

# ? How can we HELP?



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Use our **service portal**, watch **webinars** and visit our **website** to learn about IP.

- 1. Visit our Service Portal.** Under Attachments, download and read the “How to Guide” and an Invention Disclosure form. Then click on the yellow Request Service button. From there, click into the “Type of Service Request” and select one option: Request Advising, Invention Disclosure, Non-Disclosure Agreement or a Material Transfer Agreement. For most efficient service, please fill out as much information as possible.
- 2. Visit our website for internal and external resources here.**
  - **Forms and Agreements page:** Read descriptions of and download intellectual property agreements: Non-Disclosure, Confidentiality, Material Transfer Agreements **here**.
  - **Faculty Learning Center:** Learn about all facets of intellectual property through videos, free online courses, past *Tips & Tricks* newsletters, FAQs, and links to outside resources such as the USPTO.
  - **Partner with Industry:** There are several pathways within the University of Idaho for assistance, including The Office of Sponsored Programs, the Office of Research and Faculty Development, and links to request service from Proposal Development and Research Development Services. Find outside Funding resources on the External Research Funding Opportunities page, the Corporate and Foundation Relations page and the College of Graduate Studies External Funding page. Also see the “A Guide to Sponsored Projects.”
  - **Intellectual Property:** Learn about U of I policies in the Faculty Staff Handbook around developing IP while employed at the University.
  - **Success Stories:** Read about patented and commercialized UI research. learn about some of the UI research that resulted in innovations of new plants and devices that have been licensed to industry.

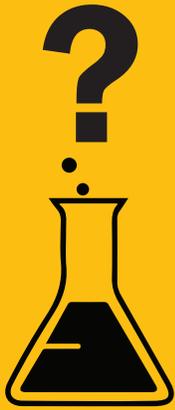
## REMINDERS & RESOURCES

- **Subscribe** to our *Tips & Tricks* newsletter. Email: [ott@uidaho.edu](mailto:ott@uidaho.edu)
- **“StartUp Stories,”** Watch recordings of interviews with inventors and business owners on our **YouTube channel here**.
- **ASCEND Hub Webinars:** The U of I is in one of the seven western IDeA states, and has access to resources provided by the ASCEND Hub, an organization that promotes education about bio-medical research and commercialization. Monthly **webinars and recordings** of past events and other resources can be found on their website: [www.ascendhub.org](http://www.ascendhub.org)
- **Our Service Portal.** Request a consultation or submit an Invention Disclosure, Confidentiality Agreement or a Material Transfer Agreement, **here**.



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# IGEM

## Tips & Tricks

VOL. 3.2.2021

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# What is IGEM?

The **Idaho Global Entrepreneurial Mission (IGEM)** Program funds are awarded to Idaho public research universities to partner with industry leaders on research projects geared toward commercialization.

“IGEM is a state grant program dedicated to funding new ideas, innovations, concepts, processes and products. IGEM funds commercialization research projects, where a business partners with an Idaho university research team to advance innovative products and services to market from Idaho.”

On the business side, by partnering with an Idaho research institution, businesses can develop new ventures, products, high-value jobs and get products to market sooner. The partnership also increases research capacity at Idaho’s three public universities: University of Idaho, Idaho State University and Boise State University.

An example of this public-private IGEM partnership is an award to the University of Idaho in early 2022 to help an industry partner, Idaho Strategic Resources, to develop new extraction techniques for rare earth elements. “**This research project** leverages collaboration between the Idaho Strategic Resources, Idaho Geological Survey, Idaho National Laboratory, the Center for Advanced Energy Studies and Idaho’s land grant university, the University of Idaho.”

“Selected project proposals will be in alignment with the statewide higher education research strategic plan and will leverage the talents and expertise of Idaho’s research universities and the private sector to further the economic vitality of the state; they will create a platform to facilitate and accelerate the transfer of technology out of Idaho’s public state research facilities and into the private sector; and they will create new ideas, products and companies that lead to higher-paying jobs and a strong economic foundation for Idaho.”

– **Idaho Higher Education Research Council Programs (HERC)**

If you have found an industry partner, you can apply for an IGEM grant. To submit your grant application go to <https://igem.idaho.gov/application-process/> where you can download the application form, PowerPoint presentation template and budget form and then upload your final documents, including resume/cv for each PI, co-PI and industry partner.

For more information about the IGEM program visit <http://igem.idaho.gov>, [commerce.idaho.gov](http://commerce.idaho.gov) or contact Carmen Achabel at [carmen.achabal@commerce.idaho.gov](mailto:carmen.achabal@commerce.idaho.gov)

### REMINDERS & RESOURCES

- “**StartUp Stories,**” Watch recordings of interviews with inventors and business owners on our **YouTube channel here.**
- **ASCEND Hub Webinars:** The U of I has access to resources

provided by the ASCEND Hub, an organization that promotes bio-medical research and commercialization. Monthly **webinars and recordings** of past events and other resources can be found on their website: [www.ascendhub.org](http://www.ascendhub.org)

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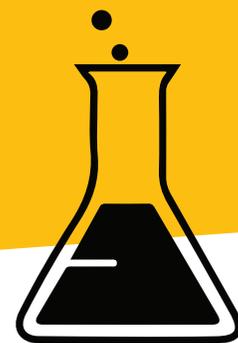


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# How IP benefits researchers and the economy?



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## 1 Bayh-Dole Act and how that changed the economic engine

Passed by Congress in 1980, the Act enables universities, nonprofit research institutions and small businesses to own patents and commercialize inventions developed under federally funded research programs within their organizations. “Since its implementation in 1980, the Act has directly contributed to well over \$1.3 trillion in U.S. economic growth, more than 4.2 million jobs, and over 11,000 new startup companies from the nation’s universities.” – Walter Copan, PH.D., remarks from interview on October 28, 2020, to commemorate the 40th anniversary of the Bayh-Dole Act  
“Prior to the enactment of Bayh-Dole, the U.S. government had accumulated 28,000 patents, but fewer than 5% of those patents were commercially licensed.” – Wikipedia, citing the U.S. Government Accounting Office (GAO) Report to Congressional Committees. May 7, 1978.  
“Technology Transfer, Administration of the Bayh-Dole Act by Research Universities”

## 2 Relationship between IP protection and economic growth

Since the “mid-1990s, spending by companies on intangible capital (such as computer software and brand development) began outpacing spending on tangible capital assets in the United States. Companies started investing more in research, development, and the commercialization of intangible assets, than in existing capital to spur growth. IP rights help protect these intangible assets and contribute to economic growth.” – **Intellectual property and the U.S. economy: Third edition** (2022)

“IP-intensive industries account for 41% of domestic economic activity and about 44% of US jobs. And, those jobs have higher wages, better benefits, etc. – especially in the copyright and utility patent intensive industries. .... Altogether, the IP-intensive industries accounted for 63 million jobs, or 44% of all U.S. employment in 2019.” (*ibid*)

## 3 Economic benefits for the individual creators, business owners, and entrepreneurs

“Under the law, federal employees who are inventors are entitled to a share of revenues that the government may obtain from licenses and royalties (not to exceed \$150,000 per year per inventor).”  
– “Patents”, U.S. Department of the Interior, Technology Transfer Activities

Researchers at the U of I make 40% in royalties on their patents and 40% for their college. Discoveries push the UI closer to the Carnegie R1 research designation, garnering access to more funding to the university and for research opportunities in the future.

“Universities are required under the Bayh–Dole Act to share some portion of patent income with inventors, but there is substantial variation in these royalty-sharing policies[SK(1)].” Based on data from the 1990s, Lach and Schankerman (2004) concluded that “licensing income is significantly increased when the direct monetary rewards to the inventor, in the form of royalties, are raised.” —“How do Patent incentives affect University Researchers,” by Lisa Larrimore Ouelette, Stanford Law School, Stanford University; and Andrew Tutt, Arnold & Porter Kaye Scholer LLP, *International Review of Law and Economics*

## REMINDERS & RESOURCES

• **Mesas to Mountains Innovation Summit**, October 11-12, 2022, 9 a.m.- 3 p.m. PT / 10 a.m.- 4 p.m. MT. Topics will include Commercialization as a Goal; SBIR SOS; Agency Lightning Round (intro to 11 Federal agencies); Protecting Your Future (IP); Building a Research Eco System; Research Institution Lightning Pitches and more! For more information and tickets: <http://bit.ly/M2Msummit>

• **Boise Entrepreneur Week (BEW)**, October 24-28, 2022 will be a hybrid in-person and online event. BEW is Idaho’s largest community-driven, entrepreneur-focused event to help support the development of a culture of innovation in Idaho. BEW partners with government agencies, civic leaders, educators, private companies, investors, students, trade association, non-profits and universities to provide networking and Pitch competition opportunities to startups in Idaho. Registration: [www.boiseentrepreneurweek.org](http://www.boiseentrepreneurweek.org)



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# SBIR/STTR

## Tips & Tricks

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# What is SBIR/STTR?

**“The mission of the SBIR/STTR programs is to support scientific excellence and technological innovation through the investment of Federal research funds in critical American priorities to build a strong national economy.”**

The Small Business Innovation Research (SBIR) program is a federally funded three-phase grant award system. It contracts small businesses to execute research and develop services and or products that fill the needs of a federal government agency. The government agencies that work with the SBIR program include the Departments of Agriculture, Defense, Education, Health and Human Services, the National Institutes of Health, the National Science Foundation, the National Air and Space Agency, and many others.

As with the SBIR program, the federally funded three-stage Small Business Technology Transfer (STTR) program provides grants to help early-stage startups commercialize technologies. Unlike the SBIR program, the STTR requires the small business to partner and collaborate with a U.S. non-profit research institution such as a university.

Proposal success is determined by several factors. The first phase focuses on the scientific integrity and technical merit—strategies, expertise, methods, materials, and procedures that meet the criteria in the submission guidance. The second phase focusses on research and product development. The third phase focusses on commercialization of that research, and development of product or service for use by the granting government agency.

For more information about the definition of a Small Business Concern, **see here.**

For details on the evaluation process of SBIR/STTR proposals, **see this page.**

## How do these grants spur economic growth?

[T]he STTR program aims to: Foster technology transfer through cooperative R&D between small businesses and research institutions.

“The mission of the SBIR program is to stimulate technology innovation by strengthening the role of innovative Small Business Concerns in Federal Research and Development. The program’s goals are four-fold:

- Stimulate technological innovation.
- Use small businesses to meet Federal R&D needs.
- Foster and encourage participation in innovation and entrepreneurship by socially and economically disadvantaged small businesses.
- Increase private-sector commercialization of innovations derived from Federal R&D funding.

## RESOURCES

- For help starting a company, **see this link and this link.**
- For information on the SBIR and STTR programs, visit **[www.SBIR.gov/about](http://www.SBIR.gov/about)**

Watch these tutorial videos about SBIR/STTR program basics:

- **What is the Purpose of the SBIR and STTR programs?”**
- **Am I eligible to participate in the SBIR/STTR programs?**
- **SBIR or STTR: which one is right for me?**
- **Tell Me About Additional Phase II Opportunities**

Also: **Understanding SBIR & STTR**

To see examples of successful SBIR/STTR projects. **visit this website.**

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# Local Small Business Development Resources



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**Establishing a small business is often required in order to commercialize research, to further develop that product or service, apply for further R&D funding and to disseminate it to the world.**

**1 Vandals Solutions** Vandal Solutions is a student-run not-for-profit business operated by the U of I College of Business upper level students. It offers professional quality services to develop your small business for free. **For information click here.**

**2 Idaho Entrepreneurs program** This student opportunity helps to move ideas into entrepreneurial opportunities. The program is guided by program director George Tanner. Students develop the skills to identify and commercialize their ideas and create business, operational and financial plans for ventures and obtain an entrepreneurship certificate. **Visit this website.**

**3 Elevate Idaho SBIR Accelerator** Under ELEVATE IDAHO, REDI, PTAC and SBDC pulled together a unique partnership with statewide leaders to launch the Idaho SBIR/STTR Virtual Innovation Center. Whether you are a beginner, or a novice in the grant process, the Idaho SBIR/STTR Virtual Innovation Center Team is **here to assist you every step of the way.**

**4 Small Business Development Center - Idaho** Take courses about developing your business, watch webinars, find resources, and get advice. Courses include: Start-Up Seminar, QuickBooks for Desktop and Online, the Amazon Small Business Academy, WordPress, Digital Marketing, and more. See **here**, and **here**.

**5 Idaho Women's Business Center** This center designed for women business owners in Idaho, provides free education, training and advising. They hold numerous workshops and webinars on many topics including Negotiation & Leadership, Maximizing Your Visibility with LinkedIn, QuickBooks Series and more. They provide on-demand-online learning on everything from using social media and crowdfunding to legal advice and finance. **Find information here.**

## REMINDERS & RESOURCES

• "StartUp Stories," Watch recordings of interviews with inventors and business owners on our **YouTube channel here.**

• **Office of Technology Transfer (OTT) Service Portal.** Request advice or submit an Invention Disclosure, Confidentiality Agreement or Material Transfer Agreement. **Service Portal link here.**

• **Idaho Global Entrepreneurial Mission (IGEM)** The IGEM grant program funds commercialization studies where university researchers and business experts partner together to bring viable technologies to market. See this **video here** and see **this page for resources.**



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**Contact the Office of Technology Transfer to help you determine what type of intellectual property protection is best for your discovery.**

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# WHAT are the TYPES of intellectual property?



## Tips & Tricks | VOL 3.6 • 2022 |

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**1 Copyrights** protect original expressions, such as plays, literature, musical scores, films, architectural renderings, and software code. They do not protect ideas or facts. The U of I IP Policy provides a carve-out for certain faculty copyright-eligible works, such as course materials, or works produced by faculty on sabbatical leave. **See U of I FSH 5300** (B-2 “Assignment of Ownership”)

**2 Trademarks** cover any word, phrase, name, slogan, symbol, device or combination used to distinguish one’s goods or services from another’s goods or services. Examples of federally registered trademarks include Apple®, the McDonald’s® Golden Arches, and “JUST DO IT®”

**3 Trade Secrets** protect any confidential business information that provides an organization a competitive advantage. A Trade secret is a broad term that usually includes a business’s selling or distributing methods; client or supplier lists; consumer profiles; product formulas or recipes; or manufacturing processes.

**4 Patents** protect discoveries or inventions that are *new, useful, non-obvious* and not based on any past public disclosures or *prior art*. The technology or invention can be a *new composition of matter*; a *process*, an act or a series of steps or procedure; a *machine*, a device used to perform a function, produce a certain effect or result; an [article of] *manufacture*, such as an item produced from other raw or prepared materials; or it can be a *composition of matter*.

**5 Contract Rights** are those that contractually impose restrictions on another party in terms of what they can or cannot do with your protected intellectual property. For example, like what may be listed in a Terms of Service or Terms of Use Agreement on a Website or in the use of a product or service. There might be contracts with distribution partners over how they can promote or advertise their product.

## REMINDERS & RESOURCES

- Watch the video, **Introduction to IP: Patents 101**, presented by Jeremy Tamsen, hosted by the ASCEND Hub. **Watch video.**
- **Learning the ropes to protect your creative works.** This USPTO **video** explains the basics of trademarks, utility patents, design patents, plant patents, and steps to take to obtain IP protection.
- **United States Patent and Trademark Office (USPTO).** Find detailed information about intellectual property protections, including policies internationally and other resources on **this page.**
- **Office of Technology Transfer (OTT) Service Portal.** Request advice or submit an Invention Disclosure, Confidentiality Agreement or Material Transfer Agreement, **Service Portal link here.**



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# What does a **COPYRIGHT** PROTECT?



## Tips & Tricks | VOL 3.7 • 2022 |

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**1 The Copyright dichotomy: an idea or an expression.** Copyright protects the particular “expression” of an idea. “Copyright protection subsists... in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories: 1) literary works; 2) musical works, including any accompanying words; 3) dramatic works, including any accompanying music; 4) pantomimes and choreographic works; 5) pictorial, graphic, and sculptural works; 6) motion pictures and other audiovisual works; and 7) sound recordings.

In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.” – See the Copyright Act of 1976, Section #102 [here](#).

**2 The Benefits of Copyright Registration.** Copyright protection is automatic. There are advantages to the owner of registering a copyright with the US Patent and Trademark Office (USPTO). For example, if you wrote a song, copyright protects the music and or lyrics as soon as those are written down. The same holds true if you’ve written an original computer source code.

- By registering, stake your claim to ownership of the work; within three months, you can sue others who infringe on your copyright and after five years your ownership presumed.
- A copyright grants the owner exclusive rights to: 1) Reproduce the copyrighted work, 2) Distribute it, and Modify or create a derivative work, and 3) the owner retains the right to publicly perform or publicly produce that copyrighted work.
- That said, a copyright does not prevent independent creation by another. Copyright protection is a narrow form of protection. Theoretically, you could write source code behind a mobile application and someone else—totally unaware of your work—could write exactly the same code, but they would not be infringing your copyright.

**3 Registering your Copyright with the USPTO is easy.** One can register by mail by filling out a paper form and sending two copies of the work, plus a \$65 fee. But it’s easier to register by filling out an online form at [www.copyright.gov](http://www.copyright.gov). A nominal fee (\$35) is required. One enters identifying information and uploads two copies of the work.

**4 Software Copyrights versus patents.** It may be wise to both copyright and patent a work. Obtaining a copyright is very easy as it ‘attaches’ automatically once you reduce it to written form. It will last essentially forever. The downside is that the protection will be relatively narrow. Conversely, it is time consuming and expensive to obtain a patent and the protection is limited to 20 years from the date of filing.

## REMINDERS & RESOURCES

- Watch this online presentation by the USPTO and the Global Intellectual Property Academy: [Overview of Copyrights](#).
- Read up on **Copyright Basics** to find out more about copyrights and how to register one, [see this USPTO web page](#).
- **What Does Copyright Protect?** To find out, visit [this page](#).
- Visit the **Copyright Registration Portal** and find more information on how to register your copyright [here](#) and [watch this video](#).
- For more information visit the **United States Copyright Office**.
- Visit our **Learning Center page** on our website to find out more about Copyrights. [Click here](#).
- **Office of Technology Transfer (OTT) Service Portal**. Request advice or submit an Invention Disclosure, Confidentiality Agreement or Material Transfer Agreement, [Service Portal link here](#).



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# ? Who OWNS a Copyright?



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**Works for Hire.** Generally, the author is the initial owner of a work. There is one exception: the “Work for Hire Doctrine.” If an employee creates a work during their employment, then the employer of that employee is —by law— the author of that work.

The scope of this doctrine is often misunderstood. An employer may believe that if they pay someone to do something for them, that qualifies as a work for hire, thinking that since they paid for the work, that they are automatically the owner of the copyright. That is not always the case. – The Work for Hire Doctrine only applies to employees, not independent contractors.

**Joint Authorship or Ownership of a Work.** A work prepared by two or more authors with the intent that their contributions be combined in an inseparable and interdependent unitary whole would result in joint ownership. Two authors/owners can be joint owners of a joint work—similar to joint patent ownership—even if their contributions are entirely unequal. Unless there is a contract that states otherwise, by default, each will have a 50/50 stake in the single work. It’s recommended that a written legal agreement be put in place, whenever there are multiple people contributing to a single work. This agreement can delineate the actual economic percentage that each party will receive, and any other control provisions that matter to parties—as in how the work can be used and licensed to others. When a joint work exists, it’s jointly owned by the individual contributors. There is often a confusion over the distinction between joint work and derivative work. A derivative work is that in which someone adds contribution to or adapts a preexisting work. This is different from joint work.

**Fair Use.** The Copyright Act of 1976 grants important rights to the public at large with the “Fair Use” doctrine that is covered in section 107, entitled “Limitations on exclusive rights: Fair use.” The fair use of a copyrighted work, including such use by reproduction in copies or phono records or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any case is a fair use, the factors to be considered shall include: 1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit education purposes; 2) the nature of the copyrighted work; 3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and 4) the effect of the use upon the potential market for or value of the copyrighted work. Including a disclaimer and proper attribution may be a factor in considering whether your use is “fair”, but alone, the disclaimer and proper attribution doesn’t give one the right to use the work.

As an entrepreneur or startup, it’s risky to rely on the ambiguous ownership of IP or technology and not know whether your use of some else’s work is “Fair”. If you’re in doubt, and you’re not prepared to take on the potential financial loss of a lawsuit over possible copyright infringement, then its best to seek permission from the rights holder(s), or seek an alternative through an open-source or creative commons License in the public domain.

## REMINDERS & RESOURCES

- Learn more about individual and joint intellectual property ownership **on USPTO website.**
- Watch this video, **Patent Rights of Joint Inventors**, and **subscribe to this channel** by John Ferrell, Esq, Attorney, Patent Strategist at Carr & Ferrell LLP.
- Read **Copyright Ownership: Who Owns What?** on Stanford University’s easy to read Stanford Libraries **website here.**
- Watch this 6 minute video, **How Copyright Works: Fair Use Copyright Law.** In this video, Berklee Online course author Dr. E. Michael Harrington explores what “fair use” means. **Watch here.**
- **Our Service Portal.** Request a consultation or submit an Invention Disclosure, Confidentiality Agreement or a Material Transfer Agreement, **here.**



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# CONSIDERATIONS

## Tips & Tricks

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# CONSIDERATIONS Before Research

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There are thousands of U.S. Patents and Patents Pending in process at any one time.

**“Twenty-two per cent of the world’s patents come from the USA. Research spending in the USA represents 3.09% of the US GDP in 2019.”**

–UNESCO SCIENCE REPORT, 2021

**“Researchers in R&D (per million people) in United States was reported at 4,821 in 2019, according to the World Bank.”**

–TRADING ECONOMICS

### Conduct Patent Searches Early

There are limitless scientific discoveries to be made, and it’s natural to think we’re the first to have discovered or engineered an idea, but we might be wrong. For this reason, it’s important to do a patent search before you’ve invested much time and money into your research effort.

Watch this presentation by the U.S. Patent and Trademark Office (USPTO), **“How to Conduct a Preliminary U.S. Patent Search: A Step-by-step Strategy”**

The USPTO’s new web-based **Patent Public Search Tool** helps in this process. This tool replaces “legacy search tools” and has two user interfaces that “provide enhanced access to prior art. The new, powerful, and flexible capabilities ... will improve the overall patent searching process.” It also has tutorials and FAQs.

### Invention reporting

At the University of Idaho, inventors are required to submit their inventions Disclosure Forms to the Office of Technology Transfer (OTT). Inventors can download the Invention Disclosure

Form and submit it through the **OTT Service Portal here**. This legal document describes the scope of the discovery and should answer these questions: What is the inventor is working on? How is this innovation different? What commercial advantage does this technology bring to the marketplace? How will other competitors react to this innovation?

### Designing Around Another Patent

The purpose of a patent search is to make sure your idea is new, useful, non-obvious, and better from existing patents filed. Sometimes during a patent search, a pre-existing filed patent may be found. In some cases, a researcher can then alter their product or service to ensure that their claims are distinctive from those claimed in a pre-existing patent. This is called “Designing Around.” There are many claims you can avoid infringement by tweaking your product or service. This is the benefit of learning about potentially problematic claims, early in your product development. To avoid potential infringement, you can learn about whether an entity has patents pending from the USPTO website: **Patent Center page**.

### REMINDERS & RESOURCES

- **Do a Patent Search.** Make sure your idea has not already been patented. **Use the USPTO’s new Patent Public Search Tool.**

- **IP/Invention Disclosures:** Jeremy Tamsen, speaks about the importance of filing Invention Disclosures in this **video**.

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# What is a NEW discovery— and what is Prior Art?

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**Patents protect discoveries or inventions that are “new,” “useful,” “non-obvious” and not based on any past public disclosures or “prior art.”**

(See *Tips & Tricks*, Vol 2.4, October 12, 2021)

## **What could make something NOT “new”?**

There are several reasons that a patent could be considered not “new”:

- there is a previous US patent
- an international patent has published within the last year
- it is obvious, or anyone with the technical knowledge could have come to that conclusion or created it
- there is “prior art”

## **What does Non-obvious mean?**

“Non-obvious” means that the invention or discovery is not a derivative of an existing patent that someone with the technical expertise could easily create. In other words, the invention must not be an obvious extension of another invention. It must be distinctive from other inventions to make it potentially patentable.

## **What is Prior Art?**

The key factors that determine if there is Prior Art for an invention include:

- the technology has already been disclosed to the public
- there is a description anywhere as in a book, newspaper, movie, video, piece of art, cartoon, social media, or otherwise published.
- It doesn't need to be built, but only suggested in such a way that someone with expertise could create it.

Many patent applications fail because the Patent Examiner has determined the discovery is not “new,” it is “obvious,” or there is “prior art.”

To learn more about “Prior Art” by **watching this video**.

## **REMINDERS & RESOURCES**

• **Prior Art Search.** See this **USPTO page** explains how to do search for prior art to ensure you're discovery or invention is patentable.

• **Prior Art Rejections: An Introduction.** Watch this presentation by the USPTO about how to avoid Patent rejections because of Prior Art. **Watch here.**

• **What is Prior Art?** Here is a quick read, an article by Patent attorney Michael K. Henry, Ph.D. **Click here to read.**

• **Office of Technology Transfer (OTT) Service Portal.** Request a advice or submit an Invention Disclosure, Confidentiality Agreement or a Material Transfer Agreement, **Service Portal link here.**



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**Contact the Office of Technology Transfer to help you determine what type of intellectual property protection is best for your discovery.**

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# PATENT RIGHTS

## Tips & Tricks

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# What are Patent Rights?

**“Intellectual Property refers to legal rights in creations of the mind.”**

– Brad Pilz, Tech Transfer Officer for the University of Michigan.

Patents are an extremely strong form of government granted intellectual property protection that covers technology, or inventions or a new composition of matter. A US patent holder has the right to exclude others from making, using, selling or offering to sell that patented invention to anyone in the United States. First enacted in 1790, the contemporary patent act, the America Invents Act, was passed by Congress in 2011. Patent law is covered in title 35 of the United States Code:

“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”

– Title 35 U.S. Code, #101 “Inventions Patentable” (July 19, 1952, ch. 950, 66 Stat. 797.)

**The owner of the patent has the right to sue others who infringe on them.**

That said, there is no government agency that will enforce patent rights. The onus is on the patent owner to enforce and defend their patent rights in Federal Court or the International Trade Commission. This can be very expensive, but important if their startup or business venture is based on a patented technology.

**Patent rights last for 20 years from the filing date of the 1st non-provisional application.**

A Provisional Patent Application provides an initial filing date—and saves a place in line so to speak—even though the US Patent Examiner will not examine it to determine its viability. This gives the inventor/researcher 12 months to reduce their invention to practice and refine their research before filing a Utility Patent (Non-provisional Patent). The Utility application is examined and reviewed by a USPTO Examiner. The patent application filer may receive a number of office actions from the Examiner that must be responded to over the course of several years or more. If allowed to issue, the term of the patent lasts 20 years from the filing of the initial Non-Provisional Application.

**Why is intellectual property such an important foundation for technology startups?**

Startups are often founded around a unique potentially patentable product or service. This is often the basis of their existence and why owning at least one patent is a make-or-break strategy. Startups are typically cash strapped. They are therefore incentivized to go out and ‘test’ the hypothesis behind their value proposition to potential customers and investors — those who may not want to sign an NDA (non-disclosure/confidentiality agreement). Understanding the basics behind intellectual property is vital to protecting the foundation of one’s startup venture.

“IP mistakes can kill a startup, before they even begin.”

– Jason Mendelson, co-author with Brad Feld of the book, “Venture Deals: Be Smarter Than Your Lawyer and Venture Capitalist”

### RESOURCES

• View the USPTO’s **Introduction to Patent Protection**. An introduction to what a patent is, what a patent protects, and how a patent is obtained in the United States. **Watch here.**

### • University of Michigan-IP Videos:

The This video series is comprised of 62 intellectual property (IP) videos delivered by Professor Bryce Pilz from the University of Michigan Law School. These 3-5 minute videos are organized into five sections, with subtopics. **Watch here.**

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# ? Who OWNS a Patent?



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## Patent Inventorship

The person who conceived of the actual solution is the inventor and initial owner of the patent rights, unless they already assigned their patent rights to a third entity prior to filing the patent application. In patent law “conception” or “invention” is defined as, “The formation in the mind of the inventor of a definite and permanent idea of a complete and operative invention as is thereafter to be used in practice.” The inventor is not required to build the product or prototype. They only need to be able to describe it with enough detail so that people in their field would understand how to use it. There are consequences for improperly naming the inventors of on a patent that include: 1. The patent rights could become unenforceable; 2. Investors can be scared away from investing in the development of your patented technology.

### What does NOT determine inventorship:

- merely building a prototype or reducing an invention to practice;
- supervising or contributing labor to the development of the invention;
- funding the development;
- deriving a solution to a problem, but without detail about the solution—you could imagine a rocket ship in your mind, but unless you can technically describe how the rocket ship will work, you have not invented it;
- identifying a problem—by itself— does not equal inventorship;
- performing experiments that prove the invention, by itself does not equal inventorship;
- conceiving of an invention that is not actually claimed in a patent;
- you are not the inventor unless your contribution to the conception of the invention is covered in at least one claim in the patent.

## Joint Inventorship

It's becoming more common that patents have multiple inventors. A recent study showed that 40% of patents now name at least three or more joint inventors. The contributions of the joint inventors do not have to be equal. All it takes to qualify, is to have made a substantial contribution to at least one claim in the patent.

## Patent Ownership

A Patent gives the owner the right to exclude others from making, using, or offering to sell the invention covered by the patent claims. Employers may own the patents developed by employees as a result of a written contract, typically an employment agreement, that assigns patent rights to the employer.

The industry standard is to have inventor/founders “assign” their rights to their startup company. Investors will insist that the startup owns the IP developed by the founders. The only exception is in the context of startups coming out of university tech transfer operations. There, the university will license exclusively or non-exclusively their rights to the startup. They will not ever “assign” their rights to the startup.

## REMINDERS & RESOURCES

- Learn more about individual and joint intellectual property ownership on the USPTO website **on this page here.**
- **Patent Inventorship.** To more clearly understand patent inventorship, you may wish to watch this series of videos (#21-#27), produced by the Bryce Pilz at the University of Michigan **here.**
- The **National Academy of Inventors** is proud to announce a new opportunity for aspiring inventors, innovators, and entrepreneurs. The Intellectual Property (IP) course developed by the Michelson Institute teaches critical knowledge about America's intellectual property protection system and how it can work for you. At your own pace, take the online IP course consisting of 12 video modules and 38 lessons. **Click here to access the course.**
- **Our Service Portal.** Request a consultation or submit an Invention Disclosure, Confidentiality Agreement or a Material Transfer Agreement, **here.**



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# OWNERSHIP

## Tips & Tricks

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# Who OWNS a PATENT?

## Technology Transfer from university research labs to the Public

We use products and services every day that are based on discoveries from university labs. For example, Google is based on the page ranked algorithm that was invented by Sergey Brin and University of Michigan alum Larry Page in 1996 while they were Ph.D. students at Stanford University. The algorithm was invented with funding provided by the National Science Foundation (NSF). Then they worked with Stanford's Technology Transfer Office to license the IP to the startup company formed by Larry and Sergey named, "Google," and the rest is history.

## Technology Transfer didn't always work this way.

Prior to 1980, established law directed that the federal government would own the IP rights to inventions created using federal funding. The Federal government could not grant exclusive licenses. To make matters worse, there were 26 different government agencies that had their own set of rules for commercializing inventions created with public funding. It wasn't working out for commercializing discoveries. At most, only 5% of inventions created with Federal funding were being turned into products or services that the public could use.

In 1980, Congress passed the Bayh-Dole Act that allows universities to elect or retain title to IP created with federal funds and to license them exclusively or non-exclusively to industry partners. Universities can collect royalties that they share with the inventors, and they can re-invest licensing income towards further research. The IP rights that the universities transfer to industry partners through licenses funnels technology into the public marketplace and boosts the economy. (See *Tips & Tricks* Vol 1.5 and Vol 2.16)

University licenses can work in different ways: offering for a fee; an up-front payment; running royalties on net sales; annual minimum fees, or milestone fees paid on net sales; or cross-Licensing - one party can own patent rights that they license to another party in exchange they can get a license back to that other party's patent rights.

In the case of startup companies, universities sometimes take equity in the company—as often startups don't have the financial resources to pay up front payments or running royalties—so an equity partnership could make sense.

Universities often offer other resources beyond licensing, such as providing incubator space; or, providing business, technology, and investment mentoring programs such as the NSF funded I-CORP program. In addition, university law schools often provide free legal clinics to startup companies. (UI has one).

## Patent Licensing

There are two ways to transfer patent rights: by **Assignment of rights**, or **License of rights**. Assignment of patent rights is like selling a house. After the sale, the house belongs to someone else—the ownership and all rights have been transferred to another owner. On the other hand, when one Licenses patent rights, it's like renting your house: you still own it, but you're allowing someone else to exercise some of the rights of ownership.

A Patent License can have two distinctions: **Exclusive Licenses**, or **Non-Exclusive Licenses**. An Exclusive License is like renting your house. You retain ownership, but you allow someone else to act as if they are the owner. A **Non-Exclusive License** is like a ticket to a sports stadium. You can enter, but you don't own it. You're allowed access for a limited time, exercising some of the rights of ownership. There is a third kind of license, that of a **Sub-License** that Licenses IP that a Licensee can grant to a third-party Licensee.

Patent Licenses can be divided up by region, or by field of use. One license could be granted to a company in the US and another License to a company abroad. One can also grant a license by field of use. A license can be granted to a company in the pharmaceutical industry, while another could be granted to that in the biotech.

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# INFRINGEMENT

## Tips & Tricks

VOL. 3.14.2023

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# Patent Infringement & Litigation?

## Enforcing Patent rights

A U.S. patent grants the owner the right to exclude others from making, using, selling, or offering to sell their patented invention in the United States. Most patents are respected in the marketplace. However occasionally—whether out of ignorance, or deceit—some entities sell products that infringe other’s patent rights.

For an entity unknowingly infringing on patent rights, a carefully worded Cease-and-Desist Letter from the owner will open the door for communication to remedy the infringement by removing the product from the market or license the patent rights from the owner.

There is no government agency that enforces patent rights. The onus falls on the patentee to defend their rights in a Federal District Court or with the International Trade Commission. That said, patent litigation is a long, arduous, and expensive process and can distract from the day-to-day work of business. At the end of the case, whether one wins or loses, you’re on the hook for legal costs and fees. Law firms can charge six figures or more per month to proceed with patent litigation.

## Defending Against Patent Assertion

You may encounter the reverse situation, in which you receive a Patent Assertion claim from a Patentee. There’s no proven procedure to address this situation. Some things to keep in mind if you receive a Cease-and-Desist Letter:

- Do not destroy any information that could become evidence in a later lawsuit preserve the information.
- Do some research about the assertion. You could contact the patentee to explain your position, to better understand their motivations and why they believe you’re infringing on their patent. Determine if there is room to negotiate a resolution. To avoid a lawsuit, the easiest choice may be to be prudent and comply with the request. If the contentious service or product is not essential to your business it may make sense to change your product or service, so it does not infringe on their patent.
- One option might be to License the good or service from the patentee. This could be an up-front payment, paying at milestones, or payment on royalties, or perhaps offering equity in your business.
- Another option is to agree to a Cross-License. If the other company is competitor, they might see value in having rights under your patent and vis versa.
- An inexpensive way to challenge an infringement assertion would be to ask the USPTO to re-examine the patent in question to determine if the USPTO made the correct decision in the first place.
- The last option would be to challenge a patent assertion by filing a lawsuit to receive a “Declaratory Judgement Action,” determining either that the patent claims are invalid or unenforceable, or that you are not infringing on the claims of their patent rights. Litigation is expensive. Carefully consider before beginning this process.

## Willful Infringement

If a party knowingly infringes on another’s patent rights, then they are judged a Willful Infringer. To be found a Willful Infringer, one must: 1) be sued by another party; 2) proceed through all the litigation; and 3) lose the case and receive a damages verdict against you—the court will triple the damages verdict to a Willful Infringer. A defense against Willful Infringement can be very expensive—especially if one loses.

One way to avoid becoming a Willful Infringer is by “designing around” another’s patent. Examine the claims in a competitor’s patent and create something new that does not infringe on their patent. The benefit of designing around another’s patent is that it far outweighs the risk of being found a Willful Infringer. There is a huge benefit to looking beforehand at the patent landscape in your field, as it far outweighs the risk that you could be found a Willful Infringer and suffer a the financial and reputation loss with a verdict against you.



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# ? Protecting Trade Secrets



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Unlike U.S. Patent law, which requires a public disclosure of an invention and gives a patentee a monopoly over their invention for 20 years—under Trade Secret law, the owner does not disclose their technology, and they must take reasonable efforts to keep it secret from others.

## Trade Secret Policies.

Companies must have policies and practices in place:

1. A basic trade secret policy should define what information is a Trade Secret.
2. Employees must be made aware of and routinely reminded of the trade secret policy, and the company must maintain procedures to ensure and maintain secrecy, monitor who, how, and when that information is accessed, and limit the number of people who have access to that information.
3. Employees should be required to sign an agreement with the company that binds them to keep information that you share with them confidential through a Proprietary Information Assignment Agreement (PIAA).
4. Trade Secret information must be tangibly segregated from the day-to-day business operational information. A big company may have a separate facility; a startup company may keep files in a locked folder on separate computer or in a cloud server such as Google Drive, Dropbox, or Box and limit the people who have access to it.
5. The policy should discuss email usage, document sharing, and how to interact with third parties such as vendors and contract employees. The policy should outline when it's permissible to share sensitive information and what type of documents need to be in place when those conversations occur.
6. Lastly, an effective policy will include language applicable to visitors, or those in shared spaces such as an accelerator. It should describe what information you share with them, to what extent a visitor needs to sign a visitor policy or agreement, and what they can or cannot do with that information upon leaving your startup space.

## Enforcement of Trade Secret protection

Many NDAs have “dispute resolution” provisions that require parties to go through a dispute resolution mechanism, such as arbitration, rather than going to court. That said, once your Trade Secret is in the hands of a competitor, there's no getting it back and it's important to remedy the situation quickly. In that case, a Temporary Restraining Order, in effect for 10-14 days, could give immediate protection. Or court ordered Injunctive Relief can stop information from getting into the hands of a competitor.

## REMINDERS & RESOURCES

- To learn more about Trade Secrets, this video by the USPTO provides a brief, yet informative introduction, discussing why you should protect them, how they can impact a business's bottom line, and their importance as Intellectual Property. **Watch this video.**
- The Global Intellectual Property Academy created this video on Trade Secrets. **View here.**
- See more resources about Trade Secrets on the USPTO website **on this page here.**
- **Trade Secrets.** Watch videos about Trade Secrets produced by Bryce Pilz at the University of Michigan. Learn about Trade Secrets, Policies, Enforcement, and Agreements and also about how to avoid trade secret infringement with others. **Watch the videos here.**
- **Our Service Portal.** Submit an Invention Disclosure, Confidentiality Agreement or a Material Transfer Agreement, **here.**



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# Trademarks

## Tips & Tricks

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# What Makes a Strong TRADEMARK?

## Spectrum of Distinctiveness

There is the *spectrum of distinctiveness* that determines how strong a trademark is. From strongest to weakest, a mark can be: 1) fanciful, 2) arbitrary, 3) suggestive, 4) descriptive, or 5) generic.

Examples of *fanciful* marks are EXXON® or KODAK® that are entirely made-up words that have no meaning related their service as an identifier of the goods or services to which they're attached.

Examples of an *arbitrary* mark are APPLE® or AMAZON®. They tell you nothing about the nature of the goods or services to which they serve as a trademark.

Examples of *suggestive* marks are JAGUAR®, MICROSOFT® or CITIBANK® They don't actually describe the goods or services, but they tell you a bit about the goods or service to which they are attached.

Examples of *descriptive* marks are BEST BUY®, RAISIN BRAN® or HOLIDAY INN®. A descriptive mark is not inherently distinctive, but merely describes the underlying goods or services. In order to attain distinctiveness such that it can own trademark rights, this type of mark can only acquire distinctiveness through a secondary meaning.

It is impossible to obtain trademark rights in a "generic" marks such as Aspirin or Safari.

## The Standard of Likelihood of Customer Confusion

This is used to determine whether one mark infringes upon the trademark rights of another mark. Courts and the USPTO look at a number of factors, often referred to as the Polaroid factors, after a famous trademark case, involving Polaroid® to determine infringement:

1. How strong or distinctive is the original trademark?
2. How similar are the marks to others?
3. Are they in the same marketplace and/or region and how likely is it that customers are going to see these two marks in the same place.
4. How likely is it that the original owner will expand their market into yours?
5. Is there market research that shows there is evidence of actual confusion?
6. Intent: is the second trademark owner intentionally trying to capture your market?
7. What is the quality of the mark and the goods or services behind the potentially infringing mark?
8. Likelihood of confusion. The case of "Domino's Sugar v Domino's Pizza" shows that because the companies use two different distribution methods: one grocery stores and the other door to door delivery, and because they cater to two different marketplaces: one mostly students and the other family households that that bake—the court found that even though the trademarks are similar, Domino's Pizza is allowed to use their trademark as a brand identifier for their pizza and it does not infringe on Domino's Sugar.

## RESOURCES

**Applying for a trademark**, is a useful video presented by USPTO Staff Attorney for Electronic Filing and Public Web Services, Matt Schwab.

To find out more about trademarks, see **this USPTO website**.

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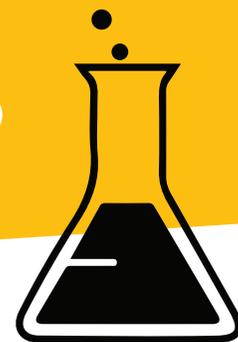


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# Why do a Trademark CLEARANCE SEARCH?



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Beyond picking a trademark name that is distinctive so that you can get trademark protection, you want to pick a name that you have the right to use. First, perform a preliminary trademark clearance search.

**1 Search the USPTO trademark database.** Search the USPTO trademark database to see if there are other registered trademarks out there with the same or similar name. If there is the same or similar trademark, you'll want to see if they are alive/active or dead/abandoned. Also check to find out who the owner of the mark is, and if there have been any disclaimers filed by the owner, limiting the scope of their trademark rights. Once you've done this and you've found no duplication of your mark, then you can broaden your search. Search Tip: also check common misspellings of the word.

**2 Remember that trademarks don't need to be registered for them to be used.** There are also common law rights through a company's regular use of their mark in commerce. To search for these kinds of marks, the online database called **MARKIFY.COM**. It is a free service, which searches not only the USPTO, but also the European database, and other databases around the world. It doesn't just look for "direct hits" it also looks for marks that are somewhat similar.

**3 Let Google help you.** The next step in your preliminary trademark clearance search is to do a "Google search". Google is also free, and this will search any people who are using your term or trademark anywhere on the internet. A Google search is also a good way to see if your mark is highly descriptive and therefore unlikely to get strong trademark rights. If your mark is merely descriptive then you'll get a number of search hits where people are using this term as a way to describe goods or services. Google is a good way to find out if someone is already using your mark or something "confusingly similar" to your mark as a trademark.

**4 Check the jurisdiction.** Look in jurisdictions where you may setup or register your company. If you're setting up an LLC or Corporation, both of these venues allow you to search to see if there are other companies that have established use of your potential trademark as a name for the company

**5 Make sure the domain name is available.** Search various social networks and usernames that you may want to use to promote your product or service. Make sure the Twitter and Facebook handles are available. Try **trademarkengine.com**. See all the different ways you can search on this **wiki-how page**.

**6 Pay for a professional service.** Once you've pursued all these preliminary steps, it's worth paying for a commercial vendor of trademark searches. Thompson, **CorpNet**, others—these cost money and best used with a trademark attorney who knows how to use them, but these will broaden out the search to make sure there's no one else using your potential trademark name or something "confusingly similar" to your own.

## REMINDERS & RESOURCES

- Visit the **USPTO: Trademark Database** to ensure that there are no other trademarks with the same name that are active. See **this USPTO page**.

- Search to find out if there is a common law usage of your mark in the U.S., Europe or elsewhere in the world. **Go to Markify.com**

- **How to Do a Trademark Search.** Registered USPTO patent attorney, J.D. Houvener from Bold Patents Law Firm, explains how to do a trademark search. Watch the video and see several other steps involved in performing a trademark search **on this page**.

- **Office of Technology Transfer (OTT) Service Portal.** Request advice or submit an Invention Disclosure, Confidentiality Agreement or Material Transfer Agreement, **Service Portal link here**.



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Contact the Office of Technology Transfer to help you determine what type of intellectual property protection is best for your discovery.

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# Contract IP

## Tips & Tricks

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# HOW ARE CONTRACTS IP?

**Contracts** between two individuals or organizations (“parties”) are used as a written tool to memorialize an understanding between two parties. Contracts can provide rights, impose restrictions, set payment or delivery terms, and more. Owners of intellectual property rights use contracts to outline the specific terms of agreement to allow third parties to use their intellectual property.

**For example**, the owner of a patent for a new device may write a contract to allow a third party company to manufacture the new device on behalf of the owner. The patent owner may also enter into a distribution contract with another company, to allow for a distributor to bring the finished devices to retailers across the country. There might be contracts with distribution partners over how they can promote or advertise their product. There could be Terms of Service/Use contracts over their website over how one can or cannot use their information, product or service.

Contracts may also be used to protect new ideas before they can be patented, copyrighted, protected by plant variety protection certificate, or otherwise protected. Material Transfer Agreements (MTA) and Non-Disclosure Agreements (NDA) can be useful in these instances, to allow for collaborations, but limit the distribution of sensitive materials and information.

## RESOURCES

Check out this **2-minute video** on the basics of contracting, **Contract Basics.Your Actions or Words Can Bind you Legally!**

This article **Contracts and IP Ownership** spells out the basics of IP ownership and especially the role of contracts in preserving intellectual property rights between businesses.

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