand and reproduce the invention and should include the construction, the principles involved, the details of operation, and alternative methods of construction or operation. Include any supporting evidence such as copy of laboratory notes, computer programs, drawings, etc. Be certain the description covers the following points:
 - (a) Problem to be solved, or purpose of the invention
 - (b) How invention solves problem
 - (c) Similar inventions in current use, or old manner of performing the function of the invention
 - (d) Disadvantages of old means
 - (e) Degree of development
4. Date and place at which discovery was made: _____

A Patent Does Not Necessarily Imply Value

The US Patent Office makes no determination regarding worth or commercialization potential.

What Sells a Patent

- Value Proposition: 10x - Faster, Cheaper, Better
- Ongoing Research at MT
- Inventors Available to Continue Work
- Proof of Concept
- Peer Review Publications
- Existing Market

Technology Transfer

- Creation and of Protection of IP
- Build Relationships with Industry
 - License Technology
 - Formulate Commercialization Plans
 - Develop and market product
- Royalties to MT and Inventors

Benefits of Technology Transfer

External

- Cheaper, better, faster solution in the market place
- Local and Regional Economic Development
- Opportunity to Develop New Industrial Partnerships

Internal

- Education and Employment of Students
- Research Grants for Faculty
- Publications
- Patenting/Licensing Fees

Potential Pitfalls - Conflict of Interest

- If Researcher or family members have a financial interest in companies which *sponsor research* in your lab or *license technologies*, and they receive,
 - \$10,000 or greater benefit per year
 - 5% or greater ownership in companyThen a potential Conflict of Interest Exists
- Report on Annual COI Declaration
- Put COI management plan in place

Regents Policy 407

- Designed to encourage technology transfer
- Are you (or any of the creators) currently or do you contemplate becoming an employee, officer, board member, or owner in an entity which has (or wishes to have) rights to this creation?
- Is so, seek 407 Exemption

Summary

- Intellectual Property
 - How we identify
 - How we protect
- Technology Transfer
 - Determining value
 - Process
- First Stop – Research Office

Resources

- Intellectual Property
 - http://www.mtech.edu/research/policies/images/invention_disclosure_form.pdf
 - <http://mus.edu/borpol/bor400/401-2.htm>
- Technology Transfer
 - http://www.mtech.edu/research/policies/images/coi_disclosure_form.pdf
 - http://www.mtech.edu/research/policies/images/mt_conflict_of_interest_policy_1-2-2008.pdf