



The Office of Technology has a **NEW WEBSITE!**



Tips & Tricks | VOL. 2.1.2021 |

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Faculty researchers will find all they need to know.

Researchers and innovators at the University, seeking information about Intellectual property (IP) protection and how to proceed to the next level with their innovation, can find what they need to know here: www.uidaho.edu/research/ott/faculty-researchers

- **Learn more about IP Agreements and download sample forms:** www.uidaho.edu/research/ott/faculty-researchers/forms-agreements
- **The Learning Center offers videos, diagrams and FAQs to gain knowledge about IP and small business development:** www.uidaho.edu/research/ott/faculty-researchers/learning
- **Navigate finding and working with an industry partner:** <https://www.uidaho.edu/research/ott/faculty-researchers/industry-partnership>

Laws and policies that govern university intellectual property.

U.S. laws govern IP that is developed at U.S. universities. There are also specific policies for IP created at the University of Idaho by faculty and staff: www.uidaho.edu/research/ott/intellectual-property

Visit our Service Portal. For assistance and to submit IP agreements, click on the Request Service link on our website Menu or the yellow Request Service button on many of our pages which will take you directly to our online Service Portal. **Also Click here.**

Read about commercialized UI research. See some of the UI Success Stories here: www.uidaho.edu/research/ott/success-stories

The Business & Industry section markets UI innovations.

UI patented technology and protected plant varieties are licensed to business and industry: www.uidaho.edu/research/ott/business

REMINDERS & RESOURCES

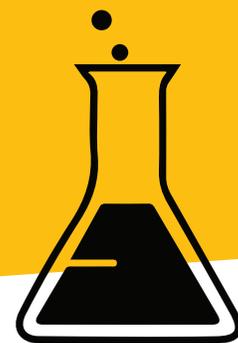
- **“StartUp Stories,”** hosted by Jeremy Tamsen, director of OTT, Thursday, September 17, 2pm PT/3pm MT on Zoom. Featured speaker will be Shane Needham, Ph.D., Chemistry, and co-founder and CSO of Alturas Analytics, Inc. on Zoom. **Participate on Zoom.**
- **ASCEND Hub Webinar,** Rich Carter and Karl Mundorff of Oregon State University will discuss “Building Innovation and Entrepreneurship into Promotion and Tenure,” September 30, 1pm PT/2pm MT. **Register here.**
- **Office of Technology Transfer (OTT) Service Portal.** Request a consultation or submit an Invention Disclosure, Confidentiality Agreement or a Material Transfer Agreement, **here.**



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WHAT are the FORMS of intellectual property?



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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. FSH 5300 (see 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

• “**StartUp Stories**,” hosted by Jeremy Tamsen, director of OTT, Thursday, September 17, 2pm PT/3pm MT on Zoom. Featured speaker will be Shane Needham, Ph.D, Chemistry, and co-founder and CSO of Alturas Analytics, Inc. **Participate on Zoom.**

• **Subscribe to the OTT YouTube channel** to watch the whole “StartUp Stories,” series: www.youtube.com/channel/UCfKW-jw1OOA2_rsoz_qc3lgw

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

• **ASCEND Hub Webinar**, “Promotion and Tenure, Innovation & Entrepreneurship,” September 30, 1pm PT/2pm MT. **Register 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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Copyrights

Tips & Tricks

VOL. 2.3.2021

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What is copyright?

Copyright law protects original works of authorship, such as plays, literature, sound recordings, films, architectural renderings, sculptures, and software code. The original work can be fixed in any ‘tangible medium’, such as writing it on a piece of paper, saving it into the memory of a computer, recording it onto a DVD, or any other tangible form from which the work can later be perceived.

Copyright does not protect ideas, procedures, processes, concepts, or methods of operation— instead, copyright protects only an exact original expression that has been fixed in a tangible medium. For example, a copyright would not protect an artist’s idea to paint a bowl of fruit; however, a copyright would protect the artist’s actual painting of a bowl of fruit. One may not use copyright to claim exclusivity on the concept behind a new invention.

“Copyright” is a legal term used to describe a collection of rights that creators have over their literary and artistic works. Generally, the creator’s collection of rights under copyright include the ability to allow or forbid others to:

- Reproduce the work in various forms, such as copying a DVD or photocopying a book;
- Publicly perform the work, such as a music group playing a song in a night club;
- Record the work, such as recording a concert performance;
- Broadcast the work, such as posting a video that features a song by The Beatles to YouTube;
- Translate the work into other languages, and;
- Adapt the work, such as making a film based on another creator’s novel.

Copyright registration is available in the United States through U.S. Copyright Office. By registering an original work with the copyright office, a creator can gain enhanced protections to use in the event of a dispute. However, registration with the Copyright Office is not required, and in the U.S. creative expressions are protected by law at the moment they are fixed in a tangible medium by a creator.

The U of I IP Policy provides a carve-out for certain faculty copyright-eligible works, such as works produced by faculty on sabbatical leave. (See FSH 5300 B-2 “Assignment of Ownership”.)

REMINDERS & RESOURCES

• **StartUp Stories**, October 14, 2pm PT/3pm MT. Interview and Q&A with **Chris Marx**, Ph.D. Microbiology, U of I Professor in Biological Sciences and Co-founder, KnipBio, a biotech company. **Join here on Zoom.**

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Trademarks

Tips & Tricks

VOL. 2.4.2021

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What is a TRADEMARK?

A **Trademark** is a type of intellectual property protection used to protect marks that identify the source of a product or service. Trademarks help create a brand for a company. They can be a critical part of building a company identity, showing that your product or services have a distinctive value.

Some examples of trademarks include: University of Idaho®, Idaho Vandals®, Vandal Brand Meats®, and Brave and Bold™. Other examples are the McDonald's® Golden Arches, and Nike's "JUST DO IT." Distinctive features of products and packaging, including the shape and color, can also be protected by trademark, such as the shape of a Coca-Cola® bottle, or the brown color of a UPS truck. Note that these are distinctive features, but not functional features of the product. To protect functional features of a product, a company must apply for patent protection.

There are two pathways to establish trademark rights:

- 1) by regularly using the trademark in commerce as an identifier of the source of particular goods or services, and;
- 2) by registering the trademark with the United States Patent and Trademark Office (USPTO).

It is not necessary to register a trademark before a company defends against others using the same mark on similar products and services, but registration provides defensive advantages. To register, a company must complete an application through the USPTO, and provide evidence that the mark is being used in commerce. Trademark protection, grants the owner the right to stop others from using the trademark by suing for trademark infringement. Federally registered trademarks can be protected indefinitely, for as long as the trademark is used in commerce; renewal forms and fees are due every ten years to maintain the registration.

For more information about trademarks, see the USPTO website:

<https://www.uspto.gov/trademarks>

REMINDERS & RESOURCES

• **StartUp Stories**, October 14, 2pm PT/3pm MT. Interview and Q&A with **Chris Marx**, Ph.D. Microbiology, U of I Professor in Biological Sciences and Co-founder, KnipBio, a biotech company. Join here on Zoom.

• **ASCEND Hub Webinar**, "How to Know If You Have a Marketable Idea," with Teddy Johnson, PE, MBA of University of Washington. October 28, 1pm PT/2pm MT. **Register here.**

• **Subscribe to the OTT YouTube channel here.**

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Trade Secrets

Tips & Tricks

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What is a Trade Secret?

Trade secrets are a form of intellectual property. Generally, trade secrets are any information that has value—only so long as it is kept a secret. Typically, trade secrets are comprised of confidential information that gives a business organization a competitive advantage. “Trade secret” is a broad term that usually may include such information as a business’s selling or distributing methods; client or supplier lists; consumer profiles; and manufacturing processes, recipes or algorithms. Famous examples of well-kept trade secrets include the Coca-Cola recipe, KFC’s blend of 11 herbs and spices, and Google’s search algorithm. Trade secrets may be protected indefinitely if the owner is rigorous enough – this is one of the advantages trade secrets versus patents (patents carry a 20-year limit on protection).

Typically, trade secrets are protected only by the rigorous actions of the owner to keep the information a secret without a formal registration process. In 2016 the U.S. federal Congress passed the Defend Trade Secrets Act (DTSA), which provides the following legal definition of trade secrets; however, the following conditions determine whether information is legally considered a trade secret:

- “all forms and types of financial, business, scientific, technical, economic, or engineering information”;
- if the owner “has taken reasonable measures to keep such information secret”; and;
- the information derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable through proper means by, another person who can obtain economic value from the disclosure or use of the information;...” The information must be secret (not generally known or readily accessible by competitors)
- The information must have some commercial value because it is secret
- The information’s rightful owner must have taken reasonable steps to keep the information secret, such as through use of confidentiality agreements or limited access to the information

The DTSA also provides a legal pathway to sue individuals who misappropriate a trade secret. “Misappropriation” means:

- acquisition of a trade secret of another by a person who knows or has reason to know that the trade secret was acquired by improper means, or;
- disclosure or use of a trade secret of another without express or implied consent.

(Citations from “Protection of Trade Secrets” Title 18 U.S. Code 1839)

For more information about trade secrets, see the USPTO website:

<https://www.uspto.gov/learning-and-resources/uspto-videos/trade-secrets>

REMINDERS & RESOURCES

• **StartUp Stories**, November 11 1pm PT/ 2pm MT. Interview and Q&A with **Trillitye Paullin**, Ph.D. a biotechnology researcher and entrepreneur. She founded Free to Feed. Join here on Zoom.

• **ASCEND Hub Webinar**, “How to Know If You Have a Marketable Idea,” with Teddy Johnson, PE, MBA, October 28, 1pm PT/2pm MT. **Register here.**

• **Subscribe to the OTT YouTube channel here.**

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Patents

Tips & Tricks

VOL. 2.6.2021

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What is a Patent?

A Patent is a government-issued monopoly, a form of intellectual property rights that protect discoveries or inventions that are ‘new’, ‘useful’, ‘non-obvious’ – as well as distinct any past public disclosures or prior art. Inventions that may qualify for patent protection include:

- **process**, an act or a series of steps, such as a procedure;
- **machine**, a device used to perform a function, produce a certain effect or produce a certain result;
- **an article of manufacture**, an item produced from other raw or prepared materials; or
- **a composition of matter**, a composition of two or more substances combined through a mechanical mixture or chemical bonds.

Patentability:

1. Invention must be patent “Eligible Subject Matter”
 - a. “Ineligible” subject matter for Patents include laws of nature; naturally occurring events and phenomenon and abstract ideas.
2. Invention must be “Useful”
 - a. “Useful” – the invention must work and have some application or utility.
3. Invention must be “New”
 - a. “Novelty” – it must be distinct from all “Prior Art” which can include anything that has been shared outside a confidentiality agreement.
4. Invention must be “Non-Obvious”
 - a. “Non-Obviousness” - even if the invention is “New” compared to other inventions, it must not be “taught, motivated, or suggested” by prior art.
5. Invention must be sufficiently “Described”
 - a. “Described” – you must sufficiently describe through words and pictures to the world and people in your field, how to replicate your invention.

Patent law is covered in Title 35 in the United States Code. The first Patent Act was enacted by Congress in 1790. It has been amended several times since then. More recently, it was updated through the America Invents Act, signed into law Sept 16, 2011. Many provisions of the new law went into effect March 16, 2013.

Patent rights last for 20 years from the filing date of the Non-Provisional Application.

Go to USPTO website for more on about patents: www.uspto.gov/patents

REMINDERS & RESOURCES

• **Introduction to IP**, webinar video by Jeremy Tamsen (Patents covered in the second half of the video)

ACCESS VIDEO HERE.

• **StartUp Stories**, November 11 1pm PT/ 3pm MT. Interview and Q&A with **Trillitye Paullin**, Ph.D. a biotechnology researcher and entrepreneur. She founded Free to Feed. **JOIN HERE** on Zoom.

• **ASCEND Hub Webinar**, “Unlocking Productivity: Electronic Management Techniques for Invention Disclosures, Non-Disclosure Agreements and Material Transfer Agreements” by Jeremy Tamsen, J.D., Director, U of I Office of Technology Transfer November 18, 1pm PT/2pm MT. **REGISTER HERE.**

• **Subscribe to the OTT YouTube channel HERE.**



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Contract IP

Tips & Tricks

VOL. 2.7.2021

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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.

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.

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

REMINDERS & RESOURCES

- **StartUp Stories**, Dec. 2, 1pm PT/ 2pm MT. Interview and Q&A with **Mattie Mead**, CEO, Hempitecture, a sustainable materials company, specializing in bio-based building products. **Join here on Zoom.**

- **Introduction to IP**, ASCEND Hub Webinar Series, video recording of presentation by Jeremy Tamsen. **ACCESS VIDEO HERE.**

- **Subscribe** to OTT’s YouTube channel and see past “StartUp Stories” videos **here.**

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What are the **STEPS** to **PATENT DISCOVERY** at the university?



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- 1 Research, discover, innovate, invent.** A patent is a government-issued monopoly that may be used to protect a “process,” “machine,” “article of manufacture” or a “composition of matter.” To be eligible, an innovation must be “useful,” “new,” “non-obvious,” and “sufficiently described” to enable someone to replicate it. Learn more in the OTT Learning Center.
- 2 File an Invention Disclosure.** The first step toward a patent application for University students, staff, and faculty members is to submit a complete Invention Disclosure Form (see FSH 5300). This form includes a description of your research and your invention and captures details about collaborators and funding. Download, complete, and submit your Invention Disclosure Form using the OTT online Service Portal.
- 3 Assessment of patentability.** OTT uses this information to determine whether your innovation may qualify for a patent. OTT considers the marketability, maturity, and anticipated time to license - innovations without a clear market fit will likely not proceed.
- 4 Patent Filing.** For qualifying innovations, patent applications are filed using third-party attorneys hired by OTT, in close coordination with the inventor(s). The patent application process requires substantial investments of time and attention by participating inventors and their collaborators.
- 5 Patent Examination.** The first response from the patent office will take 16-24 months, and that starts a back-and-forth process with the hired attorneys. This process may take years, and inventors must frequently and timely review communications to the attorney from the patent office.
- 6 Patent Issuance.** If the patent office is finally satisfied, the patent issues, granting the government-issued right to exclude others from making, using, selling, offering for sale, or importing the patented invention for the term of the patent for 20 years from the date of application.
- 7 Commercialization.** OTT relies on third parties to put innovations to work. From the time the Invention Disclosure is completed, OTT seeks a company interested in using the innovation in commerce. OTT requires the company to meet milestones towards selling the innovation as a product or service, and to make royalty payments for the rights to use the innovation.

REMINDERS & RESOURCES

- Visit the **Learning Center** on our website to find useful information and videos about intellectual property and patenting **here**.
- **Subscribe to the OTT YouTube channel** and watch the whole “StartUp Stories” series **here**.
- **Office of Technology Transfer (OTT) Service Portal.** Request advice or submit an “Invention Disclosure,” a “Confidentiality Agreement” or a “Material Transfer Agreement,” through our **Service Portal here**.
- **ASCEND Hub Webinar**, “License Agreements,” January 27, 2022, by Mark Wicker, Managing Partner, Perkins Coi LLP, San Diego Office, and Chair of the Biotechnology & Pharmaceutical Industry Group. Registration link will be posted to this **Seminar & Webinars page**.



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

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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.”

–*Tips & Tricks*, Vol 2.4,

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”, [watch this video here](#).

REMINDERS & RESOURCES

- **Introduction to IP**, ASCEND Hub Webinar Series, video recording of presentation by Jeremy Tamsen. **ACCESS VIDEO HERE.**
- **Webinar archive**, ASCEND Hub Webinar Series video recordings. **ACCESS VIDEOS HERE.**
- **Subscribe** to OTT’s YouTube channel and see past “StartUp Stories” videos **here.**
- Visit the **Learning Center** on our website to find useful information and videos about intellectual property and patenting **here.**
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What are the **four types** of **PATENT APPLICATIONS?**



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1 Non-provisional Utility Patent. This is the most common patent application. It must include: a background statement identifying the field of the invention; a brief summary, describing how the invention solves an “existing problem;” an abstract that helps the patent examiner “to quickly determine the nature” of the invention; a specification, which is a detailed written description of the invention and how it works; drawings that describe the invention’s functions; claims, that describe the invention’s subject matter and scope; cross-references to related patents or applications if appropriate; and a signed oath by the inventor(s) declaring that, “he or she believes himself or herself to be the original inventor” or co-inventor of the claimed invention.

2 Provisional Patent. If you have conceived of an invention, but you have not reduced it to practice, you may consider this preliminary patent application that buys you one year to reduce your idea to practice. It must include a detailed written description, in addition to drawings, that fully describe the invention and how it works. All inventors must be named. No formal patent claim or oath is required. The Provisional Patent establishes an early filing date that can extend the later Non-provisional/Utility patent coverage to a maximum term of 21 years, if all documentation for the Utility Patent is supplied to the patent office in time.

3 Plant Patent. This covers the invention of distinct new varieties of plants that are asexually reproduced, excluding tuber propagated plants or those “found in an uncultivated state.” With a term of 20 years, plant patents “protect the patent owner’s right to exclude others from asexually reproducing the plant, and from using, offering for sale, or selling the plant so reproduced, or any of its parts, throughout the United States, or from importing the plant so reproduced, or any part thereof, into the United States.”

4 Design Patent. This patent only protects the way an item looks, not how it functions. Design patents protect “the visual ornamental characteristics embodied in, or applied to, an article of manufacture. ...[T]he subject matter of a design patent application may relate to the configuration or shape of an article, to the surface ornamentation applied to an article, or to the combination of configuration and surface ornamentation.” For example, the curved shape of a Coke bottle is protected by a Design Patent.

To learn more, [click here to visit the U.S. Patent & Trademark Office website.](#)

REMINDERS & RESOURCES

• **“StartUp Stories,”** hosted by Jeremy Tamsen, director of OTT Friday, January 14, 2022, 1pm PT/2pm MT on Zoom. Featured speaker will be **Russell Schiermeier**, B.S., Mechanical Engineering, owner, Schiermeier Farms. **Participate on Zoom.**

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TIPS & TRICKS

Tips & Tricks

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What is a UTILITY PATENT?

Utility (Non-provisional) Patent. Utility patent applications are used to protect novel, non-obvious, and useful inventions. “[M]ost patent applications filed... are utility applications.” “A Non-provisional Utility Patent application must include a specification, including a description and a claim or claims; drawings, when necessary; an oath or declaration; and the prescribed filing, search, and examination fees” states the USPTO website.

- A Utility Patent must include a **background statement**, about which field of science or engineering the invention pertains.
- It must include a **brief summary** that describes in general terms how the invention solves an “existing problem.”
- A **specification** must be provided, which is a detailed written description of the invention and how it works.
- **Drawings**, figures, or diagrams that describe the invention and how it works must also accompany the written specification.
- Vitally important are the **claims**, that “point out and distinctly claim the subject matter that the inventor or inventors regard as the invention. The claims define the scope of the protection of the patent. Whether a patent will be granted is determined, in large measure, by the scope of the claims.”
- An **abstract** should be included. “The purpose of the abstract is to enable the USPTO and the public to quickly determine the nature of the technical disclosures of your invention.”
- **Cross-references** to other related patent applications may be made when applicable.
- An **oath** or declaration is also required, which is “a formal [signed] statement that must be made by the inventor,” stating that, “he or she believes himself or herself to be the original inventor or an original joint inventor of a claimed invention in the application.”

To learn more, see the **U.S. Patent & Trademark Office (USPTO) website**.

REMINDERS & RESOURCES

- **StartUp Stories**, February 11, 1pm PT/2pm MT. Interview with Joseph Johnson, gym guru and Sure Squat® inventor, Q&A moderated by Jeremy Tamsen. [Join here on Zoom.](#)

- **ASCEND Hub Webinar**, with Mark Wicker, JD, Coie San Diego Office Managing Partner, January 27, 1pm PT/2pm MT. [Register here.](#)

- Watch past “StartUp Stories” and [subscribe to the OTT YouTube channel by clicking here.](#)

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PROVISIONAL

Tips & Tricks

VOL. 2.12.2022

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What is a PROVISIONAL PATENT?

Provisional Patent. If you have conceived of an invention, but not yet reduced it to practical application, a provisional patent application can be used to buy you protection while you keep working on your invention. This might be useful so you can publish a paper, or attract investors or collaborators. The provisional is a temporary, initial patent application that must fully “support, describe and enable” the eventual non-provisional patent application. To get a chance for longer protection, a non-provisional application must be filed within 12 months of filing the provisional application. To be complete, a provisional application must also include:

- the name(s) of all inventors, their addresses and contact information;
- title of the invention;
- a full written description of the invention and how it functions;
- “any drawings necessary for the understanding of the invention”;
- attorney or agent (i.e, The Regents of the University of Idaho), and;
- any U.S. Government agency such as a university that has a property interest in the application.

Advantages. By allowing inventors to delay the required reduction-to-practice, it allows inventors to establish an earlier priority date for the later-filed non-provisional patent application. Other benefits of a provisional patent application include that it:

- extends the later non-provisional/utility patent term to 21 years;
- provides a lower-cost first filing in the United States;
- is fairly simple, compared the later Utility patent application;
- does not require formal claims;
- nor require formal conclusive drawings;
- does not require a formal patent oath or declaration;
- gives the inventor 12 months to finalize application for utility patent, and;
- allows the inventor to disclose their invention to others without risking protection.

Disadvantages. If your provisional patent does not fully “support, describe and enable” the technology that you later “claim” in the non-provisional/utility patent application, then you won’t benefit from the earlier filing date and would be forced to file a new application. Note that:

- if a drawing is necessary to understand the invention, it must be in the provisional application and cannot be added later;
- the provisional term of 12 months cannot be extended;
- the provisional “must have at least one inventor in common with the inventor(s) named in the [later] non-provisional application to claim benefit of the provisional application filing date”, and;
- “amendments are not permitted in provisional applications after filing, other than those to make the provisional application comply with applicable regulations.”

REMINDERS & RESOURCES

• **StartUp Stories, Fri Feb 11**, 1pm PT/2pm MT. Interview with Joseph Johnson, gym guru and **Sure Squat®** inventor, Q&A moderated by Jeremy Tamsen. **Join here on Zoom.**

• **ASCEND Hub** is offering a 5-week course, beginning March 2nd. “Bridging the Gap: Commercialization for Biomedical Researchers.” **Register here.**

• **Mountains to Mesas SBIR/STTR Accelerator**, a 10-week course starts March 23rd. **Signup here.**

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PLANTS

Tips & Tricks

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What is the difference? PLANT VARIETY PROTECTION (PVP) CERTIFICATE vs PLANT PATENT

Developing strong plants that produce good crops, takes lots of time and resources, and maintaining the genetic purity of these vital plants over time, takes even more investment. Most plants developed by researchers at the University of Idaho are therefore protected by Plant Variety Protection (PVP) Certificates, issued by the U.S. Department of Agriculture (USDA). University of Idaho uses PVP certificates to allow farmers to grow and sell our plant varieties, and to help ensure the purity of the plant varieties we develop.

Plant Variety Protection (PVP) Certificates

Enacted in 1970, the U.S. federal law known as the Plant Variety Protection Act (PVP Act) is administered by the USDA. PVP Certificates protect plants that are sexually reproduced (using seeds), tuber-propagated (like potatoes), or otherwise asexually reproduced (like garlic and other bulbs).

Certificate owners have rights to exclude others from marketing and selling their varieties, manage the use of their varieties by other breeders, and enjoy legal protection of their work. University of Idaho-owned varieties are licensed to third growers and seed producers through the Office of Technology Transfer.

Facts about PVP Certificates:

- Protects any *sexually* produced plant (which cannot be covered by a plant patent), *tuber-propagated* plant, or otherwise asexually reproduced plant;
- To qualify, a plant variety must be *new, distinct, uniform and stable*;
- PVP protection is effective for 20 years from the date the certificate issues, or 25 years for trees and vines;
- Plant variety cannot be sold or advertised for more than one year prior to the filing date of the PVP, or for more than four years from first sale outside the US, or six years from the first sale for a tree or vine outside the US;
- Allows others to conduct research with our plant varieties, re-plant some saved seeds, or use the material to develop a new variety of their own;
- PVP certificates are issued by the PVP Office, a department of the USDA.

See here for more information: <https://www.uspto.gov/ip-policy/patent-policy/international-convention-protection-new-varieties-plants-upov>
Plant Patents (to be discussed more fully in the next *Tips & Tricks*)

“A plant patent is granted ...to an inventor ...who has invented or discovered and *asexually* reproduced a distinct and new variety of plant, other than a tuber propagated plant or a plant found in an uncultivated state.” (USPTO)

REMINDERS & RESOURCES

• **ASCEND Hub** is offering a 5-week course, beginning March 2nd. “Bridging the Gap: Commercialization for Biomedical Researchers.” Learn about IP protection and funding. **Register here.**

• **Mountains to Mesas SBIR/STTR Accelerator**, a 10-week course starts March 23rd. **Signup here.**

• “**Exploring FDA Regulatory Programs & Emergency Authorizations**,” February 24th., 1pm PT/2pm MT. **Register here.**

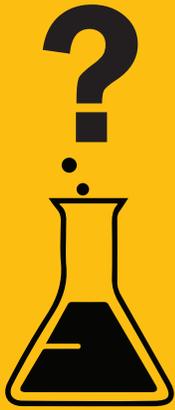
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PLANTS

Tips & Tricks

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What is a Plant Patent?

A Plant Patent provides a powerful way to protect a new plant variety and has advantages over a Plant Variety Protection Certificate because Plant Patents give the inventor more exclusive rights, and more vigorous tools to protect against infringement.

Plant Patent definition and history

“A plant patent is granted by the United States government to an inventor (or the inventor’s heirs or assigns) who has invented or discovered and asexually reproduced a distinct and new variety of plant, other than a tuber propagated plant or a plant found in an uncultivated state.” (USPTO)

The first U.S. Plant Patent was issued in 1931 to Henry Bosenberg for a climbing, ever-blooming rose.

Plant Patents protect plants as defined as:

- “A living plant with a set of characteristics determined by its single, genetic makeup or genotype, which can be duplicated through asexual reproduction, but cannot otherwise be “made” or “manufactured”;
- “Cultivated sports, mutants, hybrids, or transformed plants,” derived “from a planned breeding program” or cultivated area.

Facts about Plant Patent protection:

- Protects new or discovered distinct plants that are asexually-propagated
- “Asexual reproduction is the propagation of a plant without...fertilized seeds to assure an exact genetic copy of the plant being reproduced.”
- The plant can “not have been obvious to one having ordinary skill in the art as of the effective filing date of the claimed plant invention.”
- Gives an inventor or breeder exclusive rights over technical processes for the production of covered plant varieties.
- All co-inventors or co-breeders must be listed in the initial plant patent application filing.
- Term of protection is for 20 years from the filing date of the application.
- “Prohibits others from asexually reproducing, selling, offering for sale, or using the patented plant or any of its parts in the United States or importing them into the United States.”
- Prohibits use in research by others

PROHIBITS THIRD-PARTY RESEARCH USING THE COVERED VARIETY. CITATIONS ARE FROM THE USPTO
WEBPAGE: “GENERAL INFORMATION ABOUT 35 U.S.C. 161 PLANT PATENTS”

For more information about Plant Patents:

- Read about **Plant Patents on the USPTO website here.**
- Watch this **webinar about Plant Patents here.**

REMINDERS & RESOURCES

• **Register here** for the next ASCEND Hub Webinar, **Launching a Start Up from University**, with Grace Chou, Ph.D., March 31, 1pm PT/2pm MT.

• Watch a recorded session of an ASCEND Hub webinar, **Introduction to IP**, by Jeremy Tamsen, U of I’s OTT Director at **this link**.

• **Watch OTT videos here.**



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DESIGN TIPS & TRICKS

Tips & Tricks

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What is a Design Patent?

What shape is it? How does it look and feel? These are characteristics that can be protected by a Design Patent. From Coke® bottles and Apple® computers to website user interfaces—these can all be protected by Design Patents.

A Design Patent protects “the visual ornamental characteristics embodied in, or applied to, an article of manufacture. ...[T]he subject matter of a Design Patent application may relate to the configuration or shape of an article, to the surface ornamentation applied to an article, or to the combination of configuration and surface ornamentation.” “In general terms... a ‘Design Patent’ protects the way an article looks.”

Design vs Utility Patent

“In general terms, a ‘Utility Patent’ protects the way an article is used and works (35 U.S.C. 101), while a ‘Design Patent’ protects the way an article looks (35 U.S.C. 171). The ornamental appearance for an article includes its shape/configuration or surface ornamentation applied to the article, or both. Both design and Utility Patents may be obtained on an article if invention resides both in its utility and ornamental appearance.”

(The above text adapted from the US Patent & Trademark Office’s **Manual of Patent Examining Procedure.**)

Improper Subject Matter for Design Patents

“A design for an article of manufacture that is dictated primarily by the function of the article lacks ornamentality and is not proper statutory subject matter under 35 U.S.C. 171. In addition, 35 U.S.C. 171 requires that a design to be patentable must be ‘original.’ Furthermore, subject matter that could be considered offensive to any race, religion, sex, ethnic group, or nationality is not proper subject matter for a Design Patent application.” (35 U.S.C. 171 and 37 CFR § 1.3.)

SITATIONS FROM THE USPTO WEBSITE: “DESIGN PATENT APPLICATION GUIDE”

Read more about Design Patents on USPTO’s website here.

Who is filing Design Patents? See the top 100 design patent filers here.

REMINDERS & RESOURCES

- **StartUp Stories**, March 31, 11:30am PT/12:30pm MT. Interview and Q&A with **Brandi Turnipseed**, co-founder of Epic Equine Health. Join on Zoom.

- **Register here** for the next ASCEND Hub Webinar, **Launching a Start Up from University**, with Grace Chou, Ph.D., March 31, 1pm PT/2pm MT.

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What are the types of IP Agreements?



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1 Invention Disclosure. Before making any public announcement of any kind about your potentially patentable discovery or invention, you'll need to first file an Invention Disclosure Agreement with the UI OTT (see FSH 5300).

An Invention Disclosure Agreement is a written description of your innovation, developed under federal sponsorship (at universities). It formalizes the transfer of the IP from the inventor to the university, and empowers the university to act with Power of Attorney in future patent prosecution-related activities. Through the Bayh-Dole Act, universities are empowered to protect, patent, and benefit from intellectual property (IP) developed at their institutions, by licensing that IP to businesses, often in close proximity to the institutions—thereby stimulating the economies of the region around them.

2 Non-Disclosure/Confidentiality Agreement. A nondisclosure agreement (NDA), also known as a confidentiality agreement (CA), is a contract to protect non-public research or business information between University of Idaho (UI) and other organizations. It describes the confidential material, knowledge or information that the parties wish to share while restricting access to any other parties, and the purpose for the exchange. At UI, all the incoming and outgoing NDAs are reviewed, negotiated and signed by the Office of Technology Transfer (OTT). To protect the potential intellectual property, UI investigators are strongly advised to work through OTT to put a NDA in place before talking about their unpublished university research with other organizations.

3 Material Transfer Agreement. This Agreement (MTA) is a contract used to govern the transfer of tangible and intangible research materials between the university and other organizations. It defines the rights of the provider and the recipient with respect to the transferred material, its derivatives and related information. It prevents the material provider from losing control over the material and its research use, protects a researcher's existing and potential intellectual property, and ensures the transfer doesn't conflict with federal regulations or rights afforded in other agreements associated with the research project.

4 Plant Material Transfer Agreement. When germplasm for a new plant variety needs to be exchanged with a third party, UI OTT uses a specific Plant Material Transfer Agreement. Similar to the standard MTA, using the plant MTA for new plant materials preserves the ability to protect those materials later by a plant patent, utility patent, or a plant variety protection certificate.

REMINDERS & RESOURCES

- **ASCEND Hub Webinar,** “How to Strengthen Industrial/Academic Collaborations in the Bioscience Sector,” part of the UNM Team Research Symposium, **Wed, April 20th, 9am PT/10am MT. Register here.**
- **ASCEND “Office Hours,”** an opportunity for faculty entrepreneurs to meet one-on-one with John Chavez, Managing Director of NM Start-Up Factory, **Fri, April 22nd, from 1-3pm PT/2-4pm MT. Register here.**
- **Idaho Ignite Summer Workshop.** Open widely to researchers in all fields. Learn from Idaho university mentors; how to translate research into business ideas; and learn how to access capital. Over six weeks, from June 7th through July 14th. Address questions or concerns to Jeremy Tamsen at tamsen@uidaho.edu. **Fill out the online registration form here.**

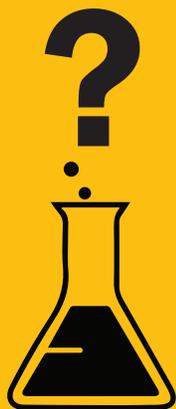


University of Idaho
Office of Technology Transfer

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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Invention Disclosure

Tips & Tricks

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What is an Invention Disclosure?

It is the first step toward patenting your university research.

Legal document that records important details about the creation of the invention

An Invention Disclosure is a legal document that fully describes your innovation, the individuals who contributed to the conception of the innovation, as well as the funding, materials, publications, and other resources used in creating the innovation. Before an assessment can be made regarding patent eligibility, an Invention Disclosure must be fully and properly completed. Improperly excluded inventors or other information can result in the loss of future patent rights – when in doubt, consult with the Office of Technology Transfer regarding the Invention Disclosure.

Describes the scope of the invention

An Invention Disclosure form will require a written description of your innovation, and includes not only the inventor(s) name, title and contact information, but especially the date of filing and a written ‘scope’ of the invention, as well as labeled drawings, diagrams and how the invention is to be used.

Partnership between the University and the Inventor

Through the Bayh-Dole Act, and the State Board of Education, the University of Idaho is empowered to identify, protect, and benefit from intellectual property (IP) developed by faculty, staff, and students in the course of university programs. Protecting and licensing that IP to businesses enables the creation of new products and services – thereby stimulating the economies of the region and nation – while also allowing the university to continue to conduct research and education activities using the innovation.

To prevent the loss of patent rights, please consult with the Office of Technology Transfer before sharing any information of any kind about your potentially patentable discovery or invention with any non-inventors.

University Faculty or staff, and students using University facilities must file an Invention Disclosure with the UI OTT prior to publication of potentially patentable material. As required by law, regulation, and policy, the Invention Disclosure formalizes the transfer of the IP from the inventor to the university and empowers the university to act as Power of Attorney in future patent prosecution-related activities.

For U of I policies around intellectual property, please see these pages:

- **5300 - Copyrights, Protectable Discoveries and Other Intellectual Property Rights:**
<https://www.uidaho.edu/governance/policy/policies/fsh/5/5300>
- **5400 - Employment Agreement Concerning Intellectual Property:**
<https://www.uidaho.edu/governance/policy/policies/fsh/5/5400>

To download and submit an Invention Disclosure form, visit our service portal by [clicking here](#) or clicking on REQUEST SERVICE on our website.

To learn more about the process of protecting university intellectual property, visit our OTT Learning Center page by [clicking here](#).

REMINDERS & RESOURCES

• **Idaho Ignite Summer Workshop.** Open widely to researchers in all fields. Learn from Idaho university mentors about translating research into business ideas, and learn how to access capital. Six weeks, June 7th through July 14th. Address questions or concerns to Jeremy Tamsen at tamsen@uidaho.edu.
[Fill out the online registration form here.](#)

• Don't miss the **ASCEND Hub** webinar, **Funding Your Startup**, TOMORROW, Thursday, April 28th, 1pm PT / 2 pm MT. John Chavez, MBA, Managing Director at New Mexico Start-Up Factory I, II and III, will speak about funding options for **biosciences**.
[Register here.](#)



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Confidentiality

Tips & Tricks

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What is a **CONFIDENTIALITY** or **Non-Disclosure Agreement?**

A Confidentiality Agreement (CA), also known as a Non-Disclosure Agreement (NDA), is a contract to protect proprietary research or business information when it is exchanged between UI and other organizations. The agreement outlines the proper procedure for exchanging confidential information while prohibiting access by any other parties.

University of Idaho Policies around CAs and NDAs

In your role at the University you may need to utilize or share confidential information; for example you may want to attract collaborators to a project around a new potential invention, necessitating that you talk about it with others before you the protection that comes from UI filing a patent. A Confidentiality Agreement, or a Non-Disclosure Agreement (NDA), is a legally enforceable contract to facilitate such an exchange of confidential information between parties. To protect potential intellectual property, UI investigators are strongly advised to contact OTT to put a NDA in place before talking about their unpublished research with other organizations, as any discussion not under a NDA can spoil future rights. UI investigators are also asked to contact the OTT as soon as possible after receiving a NDA from other organizations, as OTT is responsible for handling these when they regard UI-sponsored activities under the meaning of **FSH 5300**.

Protects confidential information. The agreement defines how parties are allowed to use confidential information and for what purpose(s), and any specific restrictions against using the information.

Defines what is confidential information. A general description of the information that the parties wish to share under confidence is included, help to limit the scope of claimed confidentiality to what is necessary to share in order to accomplish the purpose(s) of the exchange.

Helps protect patent rights. Public disclosure is the fastest way to ruin your chances at obtaining a patent for an invention or discovery, and an NDA can help protect those future rights.

Legally binding. The agreement is a legally binding contract between the University and another party. If you receive a NDA from an organization, in your capacity as a member of the faculty or staff, you are not legally qualified to sign it on behalf of the University. These agreements must be reviewed, negotiated and signed by the official signatory in OTT.

For more information about IP agreements, visit this page:

<https://www.uidaho.edu/research/ott/faculty-researchers/forms-agreements>

REMINDERS & RESOURCES

- **Idaho Ignite Summer Workshop.** Learn from Idaho university mentors about translating research into business ideas, and learn how to access capital. June 7th through July 14th. Address questions to tamsen@uidaho.edu. Register by May 13th here.

- Jeremy Tamsen, Director of Office of Technology Transfer, will present at **Elevate Idaho's monthly webinar** series on Wednesday, May 18th, 11am PDT/12noon MST on *The Importance of Intellectual Property including Data Rights & Patent Rights* Register here.



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Materials Transfer

Tips & Tricks

VOL. 2.19.2022

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What is a Material Transfer Agreement?

A Material Transfer Agreement governs how transferred materials may or may not be used.

A Material Transfer Agreement (MTA) is a legally binding contract.

MTAs allow researchers to transfer proprietary or sensitive materials while preserving intellectual property rights in the transferred materials. MTAs are used to send research materials between the University of Idaho and other entities. There are separate agreements for plant materials, non-plant materials, and materials coming from human research subjects.

MTAs define the limitations and allowed uses of the transferred material.

An MTA is used to outline how the transferred materials can be used by others, and under what parameters. The agreement also defines what intellectual property (IP) rights, if any, may or may not be claimed using those materials, and who will own those IP rights. It prevents the material provider from losing control over the material and its research use, protects a researcher's existing and potential intellectual property, and ensures the transfer doesn't conflict with federal regulations and rights afforded in other agreements associated with the research project.

Technology and Plants can be protected by MTAs.

Agreements can be signed to protect the use of plant varieties, cell lines, germplasm, transgenic plants, vectors and other features of custom plants that patent holders may want to impose limits on. Examples of other materials' whose uses can be circumscribed by MTAs are chemicals, equipment, software and data.

Your role & the role of the Office of Technology Transfer.

U of I investigators should contact OTT to put a MTA in place before sending out research materials, such as proprietary data, chemical compounds, new materials, plant seeds, bacteria, cell lines, plasmids and animals. All the incoming and outgoing MTAs are reviewed, negotiated, and signed by the University of Idaho (U of I) Office of Technology Transfer (OTT); individual faculty investigators, staff members, and students do not have authority to sign agreements on the behalf of the university. If you receive an MTA from another institution, or believe that you need one to protect the transfer of proprietary information or materials, contact OTT as soon as possible using the submit link included below on this newsletter.

To download a U of I Material Transfer Agreement, go to this page:

<https://www.uidaho.edu/research/ott/faculty-researchers/forms-agreements>

To submit an MTA to OTT, go to this page:

<https://support.uidaho.edu/TDClient/40/Portal/Requests/ServiceDet?ID=789>

REMINDERS & RESOURCES

- **ASCEND** webinar "Determining if You Have an Invention," Thursday May 26th, 1PM PT/2 PM MT. H. Victoria Bryant, MS, JD, Director of the Wyoming Technology Transfer UW, will offer advice on identifying and protecting your inventions. **Registration Link here.**

- **ASCEND** Course, "Bridging the Gap: Commercialization for Biomedical Researchers" runs June 1-29th. 5-week course topics: Commercialization Path, IP Protection, Company Structure and Non-Dilutive Funding, Entrepreneurial & Fundraising Skills, and Pitch Deck Best Practices. **Registration Link here.**



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