

INTELLECTUAL PROPERTY BASIC FOR THE RESEARCH ADMINISTRATOR

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IP BASICS – WHAT IS INTELLECTUAL PROPERTY?

- IP is a broad term defined as tangible and intangible property which includes
 - artistic and commercial creations of the mind,
 - musical, literary and artistic works,
 - ideas,
 - discoveries and inventions,
 - words, phrases, symbols, designs,
 - data, materials,
 - formulas, methods, systems

IP BASICS – WHAT IS IP?

- . It includes those elements of institutional research that can be protected as
 - patents
 - copyright,
 - copyrightable software
 - Trademarks
 - Service marks
 - Trade secrets

IP BASICS – Trade Secret DEFINITION

- Intellectual Property that is protected by keeping key information about the IP Secret

IP BASICS – Trademark /Service Mark DEFINITION

- distinctive names/signs or indicators used by an individual, business, or seller of goods or services that help customers identify a particular product represented by itself or its merchandise and used to distinguish its product from competitors products.
- A trademark can be either “TM” not yet registered or ® registered.

IP BASICS – OTHER IP /Residuals

- Data
- Materials
- Tissues
- Lists
- Ideas
- Know-how

IP BASICS – COPYRIGHT DEFINITION

- original works of authorship fixed in any tangible medium of expression that can be perceived, reproduced or otherwise communicated either directly or with the aid of a machine or device.

IP BASICS – COPYRIGHT DEFINITION

- Works of authorship include literary works, musical works, dramatic works, pantomimes and choreographic works pictorial or graphic works, audiovisual works, sound records, architectural works, and computer software.

IP BASICS-COPYRIGHT PROTECTION

- Copyright protection is provided by Title 17 of the United States Code
- No copyright notice or registration is needed to obtain copyright protection
- registering a copyright does give the copyright owner additional legal enforcement rights
- provides the owner of the copyright with the exclusive right to reproduce, prepare new versions (derivative works), to publicly display and distribute and perform the derivative.

IP BASICS – COPYRIGHT PROTECTION

- Protection is not provided for:
 - any idea, procedure, process, system, method of operation, concept, principle or discovery, regardless of form in which it is described, explained, illustrated or embodied in such work

IP BASICS –COPYRIGHT OWNERSHIP & USE

- Protection good for life of author plus 70 Years
- Exceptions to right to protection, duration, (“fair use”, satire, amt of change, non-commercial, educational non-profit use, etc.)
- Library Staff
- IT staff
- Legal Counsel

IP BASICS – COPYRIGHT

WHAT IS YOUR POLICY?

- Works of authorship and scholarly articles- does institution take ownership? Does creator retain ownership?
- What about curriculum development, educational materials?
- What about copyrightable software?
- How do you make sure your faculty remain compliant with copyright laws?

IP BASICS – INVENTION/PATENT DEFINITION

- Patentable inventions are tangible, useful, novel and non-obvious intellectual property assets that have been conceived and reduced to practice
 - Conception is the mental “idea” of an invention that occurs to the Inventor
 - Reduction to practice is the physical manifestation of the idea, which demonstrates that the conception will work in the real world

IP BASICS – INVENTION/PATENT DEFINITION

- Tangible: an item or “thing” is created
- Useful: has some kind of “industrial” purpose or use as opposed to aesthetic or artistic value.
- Non-obvious: the idea would be so obvious to a person skilled in the art that it really isn’t a new idea at all
 - What about Improvements to an existing idea?

IP BASICS-Invention/Patent Definition

- Novel: invention was not available to the public in any way before the filing date of the patent and was not available in any publication prior to that date either. This is called "prior art". In the US there is a one year grace period after publication in which you can still file for patent protection. However, this is not available worldwide.

IP BASICS – Invention/Patent Definition

- An Inventor is an individual that contributes in whole or in part to the conception of the invention. Persons that contribute solely to the reduction of the invention to practice are not considered inventors under patent law.
 - Failure to list all inventors on a patent application can invalidate the patent.

IP BASICS – Invention/Patent Definitions

- Conceived: the mental “idea” of an invention that occurs to the Inventor
- Reduced to Practice: physical manifestation of the idea, which demonstrates that the conception will work in the real world

IP BASICS –Invention/Patent

PURPOSE

- Encourage Innovation
- Speed Innovation
- Public dissemination of technology to avoid societal loss
- Grants a 20 year monopoly - the right to exclude others' use of the invention (infringement)
- Inventor's potential to recover costs of discovery

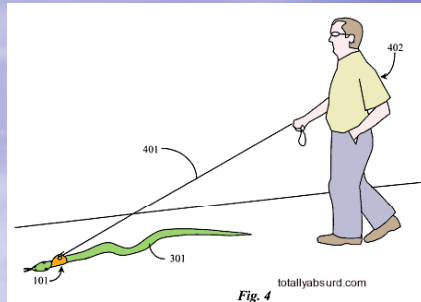
IP BASICS – INVENTION/PATENT PROTECTION

- Inventions are protected under U.S. Patent law (Citations) Each country has its' own patent laws.
- A Patent Application is filed with the U.S. Patent office
- Patent Office reviews application for patentability criteria and breadth of claims – request additional information/argument, etc.- (Inventor argues to broaden coverage, Patent office argues to narrow coverage
- If criteria met, Patent Office “Issues” a Patent

IP BASICS – INVENTION/PATENT PROTECTION



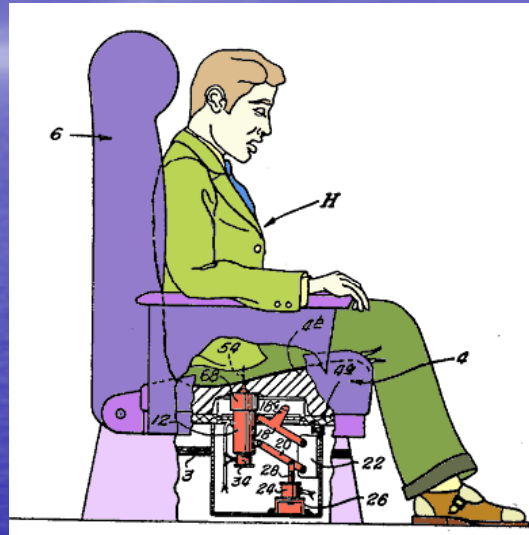
Snake Walker



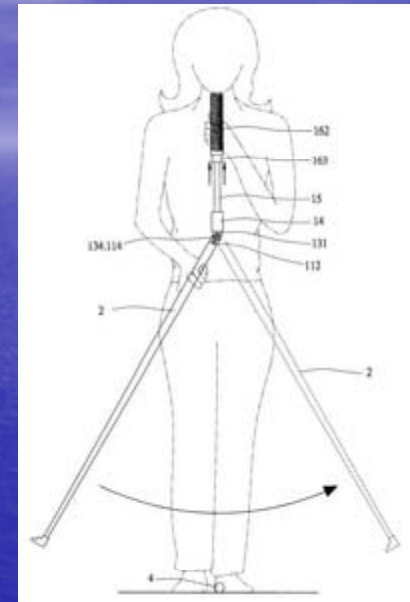
Beerrella – patent # 6637447



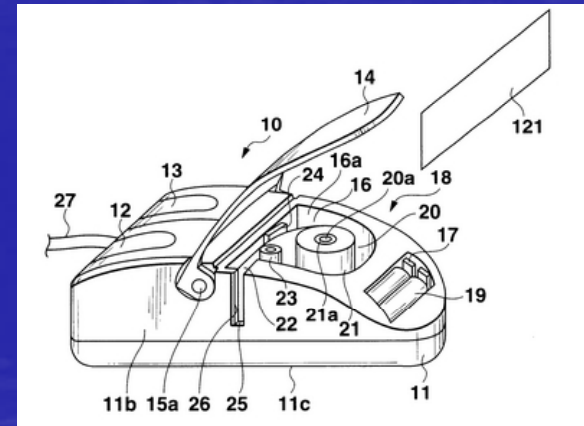
Hijacker Injector - 1974



Chin Putter Patent #6659880



Mouse with "tiny" printer patent # 6650315



IP BASICS –Inventions/Patents Protection

- Patent protection can be expensive – filing fees, attorney fees, etc. (\$10-20K US, more for international filings)
- Patents must be maintained (additional fees at x years)
- Must have a market in order to recover costs of prosecution and maintenance

IP BASICS – Inventions/Patents Ownership & Institutional Policy

Most Institutions retain all rights, title and interest (ownership) of patentable inventions that their employees (and yes, faculty are employees) create using university resources (equipment, office space, people, salary)

Policies usually provide a return of a portion of any net license/royalty income with the inventors.

IP BASICS-Invention/Patent Institutional Policy

- Protecting Institutional IP & Publication
- “public realm”
- Proposals with “enabling” information
- “provisional” patent filings –US only . . . For now
- Internal Disclosure requirement and process
- Reporting requirements to sponsors.
 - Mandatory positive and/or negative reporting requirements

IP BASICS – Technology Transfer Terminology

- Ownership – retain all rights, title and interest in the intellectual property
- Assignment – giving away ownership
- License – allow another party the right to use IP within parameters of the parties' agreement
- Sublicense – when a licensee is able to grant another license of the same IP to someone else
- Background IP-Invention that could “block” other Inventions from being used.
- Bundling

IP BASICS – Technology Transfer Terminology

- LICENSES:

- Royalty Free – fully paid
- Worldwide
- Field of Use
- Exclusive
- Revocable
- With right to sublicense
- Option

- L

- Royalty Bearing
- U.S. , other countries
- unlimited
- Nonexclusive
- Irrevocable
- Without right to sublicense
- Right of first refusal

IP BASICS – Sponsored Research Agreement Language Example (NERF)

Institution hereby grants to Company an option for a worldwide, fully paid up, irrevocable, non-exclusive royalty free license with the right to sublicense Inventions conceived and reduced to practice during performance of the Scope of Work for non-commercial, internal purposes

IP BASICS – Bayh Dole Act 1980

- If elect title, must protect via patent within one year
- Must report IP to the government (Edison)
- Periodic reports of how IP being utilized
- “March in Rights”
 - For compelling reasons, Gov’t can step in and take Title
 - Government can require you to license to 3rd party
 - Government can step in and license

IP BASICS – Technology Transfer

- Bayh Dole requirement: Not allowed to assign title to another (unless it is a patent management organization)
- Tax implications: Granting title or Commercial NERF or unpaid license could result in “private use of non-profit resources/space and make institution subject to Unrelated Business Income Tax, loss of tax-exempt bond status – or, if significant- loss of overall tax free status.
- IRS Revenue Procedure 2007-47 (Replaces Previous version IRS Revenue Procedure 97-14)

IP BASICS – Institutional Considerations

- Protecting IP during the Proposal Process
 - Collaborations prior to submission: use Non-Disclosure Agreements, Teaming Agreements
 - During Peer Review Process- proposal information held “confidential” and enforced by sponsors
 - If Federally funded, information not specifically marked as proprietary, confidential is considered “published” upon award

IP BASICS – Institutional Considerations

- Protecting IP during the project
 - Disclosures to tech transfer office PRIOR to publication
 - Discussion in classes
 - E-mail/twitter, etc.
 - Web-based information
 - Presentation at a conference
 - Thesis/dissertation delivery
 - Submission of manuscript
 - Collaboration agreements that maintain confidentiality of information with research partners

IP BASICS – Institutional Considerations

- Ensuring Compliance with Federal and other Sponsors' requirements
 - Provide Disclosures to Tech Transfer Office in timely manner
 - Consider Sponsor Data Sharing Policies/Requirements
- Protecting IP when a PI/Inventor transfers in and when a PI/Inventor transfers out
 - Have a policy, procedure and checklist
 - License agreements, Data exchange agreements, Material Transfer Agreements

IP BASICS – Institutional Considerations

- Ethical Considerations of IP and research process
 - What about Students, Postdocs, Staff?
 - Institutional conflicts – equity holdings, endowments, gifts & research
 - Ownership of human tissues
 - Benefit back to human participants of significant discoveries
 - Moore vs Regents Univ Cal System, Washington Univeristy St. Louis vs. Catalano, Greenbelt vs. Miami Hospital

The background of the slide is a blue-tinted photograph of a vast, calm ocean stretching to the horizon under a sky with light, wispy clouds. The water's surface shows subtle ripples and a slight reflection of light on the left side.

Questions?