Presentation Outline

I. The Technology Transfer Office and how we can help to best serve SDSU researchers

II. Intellectual Property and the America Invents Act.
Responsibilities of the TTO

Compliance and implementation of all SD Board of Regents Policy 4:34 requirements and goals.

Protecting, commercializing, negotiating, and distributing revenue from intellectual property developed under 4:34 guidelines.

Support researchers and their ability to work with groups outside of SDSU with the negotiation and implementation of all necessary agreements.

Encourage interdisciplinary collaboration and joint research across technology groups.

Expand commercial and industrial ties and connections to promote SDSU research and commercial ability.
Revised and approved in March 2012

Board owns intellectual property that is:
- Created or reduced to practice in the course of employment duties;
- Created or reduced to practice by employees:
  - performing sponsored research or
  - using facilities
- Created by students contributing to sponsored or faculty-directed research

Normally the Board waives title to copyrights unless specifically commissioned and Board keeps a license for nonprofit education and research.
Technology Transfer Process

Invention Disclosure Form, which can be found here: http://www.sdstate.edu/research/tto/index.cfm submitted to Technology Transfer Office.

All new Disclosures are given a patentability assessment and a marketing analysis.

After review of the patentability assessment and marketing analysis the professor is given a chance to review and meet with the TTO.

After meeting a plan is devised to help the technology best proceed including, marketing, protection, additional testing needed, areas of concern/hurdles to be overcome.

SDSU distributes 50% of all revenue, after the Technology Transfer Office recovers costs to the inventors.
What makes something go forward?

Constraints:
- Budget (patents can cost upwards of $30,000/patent and can need multiple)
- Time issues due to disclosures, ownership or assignment issues when funding or ownership has non-SDSU groups that don’t wish to comply, and plan going forward.

Areas to think about:
- Are there constraints to getting to market (lab scale v. industrial scale), how crowded is the field in patents/freedom to operate, do you have market interest or can you identify the market users, and does your technology bring value to the table that we can express?
Types of Documents Available from the TTO

Confidentiality Agreements and Non-disclosure Agreements;
Material Transfer Agreements;
Inter-institutional Agreements;
Research Collaboration Agreements;
Sponsored Research Agreements;
Sponsored Service Agreements;
Touring Agreements;
Facility Use Agreements;
Licensing Agreements;
Royalty Distribution Agreements; and
Any other agreement that has intellectual property provisions or implications.
Intellectual Property

- Copyrights
- Patents
- Trademarks
- Trade Dress
- Trade Secrets
What is “Intellectual Property” (IP)?

- Property created by intellect, not naturally occurring.
- Although intangible, IP is considered property in the sense it can be owned, sold, licensed (rented), willed, etc.
- Allows for inventors to have a limited monopoly over creations.
COPYRIGHTS

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Copyright

- An idea is not protected here, but rather the tangible expression of the idea.

- Exists immediately whenever an expression is fixed in a tangible medium and includes literary, dramatic, musical, artistic (dance, pictures, sculpture, etc.), architectural, and other intellectual works.

- Excluded are titles, names, slogans, short phrases, symbols, variations of typographic ornamentation, and mere listing of contents/ingredients, ideas, procedures, methods, systems, processes, concepts, principles, discoveries, or devices as distinguished from a description, explanation, or illustration.
Copyright (cont’d)

Requirements:
- The expression must be original
- The expression must be creative (minimally) but not simply a compilation of data (e.g. a telephone book).
- The expression must be put into a tangible form.

Rights – excludes others from copying, distributing, displaying publicly or making a derivative from the original work.
- Registration with the U.S Copyright Office is not necessary to create right, but is necessary to enforce the right in court for damage remedies.

Life of Copyright - life of the author plus 70 years or, as work for hire - 95 years from publication or 120 years creation, whichever occurs first.

Ownership determined on employment or publishing agreement.
The monopoly is granted in exchange for full disclosure of new technologies.

Patent rights exclude others from making, using, selling, or importing that which is patented.

Does NOT give the owner the right to make, use, sell, or import that which is patented.

Protected only in countries in which a patent issues.
Patentability Thresholds

The idea must have all of attributes of 35 U.S.C. §§ 101, 102, 103 and 112 to be patentable:

- **Novelty**—new

- **Non-obviousness**—not anticipated by one “skilled in the art” in view of all of the prior art, Graham v. John Deere Co. (prior art, invention vs. art, and one of ordinary skill) and KSR v. Teleflex (no teaching/motivation needed)

- **Enablement**—skilled in the art could make/use

- **Also:**

  Written Description, Utility, Best Mode, Statutory Subject Matter.
Bars to Patents

Statutory Bars to Patentability

35 U.S.C. § 102

- Public disclosure or use more than one year prior to filing patent application.

- A public disclosure of the invention immediately bars patentability in many foreign countries.

- Offer for sale more than one year prior to filing patent application.
The America Invents Act

By March 16/17, 2013 the America Invents Act will be law although some lag is given to implement all aspects.

There are key changes that will affect university researchers:

First to File;
Prior art submissions by third parties;
No swearing behind prior art;
Derivation proceedings;
Lawsuit changes for plaintiffs;
Prior use defenses; and
Disclosures can be good?
First to File

United States becomes a modified First to File country on March 16, 2013 after being a first to invent country since the inception of the USPTO.

Can no longer “swear behind” prior art if you can prove conception before the art and consistent reduction to practice.

Prior art now starts day of publication so filing a day later is not valid.

Safe harbor for your own publications for up to one year for enabling technology. Starts the bar date and lose rights in foreign countries. Should you disclose?

Prior use defense for trade secrets that can be shown as being used for advantage in business.
Prior art submissions by third parties

A 3rd party may submit prior art and reasons for the submission within 6 months of the date of publications.

A 3rd party may review for up to 9 months after the issuance of a patent to submit prior art and have the patent re-evaluated.
Derivation Proceedings

Can invalidate a patent or take their place if you can show “substantial evidence” that the invention was derived from your work/invention. The group bringing the derivation proceedings need to show lab notebooks, disclosures, access, copying, etc.

Within one year of the patent issuance the group must bring the derivation proceeding.
Trademarks
Trademarks

- **Trademark**—word, phrase, symbol, design, or combination that distinguishes one source of good from another. Can be a geographic location if not primarily geographically descriptive or if secondary meaning can be shown (protection only for the secondary meaning).

- **Service mark**—identifies a service rather than a product.

- **Trade dress**—protects distinctive features of a product that identify that product for the consumer.
Can establish rights based on legitimate use of the mark without registration and use the tm to identify.

Registration provides:
- Constructive notice;
- Legal presumption of ownership;
- Exclusive rights to use the mark in connection with goods or services registered;
- Ability to bring an action in federal court; and
- Ability to obtain registration in foreign countries.

After 5 years of registration a trademark can’t be contested.

A Registration is examined by the USPTO and registered marks can last as long as mark is in use.
Trade Secrets

- Information, including a formula, pattern, compilation of data, program device, method, technique, or process, that:
  
  - (i) Derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use, and
  
  - (ii) Is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.
Questions

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