

Commercializing University Intellectual Property



UH Office of Technology Transfer



Background

- System-wide office under UH Vice President for Research and Innovation
- Help researchers identify, protect & commercialize intellectual property developed at UH
- Transfer UH intellectual property for society's use and benefit
- Help build UH research enterprise
- Generate licensing income for UH and inventors
- Provide advice and assistance on IP matters



Bayh-Dole Act

- Established a uniform federal policy on inventions made under federal funding
- Allows universities to retain title to inventions
- Encourages collaborations with businesses to commercialize inventions
- Requires universities to file patents on inventions they elect to own
- Requires that federal grantees report inventions. OTT reports UH inventions thru IEdison



UH Patent & Copyright Policy

■ Executive Policy

- UH owns any invention conceived or developed with UH funds, equipment, facilities or personnel.
- Inventor owns inventions developed without UH resources and outside their field of research expertise

■ OTT's Role

- Protect UH IP and researchers' interests
- Transfer UH IP to industry and share proceeds with inventors. Generous comparable royalty split to other universities



Faculty share of licensing revenue

- $\frac{2}{3}$ of first \$100,000 of UH's Net Revenue
- $\frac{1}{2}$ of $>$ \$100,000 - \$200,000
- $\frac{5}{12}$ of $>$ \$200,000
- $\frac{1}{3}$ of $>$ \$300,000

Types of Intellectual Property

Innovative Work	Protection	Rights
Machine, process, article of manufacture, composition of matter	Patent	<ul style="list-style-type: none">•Make•Use•Sell•Import
Writing, software, music, recording, photograph, art work, motion picture, written choreography	Copyright	<ul style="list-style-type: none">•Copy•Adapt•Distribute•Perform•Display
Logo, name, slogan	Trademark	<ul style="list-style-type: none">•Exclusive use
Information not generally known	Trade Secret	<ul style="list-style-type: none">•Exclusive use



Patents

- Limited period of exclusive use
- Not automatic like copyrights. Must apply and be granted by a country's patent office
- Must be novel, useful, non-obvious
- Cannot patent:
 - A pure idea, must reduce to practice
 - Anything that occurs in nature, like unaltered genetic material
- Patents expire after 20 years



Copyright

- Protects original works fixed in a tangible form – protects the expression of an idea, not the idea itself
- Works are “born” copyrighted, no requirement to register, but registration aids enforcement. Sample copyright notice: © 2014 University of Hawaii
- Authors have certain rights – make and distribute copies, make derivative works, display and perform the work publicly – that can be licensed to others
- Creator/Author own their copyright, unless a work for hire or subject to a written agreement
- Faculty own copyrights they create on their own initiative; UH owns all works for hire or project deliverables



Copyright - continued

- Works for hire – assigned, paid or release time
- Certain UH employees – all work is work for hire (e.g. videographer, graphic artist)
- Mixed copyright – faculty copyright can become joined with UH copyright when using ‘work for hire’ employees or funding



When should you contact us:

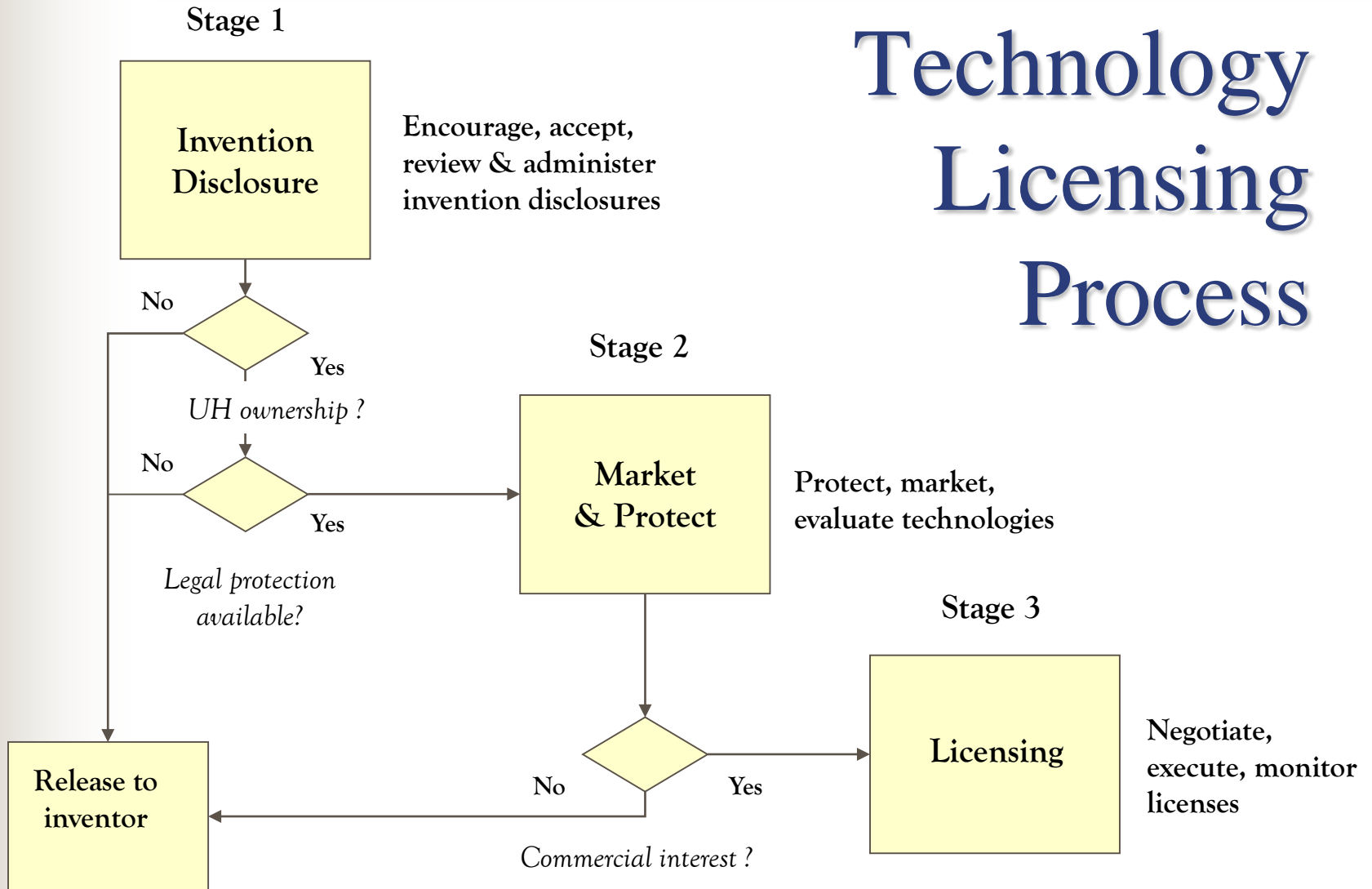
- You've invented a new, useful, non-obvious process, tool, compound, treatment, application, etc.
- Your invention or discovery has market application and commercial potential.
- A company is interested in using your invention, discovery, or copyright work.
- You'd like to see your invention move from the lab into the market to benefit society.
- Before you publish, present or publicly disclose your invention or discovery.



Submitting an Invention Disclosure:

- New online Inventor Portal @ <https://www.hawaii.edu/research/disclosing-an-invention/>
- Download a printable form
- Request via email: uhott@hawaii.edu
- We will evaluate for patentability and market potential


Technology Licensing Process





Patent Protection

- **Provisional Patent application: a placeholder**
 - Provides early filing date for the patent application
 - 1 year to convert to formal application
 - Time to assess commercial potential
- **Utility Patent application**
 - Costs increase
 - Usually takes a few years to issue
- If issued, prevents others from using or selling the invention during life of the patent



Technology Marketing & Licensing Process

- Assess commercial potential
- Market UH inventions to industry
- Encourage research collaborations and identify potential licensees
- Negotiate and execute licensing agreements granting rights to use UH IP
- Assist faculty start-ups with referrals to business support programs



Examples of licensed IP

- Antibodies – research tools
- Assay to detect viruses to cervical cancer
- Potential anti-cancer compounds
- Inhibitors for treatment (cardiac, IBD)
- Devices (stethoscope, supercooling tech)
- Disease-resistant plants (papaya, anthuriums)
- Videos and Photos



Role of Faculty in the Technology Transfer Process

- Disclose inventions & discoveries promptly
- Assist in the patenting and marketing process as a resource for information:
 - You are the expert, key technical contact
 - Knowledgeable of the industry, key players, state of the art, areas of need